TRANSCRIPT OF RECORD

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1916.

No. 952.

THE UNITED STATES EX RELATIONE CHARLES STEINMETZ, PLAINTIFF IN ERROR,

vs.

FREDERICK I. ALLEN, COMMISSIONER OF PATENTS.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

(28,954.)

(19,034.)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1903.

No. 383.

THE UNITED STATES *EX RELATIONE* CHARLES P. STEINMETZ, PLAINTIFF IN ERROR,

vs.

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1 In the Court of Appeals of the District of Columbia.

UNITED STATES *ex Relatione* CHARLES P. STEINMETZ, Appellant, *vs.* FREDERICK I. ALLEN, Commissioner of Patents } No. 1272.

Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ, Petitioner, *vs.* FREDERICK I. ALLEN, Commissioner of Patents, Respondent. } No. 45620. At Law.

UNITED STATES OF AMERICA, *District of Columbia,* } *ss:*

Be it remembered, that in the supreme court of the District of Columbia, at the city of Washington, in said District, at the times hereinafter mentioned, the following papers were filed and proceedings had, in the above entitled cause, to wit:—

Petition for Mandamus.

Filed September 9, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } At Law. No. 45620.

To the supreme court of the District of Columbia:

Your petitioner, Charles P. Steinmetz, respectfully represents:

1. That he is a citizen of the United States and resides at Schenectady, in the county of Schenectady, and State of New York:

2. That prior to the 21st day of November, 1896, he was the true, original and first inventor and discoverer of certain new and useful improvements in motor meters, not known or used by others in this country and not patented or described in any printed publi-

2 cation in this or any foreign country before his invention or discovery thereof, and not in public use or on sale in this country for more than two years prior to his hereinafter-mentioned ap-

plication for letters patent therefor; and so being the true, original and first inventor thereof, he, on the said 21st day of November, 1896, filed in the United States Patent Office an application for letters patent of the United States for said invention.

3. That said application was made, by your petitioner, in writing and addressed to the Commissioner of Patents, in due form, as required by the statutes of the United States, and by the rules of practice in the United States Patent Office in such case made and provided and with said application was filed by your petitioner a written description of his said invention, and of the manner and process of making, constructing, practicing and using the same, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which said invention appertains or with which it is most closely connected, to make, construct, practice and use the same; and in such written description the principle of your petitioner's said invention and the best mode in which your petitioner contemplated applying the same were explained; and your petitioner particularly pointed out and distinctly claimed in his said application the parts, improvements, combinations and methods which he claimed as his invention; and the specification and claims of said application were signed by your petitioner and attested by two witnesses;

4. That your petitioner did further furnish with said application drawings of his said invention, signed by his attorney and attested by two witnesses;

5. That your petitioner did further make oath before a proper officer, according to law, that he verily believed himself to be the original and first and sole inventor and discoverer of the said invention for which he solicited a patent, that he did not know and did not believe that the same was ever known or used, and did state of what country he was a citizen;

6. That your petitioner at the time of the filing of his said application did pay to the said Commissioner of Patents $15, the fee required by law and did in all other respects fully comply with the statutes of the United States and with the rules of practice in the United States Patent Office in such cases made and provided and that the said application became known and designated as application serial No. 612,943.

7. That said application contained and contains the following claims of invention to which your petitioner believes himself entitled, viz:

1. The herein-described method of measuring alternating electric currents, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetization and adapted to actuate a rotatable armature in a motor meter arranged within the energizing coils producing said lines of magnetization.

3 2. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or

axes of magnetization and adapted to actuate a rotatable armature arranged within the energizing coils producing said lines of magnetization.

3. The herein-described method of actuating a single-phase alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetization and adapted to actuate a rotatable armature arranged within the energizing coils producing said lines of magnetization.

4. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines and subjecting an armature to the inductive action of said field.

5. The herein-described method of actuating an alternating-current motor-meter which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines, one magneto-motive force being proportional to the current and the other two to the electro-motive force, and subjecting an armature to the inductive action of said field.

6. The herein-described method of actuating an alternating-current motor meter which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines, one magneto-motive force being proportional to the current and the other two to the electro-motive force, the several magneto-motive forces being so proportioned and related to each other than the resultant of the last two is displaced in phase from the first by the complement of the angle of lag, and subjecting an armature to the inductive action of said field.

7. In a watt meter for alternating electric currents, means for producing a magnetic flux proportional to the current and varying in phase therewith, means for producing a second magnetic flux proportional to the electro-motive force and lagging in phase behind the same, and means for producing an auxiliary flux along a line at an angle to said second flux and of such magnitude and phase that the resultant of the two last-mentioned fluxes will lag behind the first by the complement of the angle of lag.

8. The combination in an electro motor of a field-magnet system and means for inducing therein magnetic fluxes of three phases, one a flux due to a series coil and proportional to the current, a second flux due to a shunt potential coil and lagging behind the electro-motive force and a third flux lagging behind said second flux and having a fixed angular relation thereto such that the resultant of the second and third fluxes is dephased by substantially the complement of the angle of lag from the flux due to the series coil.

9. The combination in a recording electric meter of a field-magnet system acting on the armature and having a plurality of intersecting magnetic axes, means for inducing along one of said
4 magnetic axes a flux proportional to the current and varying in phase therewith, and means for inducing along the other

magnetic axes a plurality of other fluxes dependent upon the potential of the metered circuit, which lag behind the electro-motive force by different amounts and act upon the armature at different points said fluxes being so proportioned in value and phase that their joint action upon the armature will enable the meter to register the true energy consumed in an alternating-current circuit without being substantially affected by changes of phase relation.

10. In a watt meter for alternating currents, the combination of a field-magnet system having three intersecting magnetic axes, means for producing along one of said axes a magnetic flux proportional to the current and varying in phase therewith, means for producing along another of said axes an alternating flux proportional to the electro-motice force and lagging behind the same and means for producing along the third axis an auxiliary magnetic flux also proportional to the electro-motive force, of such a magnitude and phase that the joint action of the several fluxes upon the armature will enable the meter to register the true energy consumed in an alternating-current circuit without being substantially effected by changes of phase relation.

11. In a meter for alternating currents, the combination of a field-magnet system having three intersecting magnetic axes, means for producing along one of said axes a magnetic flux proportional to the current and varying in phase therewith, means for producing along another of said axes an alternating flux proportional to the electro-motive force and lagging behind the same, and means for producing along the third axes an auxiliary magnetic flux also proportional to the electro-motive force and of such magnitude and phase that the joint action of the two potential fluxes upon the armature will produce a torque sufficient to overcome the static friction of the meter.

12. In a single-phase alternating current meter, the combination of a field-magnet system having three intersecting magnetic axes, a field coil in which the current phase varies as the conditions of the circuit change, producing a magnetization along one magnetic axis, a potential coil producing a magnetization along another magnetic axis, a reactance device in series with said potential coil for lagging the current behind the electro-motive force and a second potential coil depending for its current upon the first potential coil, producing a magnetization along the third magnetic axis; the two potential coils conveying currents which differ in phase from each other, and each generating a flux which acts upon the armature at a point removed from the point at which the flux due to the other potential coil acts upon the armature.

13. In an electric meter, the combination of a multipolar field-magnet structure having three magnetic axes, current coils mounted upon some of the field poles and producing a magnetization along one of said magnetic axes, potential coils mounted upon other field poles and producing a magnetization along another one of said magnetic axes, and other potential coils mounted upon a portion only of the last-named field poles, or some of them,

and producing a magnetization along the third magnetic axes and an armature acted upon by the flux induced by the field coils.

8. That on or about the 15th day of May, 1900, the primary examiner to whom, according to law, your petitioner's said application was referred by the Commissioner of Patents for examination, examined and considered said application and decided that your petitioner must cancel from said application his aforesaid claims numbered 7, 8, 9, 10, 11, 12 and 13, the same being all claims for the apparatus part of your petitioner's said invention and notified your petitioner of such decision.

9. That, after receiving the notice of said decision your petitioner persisted in his said claims in said application without altering his specification in any way and his said application was thereupon, by the primary examiner, reconsidered and his aforesaid claims numbered 7, 8, 9, 10, 11, 12 and 13 were, on or about the 31st day of July, 1900, a second time required to be canceled from said application;

10. That on, or about the 4th day of August, 1900, your petitioner regarding the last-mentioned decision a second final rejection and refusal of his said claims Nos. 7, 8, 9, 10, 11, 12 and 13, by the primary examiner, and feeling aggrieved thereby, appealed therefrom, by written petition, to the board of examiners-in-chief, in accordance with the statute in such case made and provided and with the rules of practice in the United States Patent Office regulating such appeals, and paid to the Commissioner of Patents the statutory fee of $10, required for such appeal.

11. That on or about the 9th day of August, 1900, the primary examiner, contrary to his duty, refused to answer said appeal and to forward the said appeal with his answer thereto and the statement required by the rules of practice in the United States Patent Office, to the said board of examiners-in-chief, and on or about the 16th day of August, 1900, upon your petitioner's request for a reconsideration of said action repeated his said last-mentioned decision and refusal;

12. That on or about the 20th day of August, 1900, your petitioner petitioned the Commissioner of Patents to direct the said primary examiner to answer and forward said appeal, which petition was, on or about the 28th day of September, 1900, denied;

13. That, thereafter, to wit, on or about the 16th day of January, 1902, your petitioner petitioned the present Commissioner of Patents, the said Frederick I. Allen, to direct the said primary examiner to answer said appeal, and to forward said appeal with his said answer thereto and with the statement required by the rules of practice of the U. S. Patent Office to the said board of examiners-in-chief for the determination of said board, which petition was on the 7th day of February, 1902, denied.

14. That your petitioner is advised and believes that the
6 said decision of the primary examiner of the 31st day of July, 1900, repeating his previous decision of the 15th day of May, 1900, requiring the cancellation from your petitioner's said

application of all claims covering the apparatus part of his said invention, namely, his aforesaid claims 7, 8, 9, 10, 11, 12 and 13, constituted and constitutes, in fact and in law, an adverse decision upon the merits of your petitioner's aforesaid application and was and is a second rejection of the said claims 7, 8, 9, 10, 11, 12 and 13 of said application and that he is entitled, as a matter of right, under the statutes of the United States in such case made and provided, to an appeal from said adverse decision and second rejection of said claims by said primary examiner to the said board of examiners-in-chief and is entitled, as a matter of right, to have the validity of said adverse decision and second rejection revised and determined by the said board of examiners-in-chief;

15. That, under the rules of practice of the United States Patent Office, it became and was the duty of the said primary examiner to, within five days of the filing of your petitioner's aforesaid appeal, answer such appeal by furnishing the board of examiners-in-chief with a written statement of the grounds of his decision on all the points involved in the appeal and to forward such answer and statement with such appeal, to the said board of examiners-in-chief, for the revision and determination by said board of such appeal;

16. That upon the refusal of the primary examiner to furnish such answer and statement and to forward the same to the said board of examiners-in-chief as aforesaid, it became and was the duty of the said Frederick I. Allen, Commissioner of Patents to direct the said primary examiner to furnish said answer and statement and forward the same with such appeal to the board of examiners-in-chief, and the failure and refusal of the said Frederick I. Allen, Commissioner of Patents, when so requested by your petitioner as aforesaid, to perform said duty and to make such direction rendered and renders it impossible for your petitioner to have the validity of the said second rejection and refusal by the said primary examiner of the aforesaid claims Nos. 7, 8, 9, 10, 11, 12 and 13, of his said application, revised and determined by the said board of examiners-in-chief and in turn, if necessary, by the other duly constituted statutory tribunals of higher authority and operates to the great wrong and injury of your petitioner in the premises;

17. That, well hoping that the said board of examiners-in-chief might take jurisdiction of his said appeal and revise and determine the same, even without an answer or statement from the primary examiner in regard thereto and notwithstanding the action of the said Frederick I. Allen, Commissioner of Patents, aforesaid, your petitioner on the 28th day of February, 1902, petitioned the said board of examiners-in-chief, praying that said board of examiners-in-chief take jurisdiction of said appeal and revise and determine the same and reverse the aforesaid adverse decision of the said primary examiner but said petition was, on the 6th day of
7 March, 1902, denied by said board of examiners-in-chief on the ground that said board could not revise and determine said appeal without the said primary examiner's answer and state-

ment, and further, in view of the decision of the said Frederick I. Allen, Commissioner of Patents, in the premises;

18. That by the refusal of the said Frederick I. Allen, Commissioner of Patents, to so direct the said primary examiner to furnish his said answer and statement and to forward the same with petitioner's said appeal to the board of examiners-in-chief, as requested, your peitioner was and is deprived of a legal right vested in him by the laws of the United States relating to the granting of letters patent for inventions and is entirely without redress or remedy in the premises, unless this honorable court by writ of mandamus shall interpose in his behalf.

Wherefore your petitioner prays that a writ of mandamus may be issued by this honorable court to the said Frederick I. Allen, Commissioner of Patents, commanding him to direct the primary examiner to forward your petitioner's said appeal to the board of examiners-in-chief with his proper answer and statement required by the rules of practice of the United States Patent Office, to the end that the aforesaid adverse decision of the primary examiner and the aforesaid second rejection of the said claims 7, 8, 9, 10, 11, 12 and 13, of your petitioner's said application by said primary examiner, complained of, may, by said board of examiners-in-chief, be revised and determined according to law, and that speedy justice may be done your petitioner in the premises. And as in duty bound your petitioner will ever pray, etc.

CHARLES P. STEINMETZ.

O K.
A. S. D.

CHURCH & CHURCH, *Attorneys.*
ALBERT G. DAVIS, *Of Counsel.*

STATE OF NEW YORK, }
County of Schenectady, } ss:

Charles P. Steinmetz, being duly sworn deposes and says that he has read the foregoing petition by him signed and knows the contents thereof; that the statements therein contained are true of his own knowledge, except as to those matters therein stated to be on information and belief and as to such matters he verily believes it to be true.

CHARLES P. STEINMETZ.

Subscribed and sworn to before me this 28th day of August, 1902.

BENJAMIN B. HULL,
[SEAL.] *Notary Public, Schenectady County, N. Y.*

8 *Rule to Show Cause.*

Filed September 9, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ, Petitioner, *vs.* FREDERICK I. ALLEN, Commissioner of Patents, Respondent. } At Law. No. 45620.

Upon consideration of the petition for mandamus in the above-entitled cause, it is ordered, on this 9th day of September, 1902, that the respondent herein show cause, on the 17th day of September, 1902, at 10 o'clock a. m., before me at the special term of the court, why a writ of mandamus should not issue, as prayed in said petition; provided a copy of this order and of said petition be served upon the respondent on or before the 17th day of September, 1902.

JOB BARNARD,
Associate Justice of the Supreme Court of the District of Columbia.

Return of Respondent.

Filed September 17, 1902.

In the Supreme Court of the District of Columbia.

THE UNITED STATES *ex Rel.* CHARLES P. STEINMETZ *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } At Law. No. 45620.

To the honorable the justices of the supreme court of the District of Columbia:

The return of the respondent to the rule to show cause issued herein upon the 9th day of September, 1902.

The said Frederick I. Allen, Commissioner of Patents, comes and for answer to the order to show cause why the said writ of mandamus should not issue says, upon information and belief:

1. The respondent admits the allegations of the first paragraph of the petition.

2. The respondent admits the allegations of the second paragraph of the petition.

3. As to the third paragraph of the petition, the respondent denies that the application was in due form as required by the stat-
9 utes and rules of practice, since it included claims to an apparatus and claims to a process. The respondent admits that in other respects the application was in proper form.

4. The respondent admits the allegations of the fourth paragraph of the petition.

5. The respondent admits the allegations of the fifth paragraph of the petition.

6. As to the sixth paragraph of the petition, the respondent denies that the application fully complied with the statutes and rules of practice, since it included claims to an apparatus and claims to a process.

7. The respondent admits the allegations of the seventh paragraph of the petition.

8. As to the eighth paragraph of the petition, the respondent admits that the examiner having charge of the relator's application wrote a letter to him on May 15, 1900, saying:

"In accordance with office letter of January 2, 1900, applicant is required to cancel from this case all claims except those for the method."

In further explanation of this matter, the respondent says that prior to May 15, 1900, and on October 9, 1899, the primary examiner wrote a letter to the relator, requiring division between the process claims and the apparatus claims, in accordance with rule 41, before further action would be given upon the merits of the case. In a reply filed December 15, 1899, the respondent asked that his process claims be placed in interference with the claims of a patent granted to one Duncan, and said:

"It is therefore requested that the retirement for division be waived for the present in order that an interference with the patent to Duncan above referred to may be declared."

The examiner then wrote a letter on January 2, 1900, saying:

"Pending the determination of the interference applicant may retain the method and apparatus claims in this case, but the acceptance of an interference on one of the method claims will be held by the office to be an election of the prosecution of the method claims, and further prosecution of the apparatus claims in this application will not be permitted."

The relator's reply, filed January 19, 1900, was:

"It is respectfully requested that the interference with the Duncan patent, No. 604,464, be declared as soon as possible."

The interference was thereupon declared on February 7, 1900, and the decision therein was in favor of the relator and against Duncan. After that decision the examiner wrote the said letter of May 15, 1900.

By his request for the interference in reply to the examiner's warning as to the effect of such request, the relator eliminated from consideration the question which of the two inventions claimed would be retained in this case if division was finally insisted upon,

and he is estopped from denying that the apparatus, if either,
10 must be presented in a separate application. His action in accepting the ruling of the office upon the question of election, and thereby obtaining the interference, left open for final decision only the question whether division should be required, and it was upon this question that the examiner ruled in his letter of May 15, 1900.

9. As to the ninth paragraph of the petition, it is admitted that the relator filed a letter on July 16, 1900, asking for a reconsideration of the examiner's action, and that the examiner thereupon repeated his action.

10. The respondent admits that the relator filed an appeal and paid the fee, but denies that the statute and rules of practice provide for such appeal, as alleged in the tenth paragraph of the petition herein.

11. The respondent admits that the primary examiner refused to answer and forward the appeal, as alleged in the eleventh paragraph of the petition.

12. The respondent admits the allegations of the twelfth paragraph of the petition; a copy of the decision denying the petition is hereto attached, as Exhibit A.

13. The respondent admits the allegations of the thirteenth paragraph of the petition and attaches hereto and as a part hereof a copy of his decision dated February 7, 1902, marked Exhibit B.

The respondent further alleges that before the date of the said petition and decision, the relator had under the provision of rule 145 petitioned the respondent as Commissioner of Patents to review and reverse the action of the primary examiner requiring division, and after a full consideration of the matter the respondent was of the opinion that the requirement for division was proper and for that reason denied the petition on January 2, 1902.

14. The respondent denies that the examiner's letter of July 31, 1900, was a second rejection of claims made by the relator, and denies that the relator has the right of appeal therefrom to the examiners-in-chief. The examiner's action was merely a ruling that the relator should present in two applications, in accordance with the provisions of rule 41, approved by the Secretary of the Interior, the two inventions now claimed in one application, and did not involve the rejection of any claim or an action upon the merits of any claim made by the relator. The statutes and rule 133 of the rules of practice do not provide for an appeal to the examiners-in-chief from an examiner's requirement for division, and the examiners-in-chief have no jurisdiction to pass upon the question whether or not division should be required.

15. The respondent denies that it was the duty of the primary examiner to forward the appeal and to furnish a statement of the grounds of his action, as alleged in the fifteenth paragraph of the petition herein.

16. The respondent denies that it was his dnty to direct the primary examiner to forward the appeal, for the reason that no

authorized appeal had been filed, as alleged in the sixteenth paragraph of the petition herein.

11 17. The respondent admits the allegations of the seventeenth paragraph of the petition.

18. The respondent denies that the relator has by the action of the respondent been deprived of any legal right vested in him by the laws of the United States, as alleged in the eighteenth paragraph of the petition herein.

The respondent further says that by reason of the facts hereinbefore alleged, he should be dismissed with his reasonable costs.

FREDERICK I. ALLEN.

JOHN M. COIT, *Attorney.*

DISTRICT OF COLUMBIA, *ss:*

On this day personally appeared before me, a notary public in and for the said District of Columbia, Frederick I. Allen, and made oath that he is the respondent in the above-entitled cause; that he has read the foregoing answer by him subscribed and knows the contents thereof; that the same is true of his own knowledge, except as to the matters therein stated to be alleged on information and belief, and that as to those matters he believes it to be true.

FREDERICK I. ALLEN.

Given under my hand this 13th day of September, 1902.

A. M. BUNN,

[SEAL.] *Notary Public for the District of Columbia.*

EXHIBIT A.

Filed September 17, 1902.

Where applicant does not care to comply with the examiner's requirements in a matter of division such as is here involved, it has been the practice for the past thirty years to treat the question not as one of merits and appealable to the examiners-in-chief, but as a proper matter for petition to the Commissioner. I see no reason for overturning this practice. The petition is denied.

WALTER H. CHAMBERLIN,
Assistant Commissioner.

September 28, 1900.

12

Exhibit B.

Filed September 17, 1902.

Jan. 22, 1902. M. H.

United States Patent Office.

Ex Parte Charles P. Steinmetz.

Motor meters.

Petition.

Application filed November 21, 1896; No. 612,943.

Mr. Albert G. Davis for applicant.

This is a petition from the action of the primary examiner refusing to forward to the examiners-in-chief an appeal in the above-entitled case.

The examiner required division in this application between claims to the apparatus and claims to the process, and this action was clearly correct under the express provisions of rule 41. The applicant then asked for an interference with a patent containing the process claims, and that interference was declared, the applicant being informed that the request for an interference upon the process was considered an election to retain the process claims in this case, and that after the conclusion of the interference he would be required to cancel from the case the apparatus claims. The interference was decided in favor of this applicant and the examiner then insisted upon his requirement that the application be divided and that the apparatus claims be canceled. The petitioner states that this action amounted to a refusal of the apparatus claims, and therefore took an appeal to the examiners-in-chief. The examiner refused to forward the appeal, upon the ground that the questions involved are petitionable to the Commissioner and are not appealable to the examiners-in-chief.

The requirement for division is clearly a matter of form, not involving the merits of the claims, since the claims may be, and in the present case are, regarded as allowable. The examiner has not refused to grant a patent to this applicant upon any of the claims presented, but has merely required that they be included in two patents instead of one. It is a question of procedure or of the manner of securing the protection which is in controversy and not the right of the applicant to a patent upon any of the claims presented.

The examiner was right in taking the position that the question involved is not appealable to the examiners-in-chief, and although

it is a general rule of law that the appellate tribunal is the
13 one to determine whether or not it has jurisdiction when an appeal is taken to it, it is not considered necessary in the office practice to follow that practice strictly, since the Commissioner is the head of the office and has the final decision upon all questions arising within it and may settle questions of this kind upon direct petition. The examiner's decision upon the question whether or not an appeal to the examiners-in-chief is regular and proper is not final, since it may be reviewed by the Commissioner upon petition, but he has authority to pass upon that question in the first instance.

The petition is denied.

F. I. ALLEN,
Commissioner.

February 7, 1902.

Motion for Judgment, &c.

Filed September 25, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ
vs.
FREDERICK I. ALLEN, Commissioner of Patents. } At Law. No. 45620.

And now comes the relator, by Church & Church, his attorneys, and moves the court for judgment for a peremptory writ of mandamus against the respondent, notwithstanding the return of the respondent herein.

CHURCH & CHURCH,
Attorneys for Relator.

Opinion of the Court.

Filed December 2, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ
vs.
FREDERICK I. ALLEN, Commissioner of Patents. } No. 45620. Law.

This proceeding is instituted for the purpose of obtaining a mandamus against the Commissioner of Patents to require him to direct the primary examiner to forward to the board of examiners-in-chief an appeal which the relator has asked in a matter pending in the

Patent Office, wherein he has applied for a patent for certain new and useful improvements in motor meters.

14 In his said application, being serial No. 612,943, thirteen claims are stated in separate paragraphs. The primary examiner decided that the seven claims numbered 7 to 13 should be cancelled, or stricken from the application, and only the six claims first named should be considered. This ruling is based upon the contention of the examiner that the said several groups of claims are not properly related to each other, or to the alleged invention, so as to entitle them to be covered by a single patent, if one should be allowed; and for that reason, it is held that only one group should be considered in a single application; and that if the other group is to be considered at all, it must be in a separate application, thus making two cases instead of one. The relator contends that all the claims are properly united in a single application, and should be so considered; and if patentable, that a single patent should be issued covering all of them; and that it would be unlawful to grant two patents for a single invention; and if granted, the last one would be invalid.

From this ruling of the primary examiner requiring the cancellation of the seven claims last stated in the application, which it is contended has been twice made, the relator asked an appeal to the board of examiners-in-chief; but the same was denied. He then applied to the Commissioner to direct such appeal, but was answered, that the requirement for division was clearly a matter for form, not involving the merits of the claims; and that in such a matter, no appeal to the examiners-in-chief would lie.

He then applied to the board of examiners-in-chief to hear said appeal, but they declined to hear the same, because the primary examiner had not forwarded the necessary papers, and because the Commissioner had refused, on petition, to require such appeal to be forwarded to them by the said primary examiner.

The application is therefore made to this court for a mandamus in the premises, on the theory that the petitioner has a statutory right to such appeal; and that there is no discretion in the Commissioner to refuse it.

The claims, which the examiner required should be divided, were alleged, to be claims pertaining to the apparatus, and claims pertaining to the process, and the power to require such division is said to be conferred by rule 41 of the Patent Office rules. That rule provides that "claims for a machine, and the process in the performance of which the machine is used, must be presented in separate applications." Rule 42 provides, that "if several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them," the inventor will be required to elect as to which he will prosecute; and the others may be made the subjects of separate applications.

The Commissioner of Patents is authorized to establish regulations, not inconsistent with law, and subject to the approval of the

Secretary of the Interior, "for the conduct of proceedings in the Patent Office." Sec. 483, R. S. U. S.

Section 4909 R. S. U. S. provides that every applicant for a
15 patent, "any of the claims of which have been twice rejected," may have his appeal from the primary examiner to the board of examiners-in-chief.

For the conduct of proceedings in appeal under this statute, the Commissioner has adopted certain regulations, appearing in rules number 133 and 134. By these it is provided, that every applicant for a patent any of whose claims "have been twice rejected *for the same reasons, upon grounds involving the merits of the invention,* * * * may, upon payment of a fee of $10 appeal from the decision of the primary examiner," &c. and "all the claims must have been passed upon and all preliminary and intermediate questions relating to matters not affecting the merits of the invention settled, before the case can be appealed," &c.

Are these regulations consistent with law, and do they reasonably and fairly pertain to the conduct of proceedings in the Patent Office? If so, the mandamus prayed for in this case should be denied; but if not, and the relator shows himself entitled to his appeal under the statute, and has no other remedy in the premises, then the mandamus ought to be granted.

In a case clearly involving two separate inventions, it would seem proper that the claims referring to each should be divided and presented in two applications instead of in one; and that such requirement is properly a matter of practice or procedure, to be regulated by the Commissioner in the interest of all parties having business with the office. The hardship, if any, would appear to be in those cases where there may be doubt as to the claims describing two inventions. So that the applicant may not suffer an injustice in such preliminary matter, in case the primary examiner decides against him, the Commissioner has adopted rule 145, which provides for an appeal directly to the Commissioner, by petition, without fee.

It is contended by counsel for petitioner, that the statute contemplates an appeal in such formal, or preliminary matter, to the board of examiners-in-chief, and thence to the Commissioner, and finally to the Court of Appeals of the District of Columbia, the same as if the patentability of the claims was in question, rather than the manner of their presentation to the office.

In this case the examination as to the alleged new invention or discovery, required by sec. 4893 R. S. U. S., has not been made, and the questions as to its novelty, usefulness or importance, or the right of the applicant to have a patent, have not been decided; and therefore it is contended that the claims have not been rejected, within the meaning of said section 4909 granting the right of appeal.

What the relator alleges to be error, and for which he desires the appeal, is only a matter of practice or precedure, the very thing that the Commissioner is empowered to regulate by established rules. It is a question of pleading, or of description of alleged invention, and in no way involves the novelty, or usefulness of the

same, and therefore deprives the applicant of no substantial right, *provided* the claims ordered cancelled can be properly considered in a separate application.

16 It is urged by counsel for the relator that if the invention described in the several paragraphs of the application, is in fact one, then the requirement that the several claims constituting the proper description of it shall be divided, and two applications filed for the one invention, will be a denial, of justice, because the grant of a patent for one part of a unit would preclude the grant of a patent for the second part; or, if granted, the second patent would be invalid.

Although the compulsory division of claims pertaining to a single invention may be a serious matter for the inventor, it is still interlocutory, and it does not seem to be one that can be remedied by a proceeding in mandamus, for it is a technical question peculiarly within the jurisdiction of the Commissioner of Patents, and requires judgment on his part to decide. If wrong in his conclusion, he cannot be set right by mandamus. The decisions on such interlocutory questions of practice, are seldom appealable under any of the judicial systems of our country. If appeals were intended, in the executive departments of the Governments, from rulings involving only the method of doing things, or the form in which claims should be stated, or other preliminary or interlocutory orders or decisions, they should be provided for expressly, and not left to be raised by implication.

As to whether the primary examiner has committed an error in this matter, or whether the relator is correct in his contention that all his claims are properly united in one application, is not important in this proceeding, and hence no opinion is expressed on that question. The question presented here is as to the right of appeal, not as to the merits of the decisions to be appealed from. The result to the claimant of an erroneous judgment by the primary examiner in requiring a division of the claims in an application, is not necessarily the loss of his right to a patent. In most cases perhaps it is only an increase of the cost of obtaining the patent; and the question of costs is one that is seldom considered on an appeal.

In my opinion the statute authorizing an appeal, when claims have been twice rejected, means that the claims must have been considered on their merits, and found to be not patentable; and therefore that nothing inconsistent with this law is found in rules 133 and 134, regulating the procedure in appeals, so far as the same relates to a case like this.

That a decision on the merits must first be had before an appeal can be taken to the board of examiners-in-chief would seem to be as necessary as it would be to the right of the applicant to file a bill in equity under sec. 4915 R. S. U. S., and the Supreme Court holds it to be indispensable in that case. Butterworth *v.* U. S. *ex rel.* Hoe, 112 U. S. 50.

For these reasons, and without further considering the question of the discretion of the Commissioner, or the question of estoppel

argued in this case, I think the relator has not shown himself entitled to the appeal prayed for under the law, and that the writ of mandamus must be denied.

JOB BARNARD, *Justice.*

17 *Final Judgment.*

Filed December 19, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } At Law. No. 45620.

This cause coming on to be heard upon the relator's petition for a writ of mandamus against the respondant, the rule to show cause, the return and the motion of the relator for a peremptory writ of mandamus notwithstanding the return, and having been argued by counsel for the respective parties and considered by the court, it is by the court this 19th day of December, 1902, ordered and adjudged that the rule to show cause is hereby discharged and that the relator's petition be, and the same is hereby, dismissed at the costs of the relator. The relator having prayed an appeal to the court of appeals of the District of Columbia from the judgment of this court dismissing his petition, such appeal is hereby allowed, and the bond is fixed in the penalty of two hundred and fifty dollars.

JOB BARNARD, *Justice.*

Approved as to form:
JOHN M. COIT,
Attorney for Respondent.

Memorandum.

December 19, 1902.—Appeal bond filed.

Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA, *District of Columbia,* } *ss:*

I, John R. Young, clerk of the supreme court of the District of Columbia, hereby certify the foregoing pages, numbered from 1 to 31, inclusive, to be a true and correct transcript of the record, as per rule 5 of the Court of Appeals of the District of Columbia, in cause No. 45,620, at law, wherein The United States *ex rel.* Charles P.

Steinmetz is petitioner, and Frederick I. Allen, Commissioner of Patents, is respondent, as the same remains upon the files and
18 of record in said court.

In testimony whereof, I hereunto subscribe my name and affix the seal of said court, at the city of Washington, in said District, this 9th day of January, A. D. 1903.

Seal Supreme Court of the District of Columbia.

JOHN R. YOUNG, *Clerk.*

Endorsed on cover: District of Columbia supreme court. No. 1272. United States *ex relatione* Charles P. Steinmetz, appellant, *vs.* Frederick I. Allen, Commissioner of Patents. Court of Appeals, District of Columbia. Filed Jan. 13, 1903. Robert Willett, clerk.

19 THURSDAY, *April 9th, A. D.* 1903.

UNITED STATES *ex Relatione* CHARLES P. STEINMETZ, Appellant, *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } No. 1272.

The argument in the above entitled cause was commenced by Mr. Melville Church attorney for the appellant, and was continued by Mr. John M. Coit attorney for the appellee.

TUESDAY, *April 14th, A. D.* 1903.

UNITED STATES *ex Relatione* CHARLES P. STEINMETZ, Appellant, *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } No. 1272.

The argument in the above entitled cause was continued by Mr. John M. Coit attorney for the appellee, and was concluded by Mr. Albert G. Davis, attorney for the appellant.

20 UNITED STATES *ex Relatione* CHARLES P. STEINMETZ, Appellant, *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } No. 1272.

(Mr. Chief Justice ALVEY delivered the opinion of the court:)

This appeal is from a judgment of the supreme court of this District dismissing the petition of the appellant for a writ of mandamus against the Commissioner of Patents, requiring him to direct the primary examiner in the Patent Office to forward to the board of examiners-in-chief an appeal prayed for in the matter of the application for a patent pending in said office, relating to improvements in motor meters.

It is shown by the petition, and answer to the rule passed thereon, that on the 21st day of November, 1896, the appellant filed in the Patent Office an application for a patent for his invention of new and useful improvements in motor meters. This application contained, and still contains, thirteen claims that relate to the alleged invention. Of these several claims 1 to 6, inclusive, are directed to the novel method or process involved in the working of the invention; and claims 7 to 13, inclusive, are directed to the novel means or apparatus by which such method is carried into practice.

This application was in charge of a primary examiner of the office for examination, and on the 9th day of October, 1899, this primary examiner wrote to the appellant in regard to his application, requiring division under rule 41 of the office, between the process claims and the apparatus claims, before further action would be taken in respect to the merits of the claims. On December 15, 1899, the appellant asked that his process claims be placed in interference with claims in a patent issued to one Duncan. In his letter the appellant said: "It is therefore requested that the requirement for division be waived for the present, in order that an inter-
21 ference with the patent to Duncan above referred to may be declared."

In reply to this request of the appellant, the examiner informed the appellant, by letter of January 2d, 1900, that "pending the determination of the interference, applicant may retain the method and apparatus claims *in the case*, but the acceptance of an interference on one of the method claims will be held by the office to be an election of the prosecution of the method claims, and further prosecution of the apparatus claims *in this application* will not be permitted."

To this letter of the examiner the appellant, by letter of January 19, 1900, replied, that "it is respectfully requested that the interference with the Duncan patent, No. 604,464, be declared as soon as possible."

The interference was thereupon declared February 7, 1900, and decision therein was in favor of the appellant and against Duncan. It was after that decision that the examiner wrote to the appellant the letter of May 15, 1900, in which he said: "In accordance with office letter of January 2, 1900, applicant is required to cancel *from this case* all claims except those for the method."

After this, that is to say, on July 16, 1900, the appellant asked for a reconsideration of this action of the office, but the examiner repeated the action, and refused to act upon the merits of the application until the division was made in accordance with the requirement.

The appellant, then, that is, on August 4, 1900, filed what purported to be an appeal to the examiners-in-chief from the alleged rejection of his apparatus claims. But this appeal the examiner refused to answer and forward, because, as he contended, no appeal in such state of case to the examiners-in-chief was authorized. Whereupon, on August 20, 1900, the appellant petitioned the Com-

missioner of Patents to direct the examiner to answer and forward the appeal, but this application was denied by the Assistant Commissioner, who, in his opinion said, that "it has been the
22 practice for the past thirty years to treat the question not as one of merits and appealable to the examiners-in-chief, but as a proper matter for petition to the Commissioner. I see no reason for overturning this practice." On the 10th day of January, 1902, a like petition was presented to the present Commissioner of Patents, the respondent herein, and on the 7th day of February, 1902, such petition was likewise denied. In the opinion of the Commissioner of Patents, denying this application, he said: "The requirement for division is clearly a matter of form, and not involving the merits of the claims, since the claims may be, and in the present case are, regarded as allowable. The examiner has not refused to grant a patent to this applicant upon any of the claims presented, but has merely required that they be included in two patents instead of one. It is a question of procedure or of the manner of securing the protection which is in controversy and not the right of the applicant to a patent upon any of the claims presented.

"The examiner was right in taking the position that the question involved is not appealable to the examiners-in-chief; and although it is a general rule of law that the appellate tribunal is the one to determine whether or not it has jurisdiction when an appeal is taken to it, it is not considered necessary in the office practice to follow that practice strictly, since the Commissioner is the head of the office and has the final decision upon all questions arising within it and may settle questions of this kind upon direct petition. The examiner's decision upon the question whether or not an appeal to the examiners-in-chief is regular and proper is not final, since it may be reviewed by the Commissioner upon petition, but he has authority to pass upon the question in the first instance."

The appellant regarding the action of the primary examiner as an adverse decision of his right to a patent, and as a rejection of his application, on the 28th day of February, 1902, applied by petition directly to the board of examiners-in-chief to take jurisdiction of
23 his appeal; but this petition was, on the 6th day of March, 1902, also denied, on the ground that the examiners-in-chief could not, under the rules of the Patent Office, revise and determine the validity of the action of the primary examiner, without the latter's answer to the appeal, and, further, because of the previous action of the Commissioner of Patents in the premises.

Upon these proceedings in the Patent Office, the appellant applied to the court below for a mandamus to the Commissioner of Patents, requiring the latter to order and direct the primary examiner to answer and forward the appellant's appeal to the examiners-in-chief, to the end that said examiners-in-chief may review the action of said primary examiner in the premises. A rule was laid and the Commissioner answered.

The respondent, The Commissioner of Patents, in answering the

petition for the writ, denied and controverted the ground upon which the writ was sought; and, in his answer, he referred to the provisions of the statute law upon the subject, and to the various rules of practice of the Patent Office, whereby he claims and insists that the proceedings in the Patent Office in all respects conformed to and were in strict compliance with the provisions of the statute law upon the subject, and with the rules of practice made in pursuance of the statute; and therefore, as he contends, there is no ground whatever for the issuance of the writ. The appellant moved for the writ, notwithstanding the matter contained in the answer; and the court, upon hearing, concurred in the views that prevailed in the Patent Office, and therefore denied the writ and dismissed the application therefor; and from which order the relator has appealed to this court.

It is incumbent upon the appellant, in a case like the present, to show clearly and affirmatively that there was not only a right of appeal, but that such right had been denied to the applicant under circumstances that entitle him to a mandamus to enforce the right. Or, as said by the Supreme Court of the United States, in *Ex parte Cutting*, 94 U. S. 14, 20, "To entitle the petitioners to the writ
24 asked for in this case, they must show that they have a clear right to an appeal which has been refused. The office of a *mandamus* is to compel the performance of a plain and positive duty. It is issued upon the application of one who has a clear right to demand such a performance, and who has no other adequate remedy. It is never granted in anticipation of an omission of duty, but only after actual default." This principle is laid down in many authorities, but is no where better summed up than in High in his work of Extraordinary Legal Remedies, in sect. 246, where the author says: "But to warrant the interference in this class of cases it must appear that the person seeking the relief is clearly entitled to an appeal, and when this does not appear, the writ will be refused. And mandamus will not lie to compel a court to settle a statement for the purpose of an appeal from a judgment which is only interlocutory and from which no appeal lies. Nor will the writ go to compel the allowance of an appeal from orders, the granting of which rests wholly within the discretion of the court."

The question then is, whether the right of appeal in this case is thus clearly shown to exist, and whether mandamus is the proper remedy for its refusal to the applicant. This question depends upon the proper construction of certain sections of the Revised Statutes of the United States and of certain rules of practice made to govern the course of proceeding in the Patent Office.

Section 4909, Revised Statutes United States, provides that—"Every applicant for a patent or for the reissue of a patent, any of the claims of which have been *twice rejected*, and ev-ry party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal." And by section 4910, it is provided, that "If such

party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person."

25 The right of appeal thus given only exists where claims in the application for a patent, or some of them, have been twice considered and rejected by the primary examiner. And the question here is, whether any of the claims in the application of the appellant have been twice considered and rejected by the primary examiner, within the sense and meaning of the provisions of the statute? It is not denied, that to constitute a rejection of the claims in the meaning of the statute, the action or decision of the primary examiner must amount, in legal effect, to an adverse decision in respect to the merits of the claim, and be of a character to defeat the right to a patent therefor, unless reversed on appeal. There was no question made in the Patent Office as to the validity or sufficiency of any of the thirteen claims contained in the application to entitle the applicant to a patent therefor; but, because they related to different subjects-matter—one portion of them to process and the other to apparatus—the applicant was required to divide the claim, or, in the language of the primary examiner in his letter to the applicant, the latter was required to cancel *in this case* the apparatus claims, leaving the party to his right to make a separate application for a patent for those claims. There was no definite adverse decision against the claims, or against their patentability. The primary examiner had no power to make such decision without examination of the merits of the claims and twice rejecting them, because of the want of patentability, and this was not done, nor was it intended to be done; and such was the understanding and construction of the proceeding in the Patent Office; the requirement being simply that the application stands as for the process claims, and that the apparatus claims be presented in a separate application. This requirement the applicant refused to comply with, and the question is, whether there was power, under the statutes and the rules of the Patent Office, to make the required division of the claims, and to insist upon the enforcement of it.

26 It must be borne in mind that a patent for a process and a patent for a machine or apparatus with which to effect a given result, are very different things. A process is the mode of treatment of certain materials to produce a certain result; and consists of an act or series of acts performed upon the subject-matter to be transformed and reduced to a different state or thing,—whereas a machine or apparatus is a combination of mechanical elements which may or not be useful in performing the acts which constitute the process. *Cochrane vs. Deener*, 94 U. S., 780, 788; *James vs. Campbell*, 104 U. S., 356, 377. As said in the last mentioned case, a process and a machine for applying the process, are not necessarily one and the same invention. They are generally distinct and different. And this well recognized distinction is provided for in the rules of the Patent Office.

Before referring to the rules of practice bearing upon this ques-

tion, it may be proper that we refer to the sections of the Revised Statutes that confer authority to make such rules.

Section 481, Rev. Stats., provides that "the Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law, and he shall have charge of all books, records, papers, models, machines and other things belonging to the Patent Office." By section 482, it is provided that "the examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be on the written petition of the appellant to revise and determine upon the *validity of the adverse decisions of the examiners upon applications for patents*, and for reissues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them." And, by section 483, it is provided that "the Commissioner of Patents, subject to the approval of the Secretary of the
27 Interior, may from time to time establish regulations, *not inconsistent with law*, for the conduct of proceedings in the Patent Office."

It is to be observed and borne in mind that the right of appeal given by section 4909 of the Revised Statutes is given in general terms, and only when some of the claims of the applicant have been rejected; that is, as we have shown, have been considered and twice rejected on their merits, as not being patentable for some of the causes designated by the statute. If appeals were allowed in all cases of mere preliminary or interlocutory orders as well as in cases of adverse decisions on the merits of the claims, it is not difficult to see that great delays, expense, and embarrassments would be produced in conducting proceedings in the Patent Office. If appeals would lie in such cases to the examiners-in-chief, they would equally lie to the Commissioner from the examiners-in-chief, and from the Commissioner to this court. That was clearly never intended by Congress in the use of the general terms that appear in the section of the Revised Statutes. Nor has that been the understanding of the officials charged with the administration of the affairs of the Patent Office.

We shall now refer to and recite certain of the rules made to regulate the conduct of the proceedings in that office.

Rule 41 is as follows: "Two or more independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application. *Claims for a machine and its product must be presented in separate applications. Claims for a machine, and the process in the performance of which the machine is used must be presented in separate applications.* Claims for a process and its product may be presented in the same application." And rule 42 provides the mode of proceeding to effect division of claims when proper to be made. That rule provides that "If several inventions, claimed in a single application, be of

such a nature that a single patent may not be issued to cover
28 them, the inventor will be required to limit the description, drawing, and claim of the pending application to whichever invention he may elect. The other inventions may be made the subjects of separate applications, which must conform to the rules applicable to original applications. If the independence of the inventions be clear, *such limitation will be made before any action upon the merits;* otherwise it may be made at any time before final action thereon, in the discretion of the examiner."

Rules 133 and 134 have an important bearing upon the question under consideration. They are intended to regulate appeals that are prosecuted in the Patent Office, and they show under what conditions appeals are allowed, and from what nature of decisions they can be taken.

Rule 133 provides that "every applicant for a patent, any of the claims of whose application have been twice rejected for the same reasons, *upon grounds involving the merits of the invention*, such as lack of invention, novelty or utility, or on the ground of abandonment, public use or sale, inoperativeness of invention, aggregation of elements, incomplete combination of elements, or, when amended, for want of identity with the invention originally disclosed, or because the amendment involves a departure from the invention originally presented; * * * may, upon payment of a fee of $10, appeal from the decision of the primary examiner to the examiners-in-chief." * * *

And rule 134 provides, that "there must have been two rejections of the claims as originally filed, or, if amended in matter of substance, of the amended claims, and *all the claims must have been passed upon, and all preliminary and intermediate questions relating to matters not affecting the merits of the invention settled, before* the case can be appealed to the examiners-in-chief."

We have carefully scrutinized these several rules, and we perceive nothing in them that can, by any fair and reasonable construc-
29 tion, be held to be inconsistent with the provisions of the statute relating to the patent system. If there be no such inconsistency, with the express provisions of the statute, the rules are valid and have the force and effect of law, in all matters to which they relate. They are certainly not to be declared invalid upon any strained or doubtful construction, but only for such conflict or inconsistency with the statute law upon the subject as shall be made plainly to appear. These rules with many others, forming a system of practical procedure for the Patent Office, were adopted by able and experienced patent lawyers who occupied the position of Commissioner of Patents, and they have been in force for many years, and the practice of the office has been made to conform to them. To support at this late day the contention of the appellant, and declare these rules in any material respect invalid, upon the theory that they restrict the right of appeal, would be attended with very serious consequences to the Patent Office, indeed to the public. An established practice, such as has obtained under these rules,

ought not to be disturbed by the courts, except upon the clearest principle of right and necessity. The rule authorising division of claims to be made is one of grest importance in conducting the business of the office. Without such rule it would be difficult, if not impossible, to make and maintain such essential classification of the subjects of claims as would enable the office to observe and carry out the policy of the law, in making full and complete examinations as to the novelty and priority of every claim that is presented for a patent. This is a matter in which the public is greatly interested. It may be, some times, difficult to determine upon a proper division among claims presented in a single application. But, as said by the Supreme Court, in the case of *Bennett vs. Fowler*, 8 Wall. 445, "It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvements shall be embraced in one, two, or more patents. Some discretion must necessarily be left on this subject to the head of the office. It is often a nice and perplexing question."

30 This case of *Bennett vs. Fowler* recognizes the right of division of claims and the power over the subject as being in the Commissioner as head of the office. Being a matter of form and procedure the power over it is vested in the Commissioner as belonging to his supervisory power given him by the statute. His determination of such question under the rule, is final, and not reviewable by any authority in the Patent Office. In all matters involving the validity and patentability of claims and priority of invention, he exercises only an appellate jurisdiction. But in matters of practice and procedure not involving the merits and final rejection of claims, he acts in his supervisory capacity as head of the office. There must be some limit to the right of a party to have joined several and different claims in a single patent; and that being so, who is to decide the question when the division should or should not be made? The Commissioner as the head of the office is intrusted with the ultimate exercise of that power under the rules, and, it would seem, most appropriately so. The decision of the question of division in some cases may be difficult to make, it is true, but still the question must be decided as a preliminary one and as one of procedure merely. And as a regulation of such procedure rule 45 provides that "upon receiving a petition stating concisely and clearly any proper question which has been twice acted upon by the examiner, and which *does not involve the merits of the invention claimed*, and also stating the facts involved and the point or points to be reviewed, an order will be made fixing a time for hearing such petition by the Commissioner, and directing the examiner to furnish a written statement of the grounds of his decision upon the matters averred in such petition within &c. The examiner shall, at the time of making such statement, furnish a copy thereof to the petitioner: No fee is required for such petition."

It was under this rule that the appellant petitioned the Commissioner to review and reverse the action of the primary examiner

in requiring a division of the claims. And the decision of
31 the Commissioner, upon that application, was final and conclusive upon the subject, as to the application for the patent then pending. The appellant was bound to make the division as required, and the decision of the Commissioner approving the action of the examiner cannot be reversed and the Commissioner required to direct the examiner to answer and forward the appeal to the examiners-in-chief as prayed by the appellant. There is no ground shown for a mandamus, and the order appealed from, dismissing the petition therefor, must be affirmed; and it is so ordered. *Judg't affirmed.*

32 TUESDAY, *May 5th, A. D.* 1903.

UNITED STATES *ex Relatione* CHARLES P. Steinmetz, Appellant,
vs.
FREDERICK I. ALLEN, Commissioner of Patents.
} No. 1272, April Term, 1903.

Appeal from the supreme court of the District of Columbia.

This cause came on to be heard on the transcript of the record from the supreme court of the District of Columbia, and was argued by counsel. On consideration whereof, it is now here ordered and adjudged by this court that the judgment of the said supreme court, in this cause be, and the same is hereby, affirmed with costs.

Per Mr. CHIEF JUSTICE ALVEY.

May 5, 1903.

33 In the Court of Appeals of the District of Columbia, April Term, 1903.

U. S. *ex Rel.* CHARLES P. STEINMETZ
vs.
FREDERICK I. ALLEN, Commissioner of Patents.
} No1. 272. No. 12, Special Calendar.

Now comes the plaintiff-relator and petitions this honorable court to grant to him a writ of error in the above entitled case to remove the same to the Supreme Court of the United States, and, for cause shows, that the said case is one wherein is drawn in question an authority exercised under the United States and the validity of such authority, and assigns the following as errors committed by this honorable court:

First. This court erred in affirming the judgment of the supreme court of the District of Columbia.

Second. This court erred in affirming the judgment of the supreme court of the District of Columbia in dismissing the relator's petition for a mandamus.

Third. This court erred in affirming the judgment of the supreme court of the District of Columbia in rendering judgment in said case for the defendant.

Fourth. This court erred in not reversing the judgment of the supreme court of the District of Columbia and in not sustaining the relator's motion for a writ of mandamus notwithstanding the defendant's return.

Fifth. This court erred in not reversing the judgment of the supreme court of the District of Columbia and in not directing the said supreme court of the District of Columbia to issue the writ of mandamus to the defendant, commanding him to direct the primary examiner to forward the relator's appeal to the board of examiners-in-chief with a proper answer and statement as required by
34 the rules of practice of the United States Patent Office, to the end that the adverse decision of the primary examiner upon, and the second rejection by said primary examiner of claims 7, 8, 9, 10, 11, 12 and 13, of the relator's application, complained of, might be revised and determined by the board of examiners-in-chief, according to law.

Sixth. That this court erred in holding that the relator did not have a clear right of appeal to the board of examiners-in-chief from the said decision of the primary examiner of the 16th day of August, 1900, complained of.

Seventh. That this court erred in holding that the said decision of the primary examiner complained of did not constitute an adverse decision upon and a second rejection of any of the claims of relator's application for patent under sections 482 and 4909 of the Revised Statutes of the United States.

Eighth. That this court erred in holding that rule 133 of the Rules of Practice of the United States Patent Office regulating appeals is valid and not inconsistent with law.

Ninth. That this court erred in holding that the establishment of rule 133 of the Rules of Practice of the United States Patent Office by the Commissioner of Patents is a valid exercise of an authority under the United States.

Tenth. That this court erred in holding that the defendant exercised a valid authority under the United States when he instructed and directed the primary examiner not to answer and forward to the examiners-in-chief the relator's appeal to said examiners-in-chief.

Eleventh. That this court erred in holding that the requirement of division of relator's application was a matter resting entirely in the discretion of the Commissioner of Patents and not reviewable on appeal by the various statutory appellate tribunals, including the examiners-in-chief, the Commissioner of Patents and the Court of Appeals of the District of Columbia.

35 Wherefore, plaintiff-relator prays that his assignment of errors be filed in this court, that a writ of error to remove the case to the Supreme Court of the United States be granted and that the judgment of this court may be reversed that a writ of

mandamus may issue as prayed for in the petition and that the plaintiff in error may have all proper relief.

ALBERT G. DAVIS,
MELVILLE CHURCH,
Attorneys for Plaintiff in Error.

June 25, 1903.

(Endorsed:) In the Court of Appeals of the District of Columbia. U. S. *ex rel.* Steinmetz *vs.* F. I. Allen, Com'r of Patents. No. 1272. No. 12 special calendar. Petition for writ of error & assignments of error. Court of Appeals, District of Columbia. Filed Jun- 25, 1903. Robert Willett, clerk.

36 THURSDAY, *June 25th, A. D.* 1903.

UNITED STATES *ex Relatione* CHARLES P. STEINMETZ, Appellant, *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } No. 1272.

The petition for writ of error to remove the above entitled cause to the Supreme Court of the United States was submitted to the consideration of the court by Mr. Melville Church in support of petition.

FRIDAY, *June 26th, A. D.* 1903.

UNITED STATES *ex Relatione* CHARLES P. STEINMETZ, Appellant, *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } No. 1272.

On consideration of the appellant's petition for a writ of error to remove this cause to the Supreme Court of the United States, it is by the court this day ordered that said writ issue as prayed, and bond for costs is fixed at the sum of two hundred and fifty dollars.

37 UNITED STATES OF AMERICA, *ss:*

The President of the United States to the honorable the justices of the Court of Appeals of the District of Columbia, Greeting:

Because, in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said Court of Appeals before you, or some of you, between United States, *ex relatione*, Charles P. Steinmetz, appellant, and Frederick I. Allen, Commissioner of Patents, appellee, a manifest error hath happened, to the great damage of the said appellant, as by his complaint appears. We being

willing that error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same to the Supreme Court of the United States, together with this writ, so that you have the same in the said Supreme Court at Washington within 30 days from the date hereof, that the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error, what of right, and according to the laws and customs of the United States should be done.

Seal Court of Appeals, District of Columbia.

Witness the Honorable Melville W. Fuller, Chief Justice of the United States, the 26th day of June, in the year of our Lord one thousand nine hundred and three.

ROBERT WILLETT,
Clerk of the Court of Appeals of the District of Columbia.

38 Court of Appeals, District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. Steinmetz
vs.
FREDERICK I. ALLEN, Commissioner of Patents.

No. 1272. No. 12, Special Calendar.

Know all men by these presents, that we *Charles P. Steinmetz*, as principal, and *National Surety Company*, as surety, are held and firmly bound unto Frederick I. Allen, in the full and just sum of *$250*, to be paid to the said Frederick I. Allen, his certain attorney, executors, administrators or assigns; to which payment, well and truly to be made, we bind ourselves, our heirs, executors and administrators, jointly and severally, by these presents.

Sealed with our seals and dated this 3rd day of July, in the year of our Lord one thousand nine hundred and three.

Whereas, lately at a Court of Appeals of the District of Columbia in a suit depending in said court, between the United States upon the relation of said Charles P. Steinmetz, as appellant, and the said Frederick I. Allen, as appellee, a judgment was rendered against the said United States and the said relator, and the said relator in the name of the United States having obtained a writ of error and filed a copy thereof in the clerk's office of the said court to reverse the judgment in the aforesaid suit, and a citation directed to the said Frederick I. Allen, citing and admonishing him to be and appear at a Supreme Court of the United States, to be holden at Washington, within thirty days from the date thereof;

Now, the condition of the above obligation is such, that if the said Charles P. Steinmetz, in the name of the United States, or otherwise,

shall prosecute said writ of error to effect, and answer all costs if he fail to make his plea good, then the above obligation to be
39 void; else to remain in full force and virtue.

CHARLES P. STEINMETZ.

[Seal of National Surety Company.]

NATIONAL SURETY COMPANY,
By WILLIAM J. GRIFFIN,
2nd Vice President.

Attest: WM. R. WORRALL, *Res. Ass't Secretary.*

Approved
JOHN M. COIT,
Counsel for Com'r of Patents.

The foregoing bond approved,
R. H. ALVEY,
Chief Justice.

40 *Affidavit, Acknowledgment, and Justification by Guarantee or Surety Company.*

STATE OF NEW YORK, } ss:
County of New York, }

On this 3rd day of July one thousand nine hundred and three, before me personally came William J. Griffin, known to me to be the 2nd vice president of the National Surety Company, the corporation described in and which executed the within and foregoing bond of Charles P. Steinmetz, as a surety thereon, and who, being by me duly sworn, did depose and say that he resides in the city of New York, State of New York; that he is the 2nd vice president of said company, and knows the corporate seal thereof; that the said National Surety Company is duly and legally incorporated under the laws of the State of New York; that said company has complied with the provisions of the act of Congress of August 13th, 1894; that the seal affixed to the within bond of Charles P. Steinmetz is the corporate seal of said company, and was thereto affixed by order and authority of the board of directors of said company, and that he signed his name thereto by like order and authority as 2nd vice president of said company, and that he is acquainted with Wm. R. Worrall and knows him to be the res. ass't secretary of said company; and that the signature of said Wm. R. Worrall subscribed to said bond is the genuine handwriting of said Wm. R. Worrall, and was thereto subscribed by order and authority of said board of directors, and in the presence of said deponent; and that the assets of said company, unencumbered and liable to execu-

tion exceed its claims, debts and liabilities of every nature whatsoever, by more that the sum of one million dollars.

Jas. H. Ellsworth is our agent to acknowledge service in the judicial district of the District of Columbia.

(Deponent's signature:) WILLIAM J. GRIFFIN.

Sworn to, acknowledged before me, and subscribed in my presence this third day of July, 1903.

(Officer's signature, description and seal:)

[NOTARIAL SEAL.] JAMES FAWKNER,
Notary Public, No. 106, *for Kings County.*

Certificate filed in New York, Queens, Richmond, and Westchester counties.

Form 4.

STATE OF NEW YORK, *County of New York,* } ss:

I, Thomas L. Hamilton, clerk of the county of New York, and also clerk of the supreme court for the said county, the same being a court of record, do hereby certify that James Fawkner has filed in the clerk's office of the county of New York, a certified copy of his appointment and qualification as notary public for the county of Kings with his autograph signature, and was at the time of taking the annexed deposition, duly authorized to take the same, and that I am well acquainted with the handwriting of said notary public, and believe that the signature to the annexed certificate is genuine.

In testimony whereof, I have hereunto set my hand and affixed the seal of the said court and county, the 3d day of July, 1903.

[SEAL.] THOS. L. HAMILTON, *Clerk.*

[Endorsed:] No. 1272. Court of Appeals, District of Columbia. U. S. *ex rel.* Charles P. Steinmetz *vs.* Frederick I. Allen, Commissioner of Patents. Bond on writ of error S. C. U. S. Court of Appeals, District of Columbia. Filed Jul- 21, 1903. Robert Willett, clerk.

41 UNITED STATES OF AMERICA, ss:

To Frederick I. Allen, Commissioner of Patents, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, at Washington, within 30 days from the date hereof, pursuant to a writ of error, filed in the clerk's office of the Court of Appeals of the District of Columbia, wherein United States *ex rel.* Charles P. Steinmetz is plaintiff in error, and you are defendant in error, to show cause, if any there be

why the judgment rendered against the said plaintiff in error as in the said writ of error mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness, the Honorable R. H. Alvey, Chief Justice of the Court of Appeals of District of Columbia, this 21st day of July, in the year of your Lord one thousand nine hundred and three.

R. H. ALVEY,
Chief Justice of the Court of Appeals of the District of Columbia.

Service admitted this 21st day of July 1903.

JOHN M. COIT,
For Frederick I. Allen, Commissioner of Patents.

42 Court of Appeals of the District of Columbia.

I, Robert Willett, clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing printed and typewritten pages, numbered from 1 to 41 inclusive, contain a true copy of the transcript of record and proceedings of said Court of Appeals in the case of United States *ex relatione* Charles P. Steinmetz, appellant *vs.* Frederick I. Allen, Commissioner of Patents No. 1272, April term, 1903, as the same remain upon the files and records of said Court of Appeals.

Seal Court of Appeals, District of Columbia.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals, at the city of Washington, this 21st day of July A. D. 1903.

ROBERT WILLETT,
Clerk of the Court of Appeals of the District of Columbia.

Endorsed on cover: File No. 19,034. District of Columbia Court of Appeals. Term No. 383. The United States *ex relatione* Charles P. Steinmetz, plaintiff in error, *vs.* Frederick I. Allen, Commissioner of Patents. Filed July 29th, 1903.

In the Supreme Court of the United States.

OCTOBER TERM, 1903.

THE UNITED STATES EX RELATIONE Charles P. Steinmetz, plaintiff in error,
v.
FREDERICK I. ALLEN, COMMISSIONER of Patents.
No. 383.

MOTION TO ADVANCE.

Now comes the defendant in error, Frederick I. Allen, Commissioner of Patents, by the Solicitor-General, and moves the court to advance the above-entitled cause on the docket for hearing at the convenience of the court during the present term, for the following reason:

The case *ex parte* Herman A. Frasch, No. 17, original, now pending before this court on return to a rule to show cause, relates to the same general question of practice in the United States Patent Office as does this case, and it is believed that the labor of the court and of counsel will be lessened by considering the two cases together.

The present case is a petition for a mandamus, directing the Commissioner of Patents to allow an appeal within his office, from a requirement that an applicant for patent divide his application, and present claims to his machine, and claims to the process said to be performed by that machine, in separate applications. The Frasch case is a petition to this court for a mandamus directing the court of appeals of the District of Columbia to entertain and decide an appeal from the action of the Commissioner of Patents, requiring an applicant to make a division between his process claims and his claims to a machine. Both cases involve the question whether a requirement for division in the Patent Office is an appealable decision under sections 4909, 4910, and 4911, Revised Statutes.

HENRY M. HOYT,
Solicitor-General.

O

Supreme Court of the United States.

OCTOBER TERM, 1903.

No. 383.

THE UNITED STATES EX RELATIONE CHARLES P. STEINMETZ, PLAINTIFF IN ERROR,

vs.

FREDERICK I. ALLEN, COMMISSIONER OF PATENTS, DEFENDANT IN ERROR.

BRIEF FOR PLAINTIFF IN ERROR.

STATEMENT OF THE CASE.

This case comes into this court on writ of error to the Court of Appeals of the District of Columbia to review the judgment of that court, affirming the judgment of the Supreme Court of the District of Columbia dismissing the petition of the relator, Charles P. Steinmetz, for a writ of mandamus against the respondent, Frederick I. Allen, Commissioner of Patents, to compel the latter to allow an appeal to the Board of Examiners-in-Chief, from a decision of the Primary Examiner refusing and rejecting, a second time, the relator's application for patent because relator would not cancel from it certain claims, as required by the Primary Examiner, under the alleged authority of certain rules of Patent Office practice and the decisions of the Commissioner of Patents thereunder.

The validity of these rules and of the Commissioner's actions thereunder is challenged by the relator, and the case is therefore one "in which is drawn in question," directly, "an authority exercised under the United States" and the "validity" of such authority. 27 Stat., 436. (U. S. *vs.* Seymour, 153 U. S., 353; U. S. *vs.* Lynch, 137 U. S., 280; U. S. *vs.* Black, 128 U. S., 40; Butterworth *vs.* Hoe, 112 U. S., 50.)

ASSIGNMENTS OF ERROR.

The following errors have been assigned:

First. The Court of Appeals of the District of Columbia erred in affirming the judgment of the Supreme Court of the District of Columbia.

Second. The court erred in affirming the judgment of the Supreme Court of the District of Columbia in dismissing the relator's petition for a mandamus.

Third. The court erred in affirming the judgment of the Supreme Court of the District of Columbia in rendering judgment in said case for the defendant.

Fourth. The court erred in not reversing the judgment of the Supreme Court of the District of Columbia and in not sustaining the relator's motion for a writ of mandamus notwithstanding the defendant's return

Fifth. The court erred in not reversing the judgment of the Supreme Court of the District of Columbia and in not directing the said Supreme Court of the District of Columbia to issue the writ of mandamus to the defendant, commanding him to direct the Primary Examiner to forward the relator's appeal to the Board of Examiners-in-Chief with a proper answer and statement as required by the rules of

practice of the United States Patent Office, to the end that the adverse decision of the Primary Examiner and the second rejection by said Primary Examiner of claims 7, 8, 9, 10, 11, 12 and 13, of the relator's application, complained of, might be revised and determined by the Board of Examiners-in-Chief, according to law.

Sixth. That the court erred in holding that the relator did not have a clear right of appeal to the Board of Examiners-in-Chief from the said decision of the Primary Examiner of the 16th day of August, 1900, complained of.

Seventh. That the court erred in holding that the said decision of the Primary Examiner, complained of, did not constitute an adverse decision upon and a second rejection of any of the claims of relator's application for patent under sections 482 and 4909 of the Revised Statutes of the United States.

Eighth. That the court erred in holding that Rule 133 of the Rules of Practice of the United States Patent Office regulating appeals is valid and not inconsistent with law.

Ninth. That the court erred in holding that the establishment of Rule 133 of the Rules of Practice of the United States Patent Office by the Commissioner of Patents is a valid exercise of an authority under the United States.

Tenth. That the court erred in holding that the defendant exercised a valid authority under the United States when he instructed and directed the Primary Examiner not to answer and forward to the Examiners-in-Chief the relator's appeal to said Examiners-in-Chief.

Eleventh. That the court erred in holding that the requirement of division of relator's application was a matter

resting entirely in the discretion of the Commissioner of Patents and not reviewable on appeal by the various statutory appellate tribunals, including the Examiners-in-Chief, the Commissioner of Patents and the Court of Appeals of the District of Columbia.

THE PETITION.

The case made by the relator's petition is substantially as follows:

On the 21st day of November, 1896, the relator filed in the Patent Office an application for patent for his invention of new and useful Improvements in Motor Meters. This application contained and still contains thirteen (13) claims, covering the different phases of the invention; claims 1 to 6, inclusive, being, in terms, directed to the novel method or process involved in the working of the invention, and claims 7 to 13, inclusive, being, in terms, directed to the novel means or apparatus by which such method is carried into practice.

On the 15th day of May, 1900, the Primary Examiner—to whom, according to law, the application was referred by the Commissioner of Patents—examined and considered the application and decided that claims 7 to 13, inclusive, to the apparatus part of the invention, must be canceled. A reconsideration of this action was requested, and was granted, and the Primary Examiner, on the 31st day of July, 1900, repeated the requirement.

Regarding this last action as an adverse decision and as a second rejection and refusal of his claims 7 to 13, inclusive, the relator appealed to the Board of Examiners-in-Chief, with a view to having the validity of the action of the Primary Examiner revised and determined by that tribunal, according to law.

The Primary Examiner, on the 9th day of August, 1900, refused to forward the appeal, with his answer thereto, on

the ground that the question involved in the appeal was not one of which the Board of Examiners-in-Chief had jurisdiction, and therefore not appealable to that tribunal. A reconsideration of this action of the Primary Examiner was requested, and granted, and the action was, on the 16th day day of August, 1900, repeated.

On the 20th day of August, 1900, the relator petitioned the then Commissioner of Patents to direct the Primary Examiner to answer and forward relator's appeal, which petition was, on the 28th day of December, 1900, denied.

On the 16th day of January, 1902, a like petition was presented to the present Commissioner of Patents, the respondent herein, and on the 7th day of February, 1902, said petition was likewise denied.

On the 28th day of February, 1902, the relator directly petitioned the Board of Examiners-in-Chief to take jurisdiction of his appeal, but this petition was, on the 6th day of March, 1902, also denied, on the ground that the Examiners-in-Chief could not, under the Rules of the Patent Office, revise and determine the validity of the Primary Examiner's action without the latter's answer to the appeal, and, further, because of the previous action of the Commissioner in the premises.

The prayer of the relator's petition is that the respondent be commanded to direct the Primary Examiner to answer and forward the relator's appeal to the Board of Examiners-in-Chief in order that the relator may have the benefit of a review of the Primary Examiner's action by the last-named tribunal and of the other appellate tribunals, if necessary.

THE RETURN.

The respondent's return admits that the relator is the true, original and first inventor of the invention for which he solicits a patent; admits that the relator's application contained and contains the claims set out in the petition,

and that the relator's claims 7 to 13, inclusive, to the apparatus part of the relator's invention, were twice required to be canceled by the Primary Examiner. It admits, further, the filing of the appeal by the relator from the decision of the Primary Examiner to the Board of Examiners-in-Chief and the taking of the various steps by the relator, as set out in the petition, in his endeavor to perfect his said appeal and to have the same determined by the Examiners-in-Chief.

It denies that any of the claims of relator's application has been twice, or at all, rejected; denies that any right of appeal to the Board of Examiners-in-Chief has accrued to relator, and attempts to justify the action of the Primary Examiner and of the respondent, on the ground that the ruling of the Primary Examiner was merely a requirement of division of relator's application under Rule 41 of Patent Office practice, which rule the Commissioner, with the approval of the Secretary of the Interior, had authority to make, and did not involve the rejection of any claim, or an action upon the merits of relator's application, such as would entitle the relator to an appeal under the statute, or under Rule 133 of Patent Office practice.

In the Commissioner's decision, made part of the return (p. 12) (Exhibit B), it is admitted that all the claims of relator's application are allowable, but it is asserted that the refusal of the Office to grant a single patent embracing all of the claims is merely "a question of procedure or of the manner of securing protection" and "not of the right of the applicant to a patent upon any of the claims presented."

The return further sets forth that the relator is estopped by his conduct to question the validity of the Primary Examiner's requirement of division; and denies, generally, the denial of any right to the relator and of the relator's right to the relief prayed.

The relator moved for judgment, notwithstanding the return.

Mr. Justice Barnard, who heard the case in the Supreme

Court of the District of Columbia, ruled that the decision of the Primary Examiner appealed from was only interlocutory in character; did not amount to a refusal or rejection of relator's application for a patent; and was not appealable under the statute or under the rules, to the Board of Examiners-in-Chief, and he denied the writ and dismissed the petition.

This judgment was affirmed by the Court of Appeals of the District of Columbia, that court holding that the requirement of division was a matter resting in the discretion of the Commissioner; that his judgment on that question was final; and that his rule made pursuant to his statutory authority to make rules, cutting off the appeal to the Board of Examiners-in-Chief from the judgment of the Primary Examiner, was valid and not inconsistent with the statute regulating appeals.

ARGUMENT.

THE UNDERLYING QUESTION.

There is one great, fundamental, underlying question presented by this case, the proper answer to which will, probably, determine the right of the relator to the relief he seeks. It is this:

> Has an applicant for a method or process patent the right to demand protection, in that patent, of all patentable invention he is *compelled* to disclose in setting forth his new method or process?

So strongly does this question appeal to our inherent sense of justice and fair play, that we are inclined, at once, to an affirmative answer to it, especially in view of the known favor with which the inventor has always been regarded by the laws and courts of our country. Nor does a more ex-

tended and thorough examination of the subject disturb this first impression.

The very nature of the contract between the inventor and the Government, as representing the public, demands that all that the inventor be required to divulge, as a condition of the grant, shall be secured to him by the instrument through which disclosure is made. An inventor is not bound to let the public into his secret, but, if he does, the plain policy of the law is to protect him to the extent of the disclosure, by the very instrument by which the disclosure, the publication, the patenting, is effected.

If a man invents a new product that can only be produced by a new process, also of his invention, he can neither patent the one, nor the other, without disclosing both, and, therefore, he should have the right to cover both in a single patent.

In like manner, if he invents a new method that is only susceptible of being practiced by the use of certain new apparatus, which new apparatus cannot in turn be effectively worked without practicing the new method, he can neither patent the one nor the other, without disclosing both, and, therefore, should be accorded the right to cover both, in one patent. The principle is the same in both cases. He has the plain right of protection, in the instrument of disclosure, of all he is compelled to divulge in communicating either part of his invention to the public.

As to the indivisibility of process and product this court has spoken with no uncertain sound. In Powder Company *vs.* Powder Works, 98 U. S., 126, Mr. Justice Bradley said (p. 137):

> "The product in Goodyear's invention was the direct result of the process. They were parts of one invention, and except in imagination, could no more be separated from each other than the two sides of a sheet of paper, or than the shadow from the body that produces it."

The case which gave rise to this expression was one involving process and product, and therefore became a precedent in the Patent Office for the permissible joinder of process and product in one patent; but, we submit, the reasoning of the learned judge applies as well to a case of process and machine, where the process requires for its practice the disclosure and use of a particular machine, and the use of the machine necessarily involves the disclosure and practice of the process. The process and machine in such cases are inseparable. Each is incapable of description without disclosing the other. They are conceived together, and the reduction to practice of one is, at the same time, the reduction to practice of the other. Why should two things so nearly identical be required to be covered by separate patents? Doesn't common sense dictate that they should be included in one patent?

THERE IS NOTHING IN THE STATUTES REQUIRING DIVISION OF PROCESS AND MACHINE.

The next inquiry is, Is there anything in the statutes compelling a division of process and machine? Our answer to this is, emphatically, No. Some, indeed, have contended for a statutory requirement of division, but the reasons advanced in support of their views will not stand the test of criticism. The requirement, if it exists anywhere, must be found in Section 4886 of the Revised Statutes, which reads as follows:

> "SECTION 4886. Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in

public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Looking back at the Constitution, from whence the power of Congress to legislate in the matter of patents is derived, we find that, with the avowed purpose of promoting the "useful arts," Congress is given power to secure to inventors for limited times, the exclusive right to their "discoveries." The use of the word "arts," in this connection, is significant, as it indicates that everything that is to be protected under the laws of Congress *shall relate to some useful art*, the term art, above all others, being the most comprehensive that could be used.

In framing section 4886, Congress, instead of using the word "art" alone, took pains, in order that there might be no misunderstanding as to what might be considered to be comprehended by that term, to superadd the words "machine, manufacture, or composition of matter."

There was no attempt made in the section quoted to define how many inventions should be embraced in a single patent, the only object being to give an enumeration of patentable things, of patentable subjects-matter.

The section is to be read in a broad and liberal spirit and with an appreciation of the idea intended to be expressed by it. Had the purpose been to announce that a single patent could embrace only an art, or a machine, or a manufacture, or a composition of matter, apt terms would have been used to give expression to that idea, so that no doubt would have been possible as to what was meant.

This section has always been construed liberally and not technically. For instance, no one has ever doubted that a joint invention of two or more persons was patentable, though the words "any person," construed strictly, would exclude a plurality of persons.

Those who contend for a statutory requirement of division between process and apparatus insist that the statute is mandatory in this respect and inhibits the granting of a single patent covering both process and apparatus. If their position be correct, the converse must also be true, that is to say, where a patent is granted for both process and apparatus, it being a grant contrary to the statute, must necessarily be invalid. But no one has been able to find a single case in which a patent claiming both process and apparatus has been declared invalid, on that account. On the contrary, the books are full of cases in which a single patent covering both these parts of an invention has been adjudicated, sustained and found to be infringed.

Merrill *vs.* Yeomans, 94 U. S., 568, decided in 1877, was such a case. This Court found that the patentee had really invented a new process, a new product and a new apparatus. He presented, however but two claims. One of these was a claim for the apparatus and the Court found it to be good, but not infringed. The other was *either* for a process or for a product, and the Court was called upon to decide which. They decided it to be a claim for a process, and to be good, but not infringed. But the Court actually recommended the patentee to apply for a reissue to cover also the *product*, which he had failed to cover. The Court evidently considered it no vice for a single patent to cover process, apparatus and product, three things named in the statute as patentable subjects-matter.

Is it to be presumed that the Court overlooked the matter of misjoinder, if any such thing existed? Why, did they not, instead of worrying over a matter of construction of one claim and suggesting another for a different, so-called, statutory subject-matter, declare the whole patent void, at once, as combining a claim for a process with a claim for an apparatus, if there was a misjoinder?

But the most notable of these cases is the greatest patent case that has ever been tried in the courts of this country—

the Telephone Case (126 U. S., 1). There never was a case in which the interests involved were as great as in this. There never was a case in which more astute counsel, learned in the law of patents, were engaged. There never was a case passed upon by judges more skilled and experienced in and familiar with the principles of patent law and with their practical application.

In this great case, not only did the principal patent cover a process and apparatus, but both of these were embodied in a single claim.

The claim read as follows:—

> "5. The method of, and apparatus for, transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations, similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth."

Of this claim the Court said:—

> "The claim is first, for the process, and second, for the apparatus. It is to be read (1) as a claim for 'the method of transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth, and (2) as for 'the apparatus for transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations, * * * substantially as set forth.'"

The Court, in their opinion, said:—

> "In this art—or, what is the same thing under the patent law, this process, this way of transmitting speech—electricity, one of the forces of nature, is employed; but electricity, left to itself, will not do what is wanted. The art consists in so controlling the force as to make it accomplish the purpose. It had long been believed that if the vibrations of air caused by the voice in speaking could be reproduced at a

distance by means of electricity the speech itself would be reproduced and understood. How to do it was the question.

"Bell discovered that it could be done by gradually changing the intensity of a continuous electric current, so as to make it correspond exactly to the changes in the density of the air caused by the sound of the voice. This was his art. He then devised a way in which these changes of intensity could be made and speech actually transmitted. Thus his art was put in a condition for practical use.

"In doing this, both discovery and invention, in the popular sense of those terms, were involved: discovery in finding the art, and invention in devising the means of making it useful. For such *discoveries* and such *inventions* the law has given the discoverer and inventor the right to *a patent* —as discoverer, for the useful art, process, method of doing a thing he has found; and as inventor, for the means he has devised to make his discovery one of actual value."

The patent was upheld as a patent for both the process and the apparatus and infringement of the claim, in that double aspect, was decreed.

In view of this decree, and of the language we have quoted from the opinion, it certainly requires much temerity for any one to say that the point was not directly in judgment. That it was not argued is immaterial.

Is it to be dreamed that of all the astute lawyers for the defense in that case not one of them thought of the defense of misjoinder of inventions, if there was such a defense applicable, and is it to be presumed that the Court would have taken such pains to have dissected the invention of Bell and to have sustained claims for all its parts if the patent were invalid for misjoinder of inventions?

The Bell case was determined in 1887. In 1892 another case came before this Court involving a single patent, containing claims for a process and for an apparatus. This was the case of Hoyt *vs.* Horne, 145 U. S., 302. The court held

both claims to be good and the claim for the process to be infringed, reversing the judgment of the court below.

But cases are not wanting in which this fantastic defense of misjoinder of process and apparatus has been seriously urged, argued and directly decided.

In the Fire Extinguisher case, 21 Fed. Rep., 40, it was urged, and as distinctly and positively overruled by Judge Morris.

In his opinion Judge Morris says (page 44):—

> "The patent is further assailed by the respondents upon the ground (1) *that the patent as granted is for several separate and distinct inventions, and therefore void;* (2) that the specifications are deceptive and misleading, and therefore the patent is void; (3) that the patent covers an invention different from that set forth in the application.
>
> "As to the *first* point, the claims for which the patent was granted are four. The first and fourth are for the method of extinguishing fires by a properly directed stream of mingled carbonic acid gas and water escaping from pressure, and projected by its own expansive force; the second claim is for a portable apparatus by which the method or process could be usefully applied; and the third is for a stationary apparatus for the same purpose. If these are all proper subjects of claim, and are all inventions found in the application of Graham, then the language of the act of Congress which authorizes the Commissioner to issue a patent for whatever invention or inventions, where found in the application, is sufficient to justify his action. This was held sufficient in Evans *vs.* Eaton, 3 Wheat., 506. It was decided by the Supreme Court in Hogg *vs.* Emerson, 6 How., 483, that two or more patents may be united if they relate to a like subject, or are in their nature or operations connected together. Walk., Sec. 180. *The nature of the several claims of this patent is such that the granting of them in one patent, it seems to me, might be justified by this rule.*"

In the Patent Office, different Commissioners have ranged themselves on opposite sides of this question of the necessity of division between process and apparatus.

Division according to the so-called statutory requirement has been insisted upon by Commissioners Butterworth, Hall and Duell, and the contrary view has been vigorously maintained by Commissioners Montgomery, Mitchell and Simonds. Commissioner Butterworth gave expression to his views in Blythe's case (1885 C. D., 82); Commissioner Hall in Herr's case (1887 C. D., 105); Commissioner Montgomery in Young's case (1885 C. D., 108); Commissioner Mitchell in Lord's case (1890 C. D., 16); Commissioner Simonds in Curtis' case (1891 C. D., 206), and in Kerr's case (1892 C. D., 61); and Commissioner Duell in Boucher's case (1899 C. D., 133).

All of the Commissioners who have contended for a so-called statutory requirement of division have been compelled to admit an exception which is absolutely fatal to their main contention, *since it is not an exception to be found in the statute itself.* We refer to the joinder of process and product. There is no more justification for the exception of process and product than for process and apparatus. If a product, which is the result of the practice of an art, may be claimed in connection with the art itself, in a single patent, no good reason can be found for holding that an apparatus or machine for practicing an art may not be claimed in connection with the art itself, in a single patent.

It is said that process and product may be embraced in the same patent because, when the process produces the product and the product is produced only by the process, they are, in fact, the same invention, inseparable the one from the other. But is this not also true in many cases, of art and machine, of process and apparatus? Every improvement in a "machine" is an improvement in an art, "a useful art," or it is not patentable. Why, then, in reason, may not a single patent embrace a claim for an art and for a machine

which practices it? They are, oftentimes, inseparable, just as truly as are process and product. They "can no more be separated from each other than the two sides of a sheet of paper or the shadow from the body that produces it," to again quote Mr. Justice Bradley.

Take Bell's case, for example. He conceived of the possibility of transmitting speech, electrically, in a certain way, by a certain process. But that conception alone did not entitle him to a patent. It was only when he devised and constructed an apparatus by means of which that process could be carried into execution that, under the law, he made a patentable invention of any kind. The actual production of the whole patentable subject-matter was therefore accomplished by a single final act, the production of the competent apparatus.

Both being thus parts of the same inventive act, both being thus simultaneously born, linked together like Siamese twins, who will be bold enough to say that they were not parts of the same invention?

The Telephone case projects itself into this discussion in another way.

It will not do to say that in that case the method or process claimed was but the function of the apparatus, and that there was but one invention,—an invention of apparatus, or an invention of a process, but not of both.

It was claimed by the defendant Dolbear that the Bell patent was limited to the magneto-apparatus and magneto-method, which the defendant Dolbear did not use, but the Court said, in answer to this contention—

> "An effort was made in argument to confine the patent to the magneto-instrument and such modes of creating electrical undulations as could be produced by that form of apparatus, the position being that such an apparatus necessarily implied 'a closed circuit incapable of being opened, and a continuous current incapable of being intermittent.' But this argument ignores the fact that the claim is, first, for

the process, and, second, for the apparatus. It is to be read, 1, as a claim for 'the method of transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth;' and, 2, as for 'the apparatus for transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations, * * * substantially as set forth.' The method, 'as herein described,' is to cause gradual changes in the intensity of the electric current used as the medium of transmission, which shall be exactly analogous to the changes in the density of the air, occasioned by the peculiarities in the shapes of the undulations produced in speech, in the manner 'substantially as set forth;' that is to say, 'by the vibration or motion of bodies capable of inductive action, or by the vibration of the conducting wire itself in the neighborhood of such bodies,' which is the magneto-method; or 'by alternately increasing and diminishing the resistance of the circuit, or by alternately increasing and diminishing the power of the battery, which is the variable resistance method. This is the process which has been patented, and it may be operated in either of the ways set forth. The current must be kept closed to be used successfully, but this does not necessarily imply that it must be so produced, or so operated upon, as to be incapable of being opened. If opened, it will fail to act for the time being, and the process will be interrupted; but there is nothing in the patent which requires it to be operated by instruments which are incapable of making the break.

"The apparatus, 'as herein described,' which is included in the claim, is undoubtedly one in which an electro-magnet is employed, and constructed 'substantially as set forth' in the specification. One acting on the variable resistance mode is not described, further than to say that the vibration of the conducting wire in mercury or other liquid included in the circuit occasions undulations in the current, and no other special directions are given as to the manner in which it must be constructed. The patent is both for the magneto

and variable resistance *methods*, and for the particular magneto *apparatus* which is described, or its equivalent. There is no patent for any variable resistance apparatus."

The court accordingly found, in Dolbear case, infringement of the method and not of the apparatus.

THE RELATOR'S INVENTION.

The invention of the relator is extremely complex and difficult of comprehension save by a skilled electrician. It belongs to a small but important class of cases constantly brought to the attention of the Patent Office, in which the novelty relates to the mysterious action of alternating electric currents and magnetic fluxes. The invention is founded on the conception that the 90° relation which was formerly supposed to be an essential characteristic of the alternating watt meters, is not necessary, provided three or more fluxes are used, and provided that these fluxes are properly proportioned in magnitude and phase. This conception being attained and the proper relation having been worked out, the invention, as far as the broad claims are concerned, is made. The conception involves not only the method of operation of the instrument, not only the complex interaction of the magnetic fluxes and electric currents, but also a motor meter having coils, etc., so wound, related, and proportioned as to carry out the method. It would be impossible to disclose the method to a skilled electrician without putting him in possession of information by which he could immediately and without invention work out the broad features of the apparatus. On the other hand, it would be impossible to describe the apparatus to a skilled electrician in such a way that he really understood it without putting him in possession of the method.

In order to show how intimately the method and ap-

paratus are related, we contrast below, in parallel columns, method claim 6 and apparatus claim 7:

METHOD	APPARATUS
Claim 6.	*Claim* 7.
The herein-described method of actuating an alternating-current motor meter,	In a watt meter for alternating electric currents,
which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines	
one magneto-motive force being proportional to the current	means for producing a magnetic flux proportional to the current and varying in phase therewith
and the other *two* to the electro-motive force,	means for producing a second magnetic flux proportional to the electro-motive force and lagging in phase behind the same, and means for producing an auxiliary flux along a line at an angle to said second flux and of such magnitude and phase that
the several magneto-motive forces being so proportioned and related to each other that the resultant of the last two is displaced in phase from the first by the complement of the angle of lag, and subjecting an armature to the inductive action of said field.	the resultant of the two last-mentioned fluxes will lag behind the first by the complement of the angle of lag.

It is quite clear, in view of Westinghouse *vs.* Catskill, 94 Fed., 868–871; Tesla *vs.* Scott, 97 Fed., 588, and Westinghouse *vs.* Dayton, 106 Fed., 724, that all the method claims are patentable, as they stand, and are not for the mere function of the apparatus; but relator fears that if two patents are taken out, one for the method and the other for the apparatus, it might be necessary, in accordance with the ruling in the Accumulator cases (52 Fed., 137), to elect which of these two patents he would choose to rely upon. If he elected to retain the method and abandon the apparatus, he would be obliged to proceed against all manufacturers under the doctrine of contributory infringement, and would also be obliged to abandon any detail apparatus claims which he might make in the case. If, on the other hand, he elected to abandon the method claims and relied entirely upon the apparatus claims, he would lose some of the most important claims in the case and very likely might be unable to successfully proceed against some infringer utilizing the real gist of his invention.

No case could be presented illustrating better the hardship of requiring division.

Aside from the Commissioner's arbitrary rule on the subject, no reason has been advanced, or can be advanced, why there should be division. The method and apparatus claims do not fall within different classes of invention according to official classification; they go to the same class. They are not required to be examined by different examiners; they go to the same examiner. They require no further examination, at all; they have been examined on their merits and the examiner and the Commissioner have both declared all of them allowable (p. 12).

THE PATENT OFFICE RULE AS TO JOINDER WHEN RELATOR'S APPLICATION WAS FILED.

In 1896, when the relator's application was filed, the rules promulgated by Commissioner Simonds, April 1, 1892, were in force. The rule as to joinder of inventions read as follows (p. 12):

> "41. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application."

Inasmuch as claims for a process or method and claims for a machine for carrying out that method "are often dependent upon each other and mutually contribute to produce a single result," such claims were, in proper cases, permitted, under this rule, to be placed in a single application, as decided by Commissioner Simonds in Curtis' case (1891 C. D,. 206) and in Kerr's case (1892 C. D., 61).

When Commissioner Duell, the respondent's immediate predecessor, began to tinker with the rule, he made an addition to it, which he caused to be italicised, so that the rule, as a whole, read as follows (Rules, July 18, 1899):

> "41. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application.
>
> "*A machine, a process and a product are separate and independent inventions, and claims for each must be presented in a separate application.*"

The promulgation of this italicised addition raised a storm of protest from members of the patent bar and others throughout the country, and resolutions condemnatory of the amendment were passed by the Patent Law Bar Asso-

ciation of Chicago, and by the Patent Bar Association of Washington, and the subject was investigated and reported upon by a Committee of the Patent, Copyright and Trade-Mark Section of the American Bar Association (Reports Am. Bar Ass'n, 1900, p. 553), and Commissioner Duell was memorialized by all these bodies to strike out his amendment. The most that he would do, however, was to modify his amendment so as to permit the claiming of process and product in the same application. As thus modified, the rule took its present form, viz:

> "41. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application.
>
> "*Claims for a machine and its product must be presented in separate applications.*
>
> "*Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications.*
>
> "*Claims for a process and its product may be presented in the same application.*"

The effect of Mr. Duell's amendments, upon relator's case, was to render illegal (from the standpoint of the Office) an application that was perfectly legal and proper when it was filed, nearly three years before!

It was a breach of faith to demand of relator a division of his application, at so late a day, and it is to repeat it now.

The old rule, so far as it was not inconsistent with law, had the binding effect of the statute itself and was and is as operative upon the Office as it was and is upon applicants.

Whatever else may be said of a Commissioner's power to make rules, he certainly cannot make such as are retrospective in their operation. He cannot, by rule, take away the vested rights of applicants. He cannot, by rule, increase the cost of applicant's protection 100 per cent., or at all, after application filed.

This line of argument of course tends most strongly to show why the relator's application should be relieved of the oppression of the *new* rule, but it also illustrates the general abuse of the rule-making power of the Commissioner which we criticise elsewhere in this brief.

THE RELATIVE WEIGHT TO BE GIVEN THE DECISIONS OF VARIOUS COMMISSIONERS.

Now, what relative weight is to be given the decisions of the various Commissioners on this subject of joinder? Commissioners Butterworth and Hall went to their posts without previous preparation in patent law or practice and their decisions on this subject of joinder were therefore those of inexperienced patent lawyers and, moreover, were made in 1885 and 1887, respectively, before the Telephone case was decided, and, apparently, without any consideration of the Fire Extinguisher case. Commissioners Mitchell and Simonds succeeded Mr. Hall, in the order named. Both were patent lawyers of ripe experience and both held that joinder of process and machine was admissible. Mr. Mitchell was especially competent to deal with the subject. He came to the Office with a national reputation for ability of the first class. He was one of the leaders of the patent bar. He came not to learn patent law, nor to make it; but to expound and administer it; which he did, most ably. No one will dissent from this.

At an early day, the question we have now under discussion was presented to him and, in the well-considered case of *Ex parte* Lord (C. D. 1890, p. 16) he examined the whole subject, including the Butterworth and Hall decisions, the Telephone case, Merrill *vs.* Yeomans, and the Fire Extinguisher case, and came to the deliberate conclusion that his predecessors, Commissioners Butterworth and Hall, were wrong and out of harmony with the decisions of this Court; that there was no so-called statutory requirement sepa-

rating process from product, or process from apparatus, and that where these several and distinct parts of an invention are dependent upon each other and mutually contribute to produce a single result, they may be embraced in a single patent. How any one, after reading Mr. Mitchell's masterly exposition of this subject, can have any doubt of the correctness of his views we are at a loss to understand. His decision would make a good brief for this case, and we commend it to the careful consideration of the Court.

The argument of Mr. Commissioner Duell in favor of statutory classification is contained in his decision in *Ex parte* Boucher, C. D. 1899, p. 133; but, subsequently to that decision, he was obliged to admit the unsoundness of it by conceding an exception which the statute did not make, *i. e.*, the joinder of process and product, and by amending his rule so as to permit joinder of those subjects-matter. In the Boucher case he admits that no decision can be found invalidating a patent because embracing claims for process and apparatus. He intimates that no decision has ever been made squarely upon the point, but says—

> "If a case is ever presented for consideration which compels the decision of the question I fail to see how the patent can either lawfully or logically be upheld."

But in saying this he overlooks the Fire Extinguisher case, in which the precise point was directly decided, and he overlooks the controlling authority of the Telephone case, which decides, point blank, that a single patent for process and apparatus is valid and that it is proper to embrace both these subjects in a single patent.

His ground for presuming that if a case did arise involving the point the patent would be held to be invalid is based upon an entire misconception of the rulings of the Supreme Court in reissue cases.

He says:

> "I am of the opinion that if an ordinary case comes before the court for consideration where it becomes necessary to decide the question in view of the decisions of the courts in reference to reissue patents with claims for the process which originally contained claims only for the apparatus, the chances very much favor a decision holding the patent under consideration to be invalid."

If he had investigated, closely, he would have found that in those reissue cases the reissues were declared invalid, not because it was improper to join claims for a process and for a product, or for a process and an apparatus, in the same patent, but because the reissue of a process patent into a product patent, or of a product patent into a process patent, or of a process patent into an apparatus patent, or of an apparatus patent into a process patent, or of an apparatus patent, with a limited claim, into an apparatus patent with a broad claim was not permissible, since, *in each of the cases mentioned*, the reissued patent would not be for the *same invention* as the original patent, that is, would not claim the same invention as that *claimed* in the original patent.

In James *vs.* Campbell, 104 U. S., 356, an apparatus patent was reissued into a process patent and the latter was declared invalid; in Powder Co. *vs.* Powder Works, 98 U. S., 136, a process patent was reissued into a product patent and the latter was declared invalid; in Miller *vs.* Brass Co., 104 U. S., 350; Parker & Whipple Co. *vs.* Yale Clock Co., 123 U. S., 87, Hoskins *vs.* Fisher, 125 U. S., 217, Yale Lock Co. *vs.* James, 125 U. S., 447, and in many subsequent cases, machine or apparatus patents, with narrow claims, were reissued into machine or apparatus patents, with broad claims, and the latter were declared invalid.

In all these cases, covering almost every phase of the subject, the reissues were deemed bad because not for the same inventions patented, *i. e., claimed*, in the originals. There

was no ruling, in any of them, to the effect that no single patent could contain claims for process and apparatus, any more than there was a ruling that a single patent could not contain process and product claims, or broad and narrow claims for apparatus. All that was decided, in any of the cases, is consistent with the soundness of our contention that claims for process and apparatus, process and product, and broad and narrow claims for apparatus, may be lawfully joined in a single patent.

The only prohibition this Court has ever put upon the right to include several distinct and separate parts of an invention in a single patent, is found in the case of Hogg *vs.* Emerson, 6 How., 483, where the Court said :

> " But it is a well established exception that patents (inventions) may be united, if two or more included in one set of letters relate to a a like subject, or are in their nature or operation connected together."

In that case the patentee's, Emerson's, claims covered :

> (1.) A cam cylinder and pin on a piston rod, as a substitute for a crank, in a steam-engine.
> (2.) A spiral propelling wheel for a boat.
> (3.) A revolving vertical shaft to turn a boat's capstan.

All these instrumentalities were shown as mounted and used upon a boat. The patent successfully withstood a second assault, at a second hearing, on a larger record.

Hogg *vs.* Emerson, 11 How., 587.

The whole tendency of the courts has of late years been towards the condemnation of undue subdivision of invention and of undue multiplication of patents.

In Electric Accumulator Company *vs.* Brush Electric Company, 52 Fed. Rep., 137, the Circuit Court of Appeals for the Second Circuit said :

> "The result of this subdivision of the main invention, the alteration of specifications, and the grant of divisional patents at different dates, was to make an entangled mass of patents, which are to some extent intertwined with each other,—a confusion which has caused perplexity to experts, counsel, and judges and which has endangered the strength and the validity of the patents themselves."

And the tendency on the part of the Patent Office to require too much subdivision of invention is strongly condemned by Judge Lacombe in Johns Mfg. Co. *vs.* Robertson *et al.*, 89 Fed. Rep., 506, as follows:

> "For some unexplained reason (probably because of some arbitrary rule of the Patent Office), instead of allowing a reissue, with appropriate claims, the Office on the same day allowed two separate reissues—the one above quoted, and another, numbered 10,375, which purports to cover practically the same invention, only not restricted as to the composition of the non-conducting sheets. This practice of so-called 'divisional issue' has been most unfortunate for patentees. Witness the result in Underwood *vs.* Gerber, 149 U. S., 224; 13 Sup. Ct., 854. And, as was to be expected, the defendants contend that No. 10,376 is anticipated by No. 10,375. Fortunately, in the case at bar it will not be necessary to deprive the inventor wholly of his patent because the Patent Office saw fit to split it into two."

We have here given more attention to the arguments for and against a statutory requirement of division of process and machine than the subject, perhaps, deserves, in view of the fact that the respondent, the present Commissioner, apparently has no confidence in it, since he defends solely on the ground that the matter of division rests entirely in the *discretion* of the Commissioner and that the Commissioner's opinion on the matter, in any given case, is final.

THE ALLEGED DISCRETION OF THE COMMISSIONER IN REQUIRING DIVISION OF PROCESS AND MACHINE.

That the Commissioner of Patents has an unreviewable discretion in the determination of the important question as to whether claims for a process and for the apparatus for carrying the process into effect shall be embraced in one or more patents, we emphatically deny.

Such discretionary power is claimed to be derived from his power to make regulations for the conduct of proceedings in his office, conferred by Sec. 483, Revised Statutes which reads as follows:

> "§ 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

Now, some of the evils that grow out of requiring an inventor to take two distinct patents, one for his process and the other for his machine for carrying that process into effect, are these:

(*a.*) The inventor cannot patent the process without disclosing the machine, nor the machine, without disclosing the process, and the issue of a patent for either, alone, puts the public in possession of the other before it is protected by patent, with all the attendant embarrassing consequences.

(*b.*) The inventor is required to pay double fees; meaning by this, not only double fees to the Government for the examination and for the preparation of the patent, but double fees to the solicitor for the preparation and prosecution of the two cases.

(*c.*) The two patents may become the property of different owners.

(*d.*) Infringers may be subject to two independent suits, either by the same or by different plaintiffs.

(*e.*) The two patents, if granted, one for the process and the other for the machine, may, if issued at different times, become public property at different dates, to the embarrassment of the public.

(*f.*) The owner of the process patent is liable to suit at the hands of the owner of the machine patent to prevent him from using the machine as the best and only means of practicing the process.

(*g.*) The owner of the machine patent can sell machines without, perhaps, conferring upon the purchaser the right to practice the process intended to be practiced by it, and the owner of the process patent can grant a right to use the process without, perhaps, conferring the right to use the only machine that can practice it.

(*h.*) The machine patent may be sold to a purchaser who has no knowledge of the pedency of an application for an after-issued process patent, and *vice versa.*

(*i.*) It gives no opportunity to the inventor to claim, in a single patent, an invention, in both aspects, where doubt exists, whether the real invention is a process or a machine.

Take the Bell Telephone Patent, for instance. Who would, in advance of the adjudication, have risked deciding that the invention was either in the process or in the apparatus, and what wisdom was shown in making and securing, in the same patent, claims covering both?

Not only has the solicitor to contend with his own doubt, but he has to take into consideration the possible frame of mind of the judge who may be called upon to adjudicate the patent.

How will the judge view the matter? May he not say, if the claim is, in form, for a process, that the invention is really for an apparatus, and that an apparatus is not claimed; or, on the contrary, if the claim is, in form, for an apparatus, may he not decide the invention to be an apparatus, which the defendant does not use, and not for a process, which the defendant does use?

In Boyden *vs.* Westinghouse, 170 U. S., 537, this Court, of its own motion, ordered a rehearing and reargument on the question, whether one of the claims in issue was a claim for a machine or a claim for a process.

But if the solicitor is permitted to put both claims in the same patent, as he should be, then the real invention is covered, whether viewed as a process or as an apparatus, and the infringer is held.

There should be the same latitude accorded inventors in the statement of their invention as both process and apparatus that is accorded inventors of generic inventions relating to process and product, or wholly to process, or wholly to apparatus.

Can it be said, then, that the authority of the Commissioner to make rules governing mere procedure can extend to the power to make rules affecting so profoundly as this the fundamental rights of inventors? Is it a mere regulation of proceedings to require an inventor to split up a really indivisible invention into parts, with the possibility of losing protection for one of the most valuable parts by so doing? Is it a mere regulation of proceedings to require an inventor to pay two sets of fees instead of one,—to increase the cost of his protection 100 per cent.?

We contend that to require the applicant to divide his case and file a second application is to impose a condition upon his right to a patent not found in the Statutes, and, perhaps, impossible of performance. The applicant may not have the funds for another application; he may be at the end of his resources. If so, compliance with the Com-

missioner's request means the absolute loss of a very valuable part of his invention, or of the whole of it if he decide to patent it, as a process, when he should have patented it as as apparatus, or *vice versa*.

The protection of the inventor has always been a matter of special solicitude on the part of Congress, and Congress never intended that the cost of a patent to him should depend upon the whims of Commissioners of Patents.

When Congress fixes the cost of a patent the Commissioner has, plainly, no authority to add a dollar thereto. No usage in regard to making an excess charge can legalize it, and the excess can be recovered back by suit (Ogden *et al. vs.* Maxwell, 3 Blatch., 319; S. C., Federal case No. 10458). In the case last mentioned, which was a suit brought against the collector of the port of New York for the recovery of fees illegally exacted, Judge Betts said:

> "The transactions at a collector's office, which are made subject to charges or fees, are enumerated in the statute and the compensation to be collected for each act done by him is specially stated. In the levy of these emoluments he is governed by the limitations no less than by the express directions of the statute. No equity or usage in respect to these rates of compensation can be appealed to, as a sanction for a departure from the terms of the act. * * * The statute gives no reward except for doing the individual act named, and no consideration of convenience to either or both of the parties or saving of expense by substituting another practice in place of that directed by law will authorize a collector *colore officii*, to charge and receive compensation for a service differing from that appointed by positive law.
>
> "Numerous adjudications of the courts of the United States in this District have declared that when a rate of fees to an officer of court is established by statute for a particular service it is illegal in the officer to charge or accept a greater fee for that service.
>
> "The rule is equally stringent in the State courts,

> An action of assumpsit will lie by the party making payment against the officer to recover back the overcharge. (M'Intyre *vs.* Trumbull, 7 Johns., 35.) And, if the act be done corruptly, it is extortion and subjects the officer to indictment. (People *vs.* Whaley, 6 Cow., 661.)
>
> "The custom or usage alleged to prevail at this port to make constructive charges for granting permits, whatever may be its notoriety or continuance, is void, both because it contravenes the spirit of the statute and also because there is no warrant of law, except under the statute, for imposing any charge or fee for that official act. The defendant would, without the aid of the statute, be guilty of extortion in levying fees of any kind for his official services."

This Court, in Swift & Courtney & Beecher Co. *vs.* United States, 111 U. S., 22, quoted with approval Judge Betts' ruling, saying:

> "And in Ogden *vs.* Maxwell, 3 Blatch., 319, it was held that illegal fees exacted by a collector, though sanctioned by a long-continued usage and practice in the office under a mistaken construction of the statute, even when paid without protest, might be recovered back on the ground that the payment was compulsory and not voluntary."

Clearly, then, the Commissioner's power to make mere regulations cannot be used as a cloak for requiring the division and separate patenting of the parts of a really unitary and indivisible invention, nor for exacting a double set of fees from an applicant.

If any such power was intended to be given, Congress would have, in terms, conferred it. It cannot be inferred from a mere permission to make rules regulating procedure.

COMMISSIONER IS NOT SUSTAINED BY DECISIONS OF THIS COURT.

There is no adjudicated case to which our attention has been called in which the so-called discretionary power of the Commissioner, as to requiring division of applications for original patents, was directly in judgment.

The respondent referred to two cases in his brief in the court below, namely, Bennett *vs.* Fowler, 8 Wall., 445, and McKay *vs.* Dibert, 19 O. G., 1351; C. D. 1881, 238, but neither of them reaches to the point.

In Bennett *vs.* Fowler two *reissued patents*, carved out of a single original patent, were in suit, and the defendant contended that the Commissioner had exceeded his authority in permitting the reissue in two divisions, and the point was overruled. What was said by the Court, in a general way, about there being some discretion in the Commissioner in the matter of division, must be held to apply reissued patents only, for such patents only were involved in that case, and, furthermore, must be taken in connection with the then existing statute, Sec. 5, of the Act of 1837 (5 Stat., 191) [amendatory of the Sec. 13 of the Act of 1836 (5 Stat., 117)], which provided for an option on the part of an applicant for reissue as to whether he should take one or several reissued patents, as follows:

> "SEC. 5. That, whenever a patent shall be returned for correction and reissue under the thirteenth section of the act to which this is additional, *and the patentee shall desire several patents to be issued for distinct and separate parts of the thing patented*, he shall first pay, in manner and in addition to the sum provided by that act, the sum of thirty dollars for each additional patent so issued," etc., etc.

The fact that "distinct and separate parts of the thing patented," in the original patent, could be covered by separate

reissues, at the option of the applicant for reissue, indicates clearly that it was no vice to cover in a single original patent the said "distinct and separate parts" of the invention.

In McKay *vs.* Dibert, an original patent for a machine was issued to the inventor, Blake. After it was issued the same inventor applied for a second patent, claiming, first, a process, and, secondly, a product—an article of manufacture. The Commissioner advised him that he could not claim both process and product in the same patent (it is different now, for Rule 41 allows the claim of process and product in the same application); whereupon he struck out the claim for the product and filed a new application therefor. Two patents, one for the process and the other for the product, were subsequently granted him, on the same day.

The first patent, that for the machine, having expired while the later patents for process and product still remained in force, an infringer used the machine of the expired patent, and, in such use, practiced the process of the unexpired process patent and made the product of the unexpired product patent, claiming the right to do this by virtue of the expiration of the machine patent.

On these facts, the Court, Judge Nixon, observed (C. D. 1881, p. 240):

> "We have thus presented for consideration an interesting and novel question. All embarrassment would have been avoided if the officers of the Patent Office had required the inventor, when he applied for the process and product patent, to surrender his original patent for the mechanism, and had then made three several reissues for the machine, the process and the product, all bearing the same date and expiring at the same time. Such course was pursued in the case of The Rubber Company *vs.* Goodyear, 9 Wall., 788), where the inventor first patented the process and afterward surrendered the letters patent and took his reissue in two several patents, one for the product and the other for the process of the product; but such a step was not required in the present case,

> and it is a fair inference, from what was decided in Bennett *vs.* Fowler, 8 Wall., 445, that the courts have no absolute control over the head of the Patent Office in the exercise of his discretion whether a given invention or improvement shall be embraced in one, two or more letters patent."

Certainly, neither of these cases can be said to be of controlling authority on the question presented by this record.

It is not contended that, in all cases, process and apparatus claims are proper to be joined in a single patent, and the ancient part of Rule 41 provides for this.

Cases will be presented where process claims, so-called, are in reality but claims for the functions of an apparatus. Such claims, on examination, will be rejected for that reason. But the applicant is entitled to present his claims for both process and apparatus in a single application, as covering parts of his fundamental invention, and to have the judgment of all the statutory tribunals on the question of his right to make such claims.

The present rule is arbitrary, by requiring division without any determination whatever of the question of right to the claims.

In the present case no discretion has been exercised in dealing with this particular application and determining whether it is of such a character that its process and apparatus are or are not dependent, or so disunited as to require division. The Examiner has declined to look into the application. He held himself bound by a hard and fast rule.

The Examiners, the Examiners-in-Chief, and the Commissioner, acting as an appellate tribunal, are all judicial officers, as this court has twice decided (Butterworth *vs.* Hoe, 112 U. S., 50; U. S. *vs.* Duell, 172 U. S., 576), and the duty of determining whether an application contains claims for inventions which "are dependent upon each other and mutually contribute to produce a single result," or even of deciding whether the claims, in a given case, are all for a

process or all for a machine, or are some for a process and some for a machine (a question that bothered this court in Boyden *vs.* Westinghouse, 170 U. S., 537), is clearly a judicial duty, involving, oftentimes, the nicest application of the rules for the interpretation of patents.

The Commissioner's theory of the operation of present rule 41 is manifestly incorrect. His contention is that the action of the Examiner, under the rule, relates to mere matter of form and procedure and does not affect at all the merits of the application.

Of course the Examiner's action affects the merits; in the nature of things it must do so. That claims are alike or different in their nature is a judicial question and its resolution is a judicial determination, and, as such, is appealable.

If as the Commissioner contends the present rule requires division without examination,—without any determination whatever of the right to the claims, the division required by it might just as well be done by the application clerk as by the Examiner, for the latter's action under it is purely perfunctory. He might upon opening the application see that the first claim is for a process and the next is for an apparatus, and, without any inquiry whatever as to patentability, call upon applicant to divide, pursuant to Rule 41. This is what he has done, in effect.

And then a most extraordinary thing occurs. When applicant looks to the next rule (Rule 42) to see what he must do to meet the Examiner's requirements, he finds this confronting him, as the first paragraph of that rule—

> "42. If several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them, the inventor will be required to *limit the description, drawings and claim* of the pending application to whichever invention he may elect."

Now, it will be remembered he has claimed, originally, process and apparatus, and, of course, has described and shown in his application a competent and, perchance, the only known apparatus for executing the process, in strict obedience to the requirements of Secs. 4888 and 4889 of the Statutes.

This other rule (42) now requires that, if he will hold on to his claim for process, he must strike from his specification and drawings the only thing that can support his process claim—*i. e., the description and illustration of a way in which the process may be worked.*

Nothing could better illustrate the unsoundness of Mr. Duell's amendments. They render the other rules and the statute itself ridiculous.

This is a great question. Mr. Duell's amendments have not settled it. His prophecy that it might be regulated by his rule has not been realized. The trial that he says in the last paragraph of his decision in the Boucher case should be made has been made, and the great unrest exhibited by the bar at large shows that the trial has been a failure. Resistance to the Rule will not down. The matter has been discussed at large by the bar. As hereinbefore stated, it has been made the subject of careful and painstaking examination by the Patent Section of the American Bar Association, by the Patent Bar Association of Chicago, and by the Patent Bar Association of Washington, and all of these bodies have passed resolutions condemning the Rule. Nothing could be more disinterested than the position of the bar upon this subject. Division makes business and doubles fees for both solicitors and lawyers, and yet hardly a respectable member of the bar can be found who does not regard the Rule, in its present form, as arbitrary, unjust, oppressive and a reproach to the administration of the patent system.

THE RIGHT OF APPEAL.

So far, we have attempted to show the inherent right of an inventor to a single patent covering all he is compelled to disclose as the condition of the grant to him of any protection, and to show the absence of any statutory authority to require him to divide up his invention and take multiple patents for its parts. We will now endeavor to show that whenever an application for patent is a second time refused by the Primary Examiner because, as in the case at bar, it contains claims to a process that can only be practiced by the use of a certain machine and also claims to the machine for practicing such process, the applicant is entitled to an appeal from the Examiner's ruling, to all the statutory appellate tribunals, in turn, and upon a favorable decision of any of such tribunals, is entitled to have a patent issued to him.

HISTORY OF THE EXAMINATION SYSTEM.

As this branch of the discussion involves a somewhat exact knowledge of the present jurisdiction and powers of the various officers and tribunals in and out of the Patent Office charged with the duty of determining the rights of applicants for patents, we will first draw the attention of the Court to the origin and development of the scheme of examination so characteristic of the American patent system.

Under the original Patent Act of 1790 (1 Stat., 109) the Secretary of State, the Secretary of War and the Attorney General, or any two of these officials, were given power to grant patents for inventions which they "deemed sufficiently useful and important."

No examination as to novelty or originality was required to be made.

By the Act of 1793 (1 Stat., 318) the Secretary of State was substituted for the tribunal of three created by the prior act;

but still no examination for novelty or originality was required.

By the Act of 1836 (5 Stat., 117) a separate Bureau of the Department of State was established, to be known as the Patent Office, and the office of Commissioner of Patents was created.

Section 7 of the Act required the Commissioner "to make, or cause to be made, an examination of the alleged new invention or discovery" for novelty, utility, originality, etc.

The Commissioner was, by Section 2, given authority to appoint an Examining Clerk to assist him in his duties, but the responsibility of the examination and of action thereupon was laid upon the Commissioner himself.

Where an applicant, after a second rejection by the Commissioner, refused to modify his specification and claim, he might, under Section 7, appeal to a Board of Examiners, consisting of three disinterested persons appointed by the Secretary of State, "one of whom, at least," was selected, "if practical and convenient, for his knowledge and skill in the particular art, manufacture or branch of science to which the alleged invention appertains." On such an appeal the Commissioner was required to certify to the Board of Examiners his opinion and decision, "stating the particular grounds of his objection and the part or parts of the invention which he considers as not entitled to be patented," and the Board had power "to reverse the decision of the Commissioner either in whole or in part, and their opinion being certified to the Commissioner" the latter was "governed thereby in the further proceedings to be had on such application."

The applicant was required to pay into the Treasury twenty-five dollars on the taking of his appeal, and each member of the Board was entitled to receive a sum not exceeding ten dollars for his services in determining the appeal.

The Act of 1837 (5 Stat., 191), section 11, authorized the appointment of an additional Examining Clerk to assist the Commissioner in the discharge of his duties.

Under the Act of 1839 (5 Stat., 353) the examining force was increased by the appointment of the two (2) Assistant Examiners.

The act also gave an appeal from the Commissioner to the Chief Justice of the District Court of the United States for the District of Columbia in substitution for the appeal to the Board of Examiners theretofore allowed.

The appeal fee remained at $25 (section 1) and the Chief Justice received annually an additional $100, in consideration of the special duties thus imposed upon him.

By section 10 of the act the applicant was given the right to file a bill in equity where his patent was refused "for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia upon appeal from the decision of said Commissioner."

By the Act of 1848 (9 Stat., 231) the examining corps was authorized to be further increased by the appointment of two (2) additional Principal Examiners and two (2) additional Assistant Examiners.

By the Act of 1849 (9 Stat., 395) the Patent Office was transferred to the Department of the Interior.

By the Act of 1852 (10 Stat., 75) the right of appeal from the Commissioner was extended to include an appeal to the Assistant Judges of the Circuit Court of the District of Columbia, and the appeal fee of $25 was required to be paid over by the Commissioner to the Chief Judge or Assistant Judge called upon to determine any particular case.

By the Act of 1855 (10 Stat., 670) four (4) more Principal Examiners and four (4) more Assistant Examiners were added to the force.

By the Act of 1856 (11 Stat., 91) two (2) more Principal Examiners and two (2) more Assistant Examiners were added.

The Act of 1861 (12 Stat., 246), recognizing apparently the need of an independent appellate tribunal in the Patent Office between the Principal Examiners and the Commissioners, created the present tribunal known as the Board of Examiners-in-Chief.

Section 2 of the Act reads as follows:

> "SECTION 2. *And be it further enacted*, That for the purposes of securing greater uniformity of action in the grant and *refusal* of letters patent, there shall be appointed by the President, by and with the advice and consent of the Senate, three Examiners-in-Chief, at an annual salary of three thousand dollars each, to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners *when adverse to the grant* of letters patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases, and when required by the Commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said Examiners-in-Chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents."

The passage of this Act of 1861 was productive of profound consequences in the administration of our patent system. The Principal or Primary Examiners (as they are indifferently called) instead of remaining mere clerks to the Commissioner became independent tribunals of first instance. From their favorable decisions no appeal lay. From their adverse decisions appeal was given, at first without fee, to the Board of Examiners-in-Chief; from adverse decisions of the latter tribunal appeals lay to the Commissioner in person,

and from decisions of the Commissioner appeals lay to the Judges of the Circuit Court of the District of Columbia.

The fate of an applicant no longer depended alone upon the judgment of the Commissioner of Patents himself—who was not a permanent officer and often a mere politician, unversed in patent law or any other kind of law—but, in the first instance, upon the judgment of the Primary Examiner and then upon the new special tribunal—the Board of Examiners-in-Chief—composed of officers required to be "persons of competent legal knowledge and scientific ability."

It is true that the Board might be reviewed by the Commissioner on appeal, but the decision of the latter was not final, and was, in turn, reviewable by the judges.

The Act was construed to deprive the Commissioner of the power to pass upon the merits of applications, except upon regular appeal from the Board of Examiners-in-Chief, notwithstanding the continued existence of that provision of the Act of 1836, which directed the Commissioner to "make or cause to be made" an examination, etc. (Snowden *vs.* Pierce—Case No. 13,151, Federal Cases).

By the act of March 3, 1863, establishing the Supreme Court of the District of Columbia, the Justices of said Court were clothed with the same power theretofore exercised by the Judges of the Circuit Court.

By the act of 1867 (15 Stat., 10) a fee of $10 was required to be paid upon appeal from the Primary Examiner to the Board of Examiners-in-Chief.

By the Act of 1868 (15 Stat., 168) the Examiner-in-Chief oldest in length of commission supplied the vacancy caused by the death, resignation, absence or sickness of the Commissioner.

Under the Act of 1869 (15 Stat., 293) the examining corps was expanded to include twenty (20) Principal Examiners, twenty (20) First Assistant Examiners and twenty (20) Second Assistant Examiners.

A later Act of 1869 (19 Stat., 11) added two more Principal Examiners.

The act of 1870 (16 Stat., 198) increased the examining force to one Examiner in Charge of Interferences, twenty-two (22) Principal Examiners, twenty-two (22) First Assistant Examiners and twenty-two (22) Second Assistant Examiners.

This Act continued the Board of Examiners-in-Chief, and, beyond question, took away every vestige of the Commissioner's power to personally make an original examination of an application, if any remained, after Judge Dunlop's decision in Snowden *vs.* Pierce, by substituting, in Section 31, the words "shall cause an examination to be made" for the words "make or cause to be made" of the Act of 1836.

The review of the Statutes, thus far made, shows how the Commissioner of Patents, from a judicial or quasi-judicial officer, having exclusive jurisdiction to determine the merits of applications for patents, *in the first instance*, with a gradually increasing force of examining clerks to assist him, has been transformed into an officer having *appellate jurisdiction only* and whose judgments are subject to review by the Court on direct appeal; also how the Examiners, from mere clerks to the Commissioner, have become transformed into judicial or quasi-judicial officers having *original* jurisdiction of applications and subject to review, not by the Commissioner directly, but first by an independent, intermediate, permanent tribunal of specialists, *i. e.*, the Board of Examiners-in-Chief on appeal, and then on appeal from the latter to Commissioner in person.

These conditions continue substantially, at the present day, under existing law, as will be seen upon examining the Revised Statutes and the Acts of Congress passed subsequent thereto.

Section 476 of the Revised Statutes provides for the appointment by the President of the Commissioner, one Assist-

ant Commissioner and three Examiners-in-Chief by and with the advice and consent of the Senate.

The Commissioner receives a salary of $5,000 a year and the Assistant Commissioner and the Examiners-in-Chief $3,000 a year each.

There are now on the rolls of the office 39 Principal or Primary Examiners, 41 First Assistant Examiners, 50 Second Assistant Examiners, 61 Third Assistant Examiners and 70 Fourth Assistant Examiners, besides five additional clerks assigned to the duty of making examinations.

The general powers and duties of Commissioner are defined by Section 481, as follows:

> "SEC. 481. The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law, and he shall have charge of all books, records, papers, models, machines and other things belonging to the Patent Office."

His power to make regulations is defined in Section 483, as follows:

> "SEC. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, *not inconsistent with law*, for the conduct of proceedings in the Patent Office."

The powers and duties of the Examiners-in-Chief are found in Section 482, as follows:

> "SEC. 482. The Examiners-in-Chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be on the written petition of the appellant to revise and determine upon the validity of the *adverse decisions of examiners upon applications for patents*, and for reissues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions and perform such other like duties as he may assign them."

Section 4886 defines what may be patented and section 4888 states what the application for patent must contain.

Section 4893 requires the Commissioner to *cause* an examination to be made upon the filing of an application, as follows:

> "SEC. 4893. On the filing of any such application and the payment of the fees required by law the Commissioner of Patents *shall cause an examination to be made* of the alleged new invention or discovery, and if on such examination it shall appear that the claimant is justly entitled to a patent under the law and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

In case of the rejection of any claim for a patent the duty of the Commissioner is made plain by section 4903, which reads as follows:

> "SEC. 4903. Whenever on examination *any claim for a patent is rejected* the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case."

The Act of 1870 (16 Stat., 198, Sec. 41) was like Section 4903 save that it contained after the word "rejected" the words "for any reason whatever." The omission of these words in the revision indicates that Congress intended that the Commissioner should notify the applicant when any of his claims for a patent was rejected *whether for or without reason.*

The Patent Office regulation made pursuant to Section 4903 is modeled rather on the lines of the old Statute than on the new one. It reads as follows:

> "Rule 65. Whenever on examination any claim of an application is rejected *for any reason whatever* the applicant will be notified thereof. The reasons for such rejection will be fully and precisely stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of prosecuting his application or of altering his specification; and if, after receiving such notice, he shall persist in his claim, with or without altering his specification, the application will be re-examined. If upon re-examination the claim shall be again rejected the reasons therefor will be fully and precisely stated."

Section 4909 makes it clear that the person whom the Commissioner shall cause to make the examination is the Primary Examiner, for it provides:

> "SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may *appeal from the decision of the Primary Examiner*, or of the Examiner in Charge of Interferences in such case to the Board of Examiners-in-Chief, having once paid the fee for such appeal."

The Patent Office regulations on the subject show that this is the construction placed on the section by the Patent Office

> "133. Every applicant for a patent, any of the claims of whose application have been twice rejected for the same reasons, upon grounds involving the merits of the invention, such as lack of invention, novelty or utility, or on the ground of abandonment, public use or sale, inoperativeness of invention, aggregation of elements, incomplete combination of elements, or, when amended, for want of identity with the invention originally disclosed or because the amendment involves a departure from the invention originally presented, and every applicant for the reissue of a patent whose claims have been twice rejected for any of the reasons above enumerated, or on the ground that the original patent is not inoperative

or invalid, or if so inoperative or invalid that the errors which rendered it so did not arise from inadvertence, accident or mistake, may, upon payment of a fee of $10, appeal from the decision of the *Primary Examiner* to the Examiners-in-Chief. The appeal must set forth in writing the points of the decision upon which it is taken, and must be signed by the applicant or his duly authorized attorney or agent.

"134. There must have been two rejections of the claims as originally filed, or, if amended in matter of substance, of the amended claims, and all the claims must have been passed upon, and all preliminary and intermediate questions relating to matters not affecting the merits of the invention settled before the case can be appealed to the Examiners-in-Chief.

"135. Upon the filing of the appeal the same shall be submitted to the *Primary Examiner*, who, if he finds it to be regular in form, shall, within *five* days from the filing thereof, furnish the Examiners-in-Chief with a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected claims and with the references applicable thereto. The Examiner shall at the time of making such statement furnish a copy of the same to the appellant. If the Primary Examiner shall decide that the appeal is not regular in form a petition from such decision may be taken directly to the Commissioner, as provided in Rule 145."

The appeals from the Examiners-in-Chief to the Commissioner in person and from the Commissioner to the Court of Appeals of the District of Columbia are regulated by the following provisions of the Revised Statutes of the United States:

"SEC. 4910. If such party is dissatisfied with the decision of the Examiners-in-Chief he may, on payment of the fee prescribed, appeal to the Commissioner in person.

"SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

"SEC. 4912. When an appeal is taken to the Supreme Court of the District of Columbia the appellant shall give notice thereof to the Commissioner and file in the Patent Office within such time as the Commissioner shall appoint his reasons of appeal, specifically set forth in writing.

"SEC. 4913. The Court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the Court may prescribe to all parties who appear to be interested therein. The party appealing shall lay before the Court certified copies of all the original papers and evidence in the case and the Commissioner shall furnish the Court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the Court, the Commissioner and the examiners may be examined under oath in explanation of the principles of the thing for which a patent is demanded.

"SEC. 4914. The Court, on petition, shall hear and determine such appeal and revise the decision appealed from in a summary way on the evidence produced before the Commissioner at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the Court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and shall govern the further proceedings in the case. But no opinion or decision of the Court in any such case shall preclude any person interested from the right to contest the validity of such patent in any Court wherein the same may be called in question.

"SEC. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity, and the Court having cognizance thereof, on notice to adverse parties and

other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, *as specified in his claim or for any part thereof* as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the Commissioner, and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not."

the following section of the Revised Statutes relating to the District of Columbia:

"SEC. 780. The Supreme Court, sitting in banc, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the Commissioner of Patents, in accordance with the provisions of section forty-nine hundred and eleven to section forty-nine hundred and fifteen, inclusive, of chapter one, Title LX, of the Revised Statutes of the United States, Patents, Trade-Marks and Copyrights."

(See R. S. U. S., p. 958. See R. S. U. S., Sec. 699);

and also by Section 9 of the Act of February 9, 1893, establishing the Court of Appeals of the District of Columbia, as follows:

"SEC. 9. That the determination of appeals from the decision of the Commissioner of Patents now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals created by this act;

"And, in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

Having by this review of the Statutes shown the gradual development of the examination system into the present proportions, the vast increase in the number of officials now engaged in carrying it on and the clear-cut division of the examining and reviewing tribunals into Examiners, Examiners-in-Chief, Commissioner and Court of Appeals of the District of Columbia, each having exclusive jurisdiction in its particular sphere *and none having any original jurisdiction save the Examiners*, we think we have put before the Court enough to enable it to decide the following vital question which this record presents, namely:

> Was the action of the Primary Examiner of the 31st day of July, 1900, requiring and demanding a second time the cancellation of claims 7 to 13, inclusive, of relator's application, as a condition of the grant of a patent to him on said application, an *adverse decision* upon or *second rejection of his said application*, or of *said claims*, such as entitles him to an appeal to the Board of Examiners-in-Chief?

THE RELATOR'S RIGHT OF APPEAL HAS ACCRUED UNDER THE STATUTE.

The statutory jurisdiction of the Board of Examiners-in-Chief would certainly seem broad enough to give that tribunal power to review the action of the Primary Examiner complained of. Section 482, R. S., says:

> "SEC. 482. The Examiners-in-Chief shall be persons of competent legal knowledge * * * whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the *adverse decisions of examiners* upon applications for patents" * * *

Surely the decision of the Primary Examiner complained of was *adverse* enough. It certainly was not favorable. It barred, and still bars, the progress of the application. It

prevented, and still prevents, the issue of relator's patent. Could anything be more adverse?

The respondent's return admits (p. 8) that *all* the claims of the relator's application are allowable and that the only question left is the question of division (p. 12), and the application is refused because of this adverse decision respecting it.

As the Statute imposes upon the Examiners-in-Chief the *duty* of revising and determining the validity of the adverse decisions of the Examiners, it by the clearest implication gives an applicant the right of appeal to them from such adverse decisions. So, without reference to any other section of the Statute, the relator's right of appeal from the Examiner's action complained of in this case seems clear under Section 482.

But if relator's right of appeal depends upon the provisions of Section 4909, alone, such right is equally perfect thereunder. The section says:

> "SEC. 4909. Every applicant for a patent or for the reissue of a patent, *any of the claims of which have been twice rejected* * * * may appeal from the decision of Primary Examiner * * * to the Board of Examiners-in-Chief."

If any of relator's claims for a patent have been rejected at all they have been twice rejected. This the return admits. The question is, Has any claim been rejected at all?

What does "rejected" mean as used in the section?

In the interpretation of Statutes it is a general rule that common words are to be given their plain, ordinary, popular meaning. Tested by this rule we find the word "reject" (*rejectus*, to throw back) to be universally used as the equivalent of "refuse," especially when used to indicate a denial of a petition or request.

We quote below from some of the Standard Authorities:

Webster's International Dictionary

Reject—To refuse to grant, as to reject a prayer or request.

Refuse—To decline to accept; to reject; to deny the request or petition.

Century Dictionary

Reject—To refuse to receive.

Refuse—To decline to accept; reject; as to refuse an office, to refuse an offer.

Standard Dictionary

Reject—To refuse to grant, as to reject an application or petition.

Refuse—To withhold acceptance of; reject, as to refuse an offer.

Soule's Synonyms

Reject—Decline, refuse, repudiate, repel, rebuff.

Refuse—Reject, repudiate, exclude, repel, rebuff, decline.

International Dictionary and Cyclopedia

Reject—To refuse to grant, as to reject a petition or request.

Refuse—To decline to accept; to reject.

Richardson's English Dictionary

Refuse—To deny; to reject; to give a negative to any request or petition.

American Encyclopedic Dictionary

Reject—To refuse to grant, as to reject a petition or request.

Refuse—To deny that which is solicited, demanded or sought; to decline to do or grant; not to comply with; to decline to accept; to reject.

That the word "rejected" was used by Congress in Sections 4903 and 4909 in the sense of "refused" is perfectly apparent from the fact that in Section 4915, found in the same Act, which gives to an applicant the right to *further*

prosecute his claim for a patent by a bill-in-equity proceeding, after final adverse action by the Commissioner, or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the word "refused" is used instead of "rejected" to indicate the action of the Commissioner or of the Court sought to be reviewed, the language being:

> "4915. Whenever a patent on application is *refused* either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity;" * * *

Note, here, that it is the refusal of *a patent*, of the whole application, and not of claims, merely, that gives the right to file a bill in equity. Unquestionably, the proceeding is but another step in the prosecution of applicant's right to a patent. Gandy *vs.* Marble, 122 U. S., 432; Butterworth *vs.* Hoe, 112 U. S., 50.

Assuming, then, that the word "rejected" in Section 4909 means "refused" was any of relator's claims refused by the Primary Examiner when he a second time required and demanded that claims 7 to 13, inclusive, be canceled?

Clearly the claims referred to were not granted, and just as clearly they were refused. To not grant them was to refuse them, and to require and demand that they be canceled, expugned, thrown out, was a complete refusal, rejection and suppression of them, so far as the Primary Examiner, by any action on his part, could accomplish that result.

Of course, to insist upon unreasonable conditions, or upon conditions which jeopardized any inherent or statutory right of the applicant, is equivalent to a refusal.

In the present case, the Examiner "refused" or "rejected" the claims because, without determining whether or not the process and apparatus were or were not mutually dependent upon each other, and merely because of the arbitrary and, as we have shown, illegal requirement of Rule 41,

declined to take any action to give the applicant the benefit of the appeal to the Examiners-in-Chief to which he was entitled by law.

The whole application was refused and rejected in the sense that the application, as a whole, came to a standstill and could not and cannot proceed at all unless and until compliance with the Examiner's requirement, or the reversal of his ruling, on appeal. Could there be a refusal more emphatic? How absurd to hold that if one claim is rejected an appeal will lie, but that if the whole application is rejected no appeal will lie!

The refusal and rejection is none the less complete because the Examiner intimates that the refused and rejected claims may be allowed *in another application*. The relator has not applied for two patents, but for one patent—for one patent covering all the parts of what he believes and claims to be his invention. The Examiner had no right to act to compel him to file two applications. A single patent, covering his whole invention, the relator claims the right to have, under the Statute, upon the payment of a single set of fees. The very section we have just quoted (Sec. 4915) says, "whenever *a patent* on application is *refused*," indicating that it is the refusal of *a patent* for any cause, whether because the application contains no novelty, or too many claims, or too many inventions, or because it is rejected upon an illegal rule of practice, or what not, that may be reviewed.

IF RULE 133, REGULATING APPEALS, ADDS ANY CONDITIONS OF APPEAL NOT FOUND IN THE STATUTE IT IS NULL AND VOID.

Section 482, R. S. U. S. guarantees, as we have seen, a right of appeal to the Board of Examiners-in-Chief from the "adverse decisions of Examiners upon applications for patents," and Section 4909, R. S. U. S., gives, in terms, a right

of appeal to any applicant "any of the claims of which have been twice rejected."

The Commissioner's Rule 133 provides:

> "133. Every applicant for a patent, any of the claims of whose application have been *twice rejected for the same reasons, upon grounds involving the merits of the invention, such as lack of invention, novelty or utility, or on the ground of abandonment, public use or sale, inoperativeness of invention, aggregation of elements, incomplete combination of elements, or, when amended, for want of identity with the invention originally disclosed, or because the amendment involves a departure from the invention originally presented;* and every applicant for the reissue of a patent whose claims have been twice rejected for any of the reasons above enumerated, or on the ground that the original patent is not inoperative or invalid, or if so inoperative or invalid that the errors which rendered it so did not arise from inadvertence, accident or mistake, may, upon payment of a fee of $10, appeal from the decision of the Primary Examiner to the Examiners-in-Chief. The appeal must set forth in writing the points of the decision upon which it is taken, and must be signed by the applicant or his duly authorized attorney or agent."

Now if, as respondent contends, the Examiner's requirement was not a "second rejection *upon grounds involving the merits of the invention*," and, consequently, was not an action which gave a right of appeal under Rule 133, then Rule 133 is invalid, void and of no effect, because inconsistent with law in that it curtails and cuts down the statutory right of appeal from "adverse decisions" *of any kind* (Sec. 482) and "second rejections" *of any kind* (4909) to a right of appeal from *second rejections for the same reasons upon grounds involving the merits of the invention.* The Statute says nothing about a rejection *for reasons*, nor about rejections upon *grounds involving the merits of the invention* (Com'r of Patents *vs.* Whitely, 4 Wall., 552). Rejection for or without

reason, and rejections upon the merits of the invention or otherwise, are equally within its purview, and the Commissioner, by rule, can add nothing to nor subtract anything from the statutory requirements, to the prejudice of an applicant.

Morrill *vs.* Jones, 106 U. S., 466.
Tracy *vs.* Swartwout, 10 Peters, 80.
Kurtz *vs.* Moffit, 115 U. S., 487.
Teal *vs.* Fulton, 12 How., 285.
Anchor *vs.* How, 50 Fed., 367.

Under the Act of 1839 appeals were allowed from the Commissioner to the Chief Judge of the Circuit Court of the District of Columbia, and the Act of 1852, without taking away that power, extended the right of appeal so as to lie to either of the Assistant Judges. The Chief Judge having become very infirm the Commissioner undertook, by rule or order, to restrict appeals to the Assistant Judges only, and the legality of his action having been drawn in question the opinion of the Attorney General of the United States, Mr. Cushing, was asked and obtained thereupon. Mr. Cushing, in giving his opinion, said:

> "The Commissioner undertook to require and order that in all cases of interfering patents that the appellant, who shall have, theretofore, taken an appeal to the Chief Justice shall, within fifteen days after notice of the order, amend his appeal by taking it to one of the Assistant Judges, and on his neglect so to amend that a patent shall issue to the appellee, and that thereafter all appeals shall be taken to one of the Assistant Judges, or else shall issue to the adverse party. I conceive these orders to be a plain violation of law. The Commissioner has assumed to make a statute repealing an Act of Congress."
>
> 6 Opin. Att'ys Gen'l, 38 (June 2, 1853).

In the case of Morrill *vs.* Jones, 106 U. S., 466, above cited, under a statute providing that "animals, alive, specially im-

ported for breeding purposes from beyond the seas, shall be admitted free (of duty) upon proof thereof satisfactory to the Secretary of the Treasury, and under such regulations as he may prescribe" the Secretary of the Treasury prescribed a regulation providing that before a collector should admit such animals free he must, among other things, be satisfied that "the animals are of superior stock, adapted to improving the breed in the United States." The collector, though the importation was for breeding purposes, demanded the duties because he was not satisfied that the animals were of *superior stock*.

But this Court, speaking through Mr. Chief Justice Waite, said:

> "The Secretary of the Treasury cannot, by his regulations, alter or amend a revenue law. All he can do is to regulate the mode of proceeding to carry into effect what Congress has enacted. In the present case we are entirely satisfied the regulation acted upon by the collector was in excess of the power of the Secretary. The Statute clearly includes animals of all classes. The regulation seeks to confine its operation to animals of 'superior stock.' This is manifestly an attempt to put into the body of the Statute a limitation which Congress did not think it necessary to prescribe. Congress was willing to admit duty free all animals specially imported for breeding purposes; the Secretary thought this privilege should be confined to such animals as were adapted to the improvement of breeds already in the United States. In our opinion the object of the Secretary could only be accomplished by an amendment of the law. That is not the office of a treasury regulation."

The analogy between that revenue case and the case at bar is striking. The Commissioner of Patents, not satisfied with the Statute and not recognizing a right of appeal from every adverse decision or second rejection by an Examiner, required that the adverse decision should be of "superior

stock," *i. e.*, "a second rejection, for the same reasons, upon grounds involving the merits of the invention," thereby exceeding his authority, by unduly limiting the right of appeal, as much as the Secretary of the Treasury did by his regulation.

In this conflict between the Statute and the regulation the latter necessarily goes to the wall and cannot be invoked by the respondent for his protection in this proceeding.

It may be remarked, in passing, that it is not true, as intimated by counsel for respondent in the court below, that the Office rule regulating appeals has been the same for the past thirty years.

The rules promulgated in 1870 by Commissioner Samuel S. Fisher, who, perhaps, had as much to do with the formulation of the Patent Act of 1870 as any one person, contained the following provision respecting appeals:

> "42. Every applicant for a patent or the reissue of a patent any of the claims of which have been twice rejected and every party to an interference, may appeal from the decision of the Primary Examiner or of the Examiner in charge of interferences, in such case, to the Board of Examiners-in-Chief, having once paid a fee of $10. For this purpose a petition in writing must be filed, signed by the party or his authorized agent or attorney, praying an appeal and setting forth briefly and distinctly the reasons upon which the appeal is taken."

This rule, it will be observed, follows closely the Statute. It was continued by Mr. Fisher's successors down to November, 1876, when Commissioner R. H. Duell amended it so as to read:

> "42. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected *upon the merits of the invention*, may appeal from the decision of the Primary Examiner to the Board of Examiners-in-Chief," etc.

In this amended form the rule continued till 1879, when Commissioner Paine changed it so as to contain an attempt at a specification of things regarded as affecting the merits, viz.:

> "128. Every applicant for a patent or the reissue of a patent, any of the claims of whose application have been twice rejected upon grounds involving the merits of the invention, *such as lack of novelty or utility, abandonment, public use, or want of identity of invention, either in amended or in reissue applications*, may appeal from the decision of the Primary Examiner to the Board of Examiners-in-Chief," etc.

This form prevailed, in substance, until the time of Commissioner Seymour, who, by his code of rules, promulgated February 9, 1897, struck out the rule entirely, appreciating, doubtless, that the various amendments and additions of his predecessors had taken it farther and farther from the Statute.

In the preface to his rules Commissioner Seymour made the following statement:

> "The rules of procedure have been revised on the following lines:
>
> "First. To remove from the rules those sections of the Revised Statutes which have, from time to time, been incorporated in them, and in place of incorporating certain sections in the rules, it has been decided to publish the Statutes, revised to the present time, in full, in the same pamphlet with the rules."

His new appeal rule was very simple:

> "71. In *ex parte cases* upon the filing of an appeal or petition the Primary Examiner shall, ten days before the date of hearing, furnish the appellate tribunal and the appellant or petitioner with a statement of the grounds of his decision."

The wisdom of thus relying upon the Statute itself for a statement of grounds of appeal is apparent from our discussion of the present rule.

Mr. Seymour's work was, in turn, uprooted by his immediate successor, Mr. Butterworth, and the old rule, in substantially its present form, was readopted.

That Mr. Seymour believed that a requirement of division might amount to a rejection of merits and give a right of appeal to the Board of Examiners-in-Chief is apparent from the decision of his assistant in *ex parte* Bellingrodt (54 MSS. Dec., 474), printed as an Appendix to this brief which was foreshadowed in his own decision in *ex parte* Thomson, C. D. 1894, p. 8; 66 O. G., 653, wherein he said (p. 10):

> "Since division between process and product may produce confusion in the arts and conflicting interests, as intimated by the Court in McKay *vs.* Dibert (C. D. 1881, 238; 19 O .G., 1351, 5 Fed. Rep., 587) and since no patent has been declared void by reason of the joinder of such claims, while many have been held to be valid, and since manifest advantages would follow from one uniform rule as to division, and, more important than all else, since division or joinder *approaches if it does not present* a question of right in the applicant to choose between two courses, both of which are open to him, it is broadly announced that division in such cases should not be required."

RELATOR'S RIGHT OF APPEAL HAS ACCRUED UNDER RULE 133, IF RULES 41 AND 133 ARE PROPERLY CONSTRUED.

The action of the Primary Examiner which gave rise to the lodgment of the appeal in this case to the Board of Examiners-in-Chief was made pursuant to Patent Office Rule 41.

Rightly or wrongly the Examiner rejected claims 7 to 13, inclusive, of relator's application because of this rule. He said, in effect, your application contains claims to an appa-

ratus and claims to a process, and the process claims must go.

Did this objection, right or wrong, go to the merits of the invention? If it did, there was a clear right of appeal, not only under the Statute, but under Rule 133.

If the relator had made thirteen apparatus claims and seven of them had been rejected as not involving invention, he would have had, admittedly, a clear right of appeal. If, too, the Examiner had rejected the aforesaid seven apparatus claims on the ground that they were not warranted by the original disclosure in the application, or because they covered mere aggregations and not legitimate combinations, there would also have been, unquestionably, a right of appeal. All of these objections would, admittedly, have gone to the merits of the invention, *for Rule* 133 *says so.*

How about the requirement compelling the relator to throw away seven of his valuable apparatus claims on the ground that they couldn't be entertained there? Are they not parts of his invention? Does not their cancelation affect the merits as much as, and more than, a question as to whether a claim is in the form of an aggregation or of a legitimate combination?

The fact that a process and an apparatus for carrying it into effect are distinct inventions or distinct parts of an invention does not militate against their joinder in the same application under the rule. Every application that contains two or more process claims or two or more apparatus claims embodies claims for two or more distinct inventions. Each claim in an application or in any patent is supposed to be patentably distinguished from every other claim and to cover a distinct invention. Multiple claims are granted on no other theory.

The first paragraph of Rule 41 provides that "where several distinct inventions are dependent upon each other and mutually contribute to produce a single result *they may be claimed* in the same application."

Mr. Commissioner Mitchell, than whom no better patent lawyer ever graced the Patent Office, in his admirable decision, in the case of *ex parte* Lord (50 O. G., 987; G. D., 1890, p. 16), held that process and apparatus might be, and often were, dependent upon each other and mutually contributed to produce a single result, and that, therefore, they might be claimed in the same application. When Mr. Mitchell rendered this decision he was construing Rule 41, as it then stood—that is, without that *addition* made by his successor, Mr. Commissioner Duell, which now reads:

> "Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications."

But what Mr. Mitchell said is as true today as it was when he said it, and Mr. Duell's addition to the rule must still be read to mean that process and apparatus must be presented in separate applications *unless they are "dependent upon each other and mutually contribute to produce a single result,"* in which case they may be claimed in a single application.

The Examiner in relator's case must be held to have practically decided that the process and apparatus claimed by relator were not dependent upon each other and did not mutually contribute to produce a single result, *and his decision on that question of fact goes to the merits of the case and is clearly appealable.*

THE REFUSAL OR REJECTION OF AN APPLICATION, OR OF ANY OF THE CLAIMS THEREOF, UNDER A RULE OF PRACTICE, IS NOT DIFFERENT, IN KIND, FROM A REFUSAL OR A REJECTION UNDER THE STATUTE ITSELF, AND IS APPEALABLE.

The respondent and the Court below seem to think that the refusal by the Primary Examiner of a patent to the relator on the ground that the latter's application is obnoxious to the provisions of Rule 41 is different, in kind, from a re-

fusal or rejection of the application on the ground that it is obnoxious to some provision of the Statute; that the one involves a question of office practice or procedure, merely, and the other a question of the merits. No such distinction, we submit, can be made.

The rules of the Office made pursuant to statutory authority, *and not inconsistent with law*, have all the force and authority of the Statute itself, and are, so long as they remain unrepealed, as binding upon the Office as they are upon applicants.

U. S. *vs.* Eliason, 16 Pet., 291.
Gratiof *vs.* U. S., 4 How., 80.
In re Hirsch, 74 Fed., 931.
Wilkins *vs.* U. S. (C. C. A.), 96 Fed., 837.
James *vs.* Germania Iron Co., 107 Fed., 597–609.
D. C. *vs.* Roth, 18 App. D. C., 547.
Rio Grande Irrigation Co. *vs.* Gildersleeve, 174 U. S., 603.

When, therefore, claims 7 to 13, inclusive, of relator's application were refused, *in that application*, because of alleged repugnancy to the provisions of Rule 41, such refusal or rejection was the same, in kind, as a refusal or rejection of them on the ground that they were obnoxious to the statute (sec. 4886), requiring that they embody patentable subject-matter, and such refusal became, in effect, a statutory refusal or rejection of them, went directly to the merits of the application, was final, and all the statutory appellate tribunals may be invoked to review the soundness of the Primary Examiner's action in making such refusal or rejection. Mark, in this connection, the aptness of language in the statutory provision respecting appeals:

> "SEC. 4909. Every applicant for a patent or for the reissue of a patent, *any of the claims of which have been twice rejected*, etc., may appeal from the decision of the Primary Examiner, etc., to the Board of Examiners-in-Chief."

It may possibly transpire that the Primary Examiner has, in the case at bar, acted wisely and well, and all the appellate tribunals whose jurisdiction is invoked may affirm his decision, but that is not the question. It is not a question as to *how* the appellate tribunals are going to decide, but as to *whether they have an opportunity to decide at all.*

It seems to us that there can be but one answer to relator's contention. If the Primary Examiner has refused to allow applicant's claims 7 to 13, inclusive, in the pending application, and has demanded their cancellation from that application, because of supposed repugnancy to Rule 41—which has the force and effect of the Statute, if valid—he has refused and rejected such claims under that rule, and all of the statutory appellate tribunals have the right, at least, to say whether or not the rule has been properly applied, just as they would have the right to say whether a rejection grounded on the alleged lack of one of the direct statutory prerequisites, such as novelty of subject-matter, was properly made or not.

THE HEARING OF THE COMMISSIONER ON INTERLOCUTORY PETITION IS NO SUBSTITUTE FOR THE STATUTORY APPEAL.

The respondent contends that the Examiner's requirement of division is a matter of form, not appealable to the Board of Examiners-in-Chief, but reviewable by the Commissioner, upon interlocutory petition, without fee, and further, that the Commissioner's decision upon such questions is final and unreviewable.

To this we reply:

1. No such mode of reviewing an adverse decision of a Primary Examiner is recognized by the Statute.

2. If the Commissioner has indulged an applicant by giving him the benefit of his opinion on such question, on mere petition, without fee, in advance of acquiring jurisdic-

tion on regular statutory appeal, and it has been customary for the Primary Examiner to act in accordance with such opinion, applicants have perhaps been justified in invoking the Commissioner's aid in that way, but their right to a regular statutory appeal to the Examiners-in-Chief, to the Commissioner and to the Court of Appeals, on such a question, has not thereby been waived or prejudiced.

3. It is a question whether the Commissioner, by entertaining and deciding such interlocutory petitions, as a matter of grace, without fee, has not deprived the Government of the revenue which would have accrued from the fees on regular appeal to him through the Examiners-in-Chief, amounting to $30, in each case, and laid himself open to most unfavorable criticism by such action.

4. It is absurd to contend that the decision of the Commissioner is final upon such a grave question as the right of an applicant to have the whole of an invention he is compelled by law to disclose covered by a single patent, the very instrument of disclosure. Was it not for the purpose of reviewing the action of the Commissioner on just such important points, affecting, profoundly, the rights of an inventor, that the Court of Appeals of the District of Columbia was set above the Patent Office?

We contend, most strenuously, that the Commissioner cannot by offering his advice on interlocutory petition, on such a matter, either short-circuit the jurisdiction of the Board of Examiners-in-Chief, or deprive the Court of Appeals of its right of reviewing him.

5. The Commissioner's power to make a final, unreviewable decision upon so important and vital a matter is neither derived from his power to make regulations nor from his general supervising powers conferred by Sec. 481.

While it is true that the latter section imposes upon him

the duty to "superintend or perform all duties respecting the granting and issuing of patents directed by law," it does not give him the power of original examination of applications where that duty is lodged elsewhere, *i. e.* in the Primary Examiner; it does not give him the power to review, in the first instance, the judgments of the Primary Examiners on questions of patentability, or any other questions affecting the rights of an applicant to a patent, when that duty is lodged elsewhere *i. e.*, in the Examiners-in-Chief; any more than it gives him the right to refuse a patent after the Court of Appeals have adjudged, on appeal from him, an applicant entitled to one.

Some of the limitations on his powers and duties are expressed in Section 4893, viz:

> "§ 4893. On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents *shall cause* an examination to be made of the alleged new invention or discovery; and if *on such examination* it shall appear that the claimant is *justly entitled to a patent under the law*, and the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

Under this section he is to "cause an examination to be made" not to make it himself, and "if on such examination it shall appear" (to the Examiner, not to the Commissioner) "that the claimant is justly entitled to a patent under the law" he "shall" *i. e.*, *must* issue a patent. His only power to reject or refuse a patent arises when a case comes before him on regular, statutory appeal.

6. If the Commissioner's decision was *final* on the question of division, in this case, then it was final as to everything else for, as the return shows (p. 12) *that was the only question left open*, the novelty and patentability of *all* the claims, and every other question, having been disposed of.

THE DEFENSE OF ELECTION AND ESTOPPEL.

The respondent in his return sets up the demand of the relator for an interference with a patent upon a method claim, after being advised by the Examiner that such a demand would be deemed and taken to be, by the Office, an election to stand on method claims alone, and as an abandonment of his right to persist in his apparatus claims on the termination of the interference, and as an estoppel upon his right to further prosecute his apparatus claims in the present application.

The point is absolutely without merit, and constitutes no defense to relator's petition.

In the first place, the requirement of the Examiner was unlawful and was of no effect against the relator's right to prosecute his application in respect of all its claims. The relator consented to nothing, acquiesced in nothing. He demanded an interference, as he had a right to do, and the Commissioner being satisfied that an interference existed, declared it, as required by law. It is not true, as contended by respondent, that the interference could not and would not have been declared if the alleged election had not been made by the relator. Dungan, with whom an interference was demanded, was a patentee, and the practice as recognized in the recent case of *Ex parte* Spoon, 97 O. G., 1375, decided November 2, 1901, during the respondent's administration, permitted and required an interference, notwithstanding questions not directly involving the right of the applicant to make the claim in interference were still unsettled in the applicant's application. The threat of the Examiner, the relator considered to be idle and frivolous, and attached no more importance to it than he would have to a demand for $100, as a condition of declaring the interference. He is now no more estopped and concluded from insisting upon his right to further prosecute his application, as to all its

claims, than he would be estopped to resist a demand for $100 at the hands of the Examiner in the case supposed.

But if the relator were bound as by an election, or estopped by his conduct, the action of the Primary Examiner of the 31st day of July, 1900, complained of, was a *second rejection* of relator's claims 7 to 13, inclusive, *on that ground*, and is clearly appealable to the Board of Examiners-in-Chief. An estoppel, of course, goes to the merits.

The respondent may call the Examiner's action a requirement of division, a demand for cancellation of claims, a judgment as upon an election, or as upon an estoppel, or as upon a matter *res adjudicata*, or as upon anything else; whatever it may be termed, it was an "adverse decision" a second time made, and a "second rejection" of relator's claims 7 to 13, inclusive, and, consequently, is the proper subject of review, on appeal, by the Board of Examiners-in-Chief.

RESPONDENT HAS MAGNIFIED THE CONSEQUENCES OF ALLOWING APPEALS IN CASES LIKE RELATOR'S.

The respondent argues that the relator's right of appeal contended for in this case, if admitted, would operate most disastrously, by permitting appeals to all the statutory appellate tribunals on all questions of mere procedure and Office practice arising under the rules.

That we may not misstate respondent's position, we quote the following from the brief filed in his behalf in the court below:

> "If an applicant is entitled to appeal to the Court of Appeals from the Commissioner's ruling upon this question of procedure, he is entitled to such appeal from any requirement which the Commissioner may make during the prosecution of the application which the applicant does not wish to comply with, although that requirement has nothing to do with the merits of the applicant's claim or his right to a patent. For

> instance, the Commissioner may require that papers filed in the case be written upon one side of the paper only, or be written in permanent ink, and if the applicant does not wish to comply with the requirement, he may regard the action as a rejection of all claims made by him in the case and appeal to the several tribunals of the Patent Office and to the court."

This line of argument is specious and unsound, and demonstrably so.

The relator contends for the right of appeal from such actions of the Primary Examiner as are made under *rules that are inconsistent with the plain provisions of the Statute.* He claims no right of appeal from actions under rules that are not open to this criticism and, of course, there are many such—

To illustrate: Section 4888 R. S. U. S. requires that—

> "SEC. 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, *in writing* to the Commissioner of Patents, and shall file in the Patent Office a *written description* of the same," etc., etc.

Now, if the Commissioner, pursuant to his statutory authority to make rules, should promulgate a rule requiring that the application should, to quote the respondent's illustration, "be written upon one side of the paper only or be written in permanent ink," the rule would be a perfectly proper one, and no statutory appeal would lie from the action of a Primary Examiner enforcing it. But suppose the Commissioner should make a rule requiring that all applications for patent should be presented *in print,* and refusing consideration of any application that was written with a pen, would such a rule be considered a legal exercise of his power to make rules not inconsistent with law? Would such a rule be upheld by this Court? Manifestly not. In case of the

presentation of a *written* application and of the refusal of the Primary Examiner to receive it and to examine it, under such a rule and of the refusal of the Commissioner to direct the Examiner to receive it and examine it, mandamus would clearly lie to the Commissioner to compel him to direct the Examiner to do his duty under the law, notwithstanding the rule, and the Court would not hesitate to declare the rule "inconsistent with law," and therefore null and void. (Morrill *vs.* Jones, 106 U. S., 466.)

To make our point clearer, let us put another case.

Section 4909 R. S. U. S. provides that—

> "SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been *twice rejected*, etc., etc., may appeal from the decision of the Primary Examiner, etc., to the Board of Examiners-in-Chief," etc.

Now, suppose the Commissioner should make a rule requiring that there should be *three* rejections of a claim by the Primary Examiner before an applicant should have the right of appeal, and, after two rejections, an applicant should lodge his appeal to the Board of Examiners-in-Chief, and the Primary Examiner should refuse to answer it and forward it with his answer to the Board of Examiners-in-Chief, on the ground that the case was not in appealable condition, under the Commissioner's rule; and that the Commissioner should, on application, refuse to direct the Examiner to answer and forward the appeal, does any one doubt that mandamus would lie to the Commissioner in such a case to compel him to direct the Examiner to treat the appeal as a perfected appeal? In the case at bar the situation is not essentially different from that of the case last put.

MANDAMUS IS RELATOR'S PROPER REMEDY.

The Primary Examiner charged with the duty of passing upon an application in the first instance may reject or refuse

any claim made in it, but his decision upon such a question is not final. Elaborate judicial machinery has been devised, as we have seen, to review the Examiner's actions. The first revision is by the Board of Examiners-in-Chief, the second by the Commissioner of Patents in person and the third by the Court of Appeals of the District of Columbia, all on regular, statutory appeals. None of these tribunals has jurisdiction to pass upon the question in advance of its coming to it by regular appeal. None of them has any original jurisdiction, but each has ample power as an appellate tribunal, and the right of an applicant to invoke that power cannot be throttled and taken away by any possible action of a Primary Examiner, of a Commissioner of Patents, or by anybody else so long as the courts of the country are open to him.

The courts should not, we contend, except upon statutory appeal, determine the validity of any ground of rejection urged by a Primary Examiner (Frasch's Case, D. C. App., 100 O. G., 1977), but they can and will clear away any and every obstruction to an applicant's right to a revision of an Examiner's action by the duly constituted statutory, appellate tribunals provided for the purpose.

Any interference with a right of appeal is never tolerated and mandamus is the proper remedy to remove any obstruction to the exercise of the right.

U. S. *vs.* Gomez, 3 Wall., 752.
Ex parte Zellner, 9 Wall., 244.
Vigo's case, 21 Wall., 648.
Ex parte Jordan, 94 U. S., 248.
Ex parte Cutting, 94 U. S., 14.
Ex parte South, etc., R. R. Co., 95 U. S., 221.
Com. of Patents *vs.* Whitely, 4 Wall., 522.

The case of Commissioner of Patents *vs.* Whitely, 4 Wall., 522, last above quoted, is especially interesting in this connection.

The 13 section of the Act of 1836 declared that, under the circumstances therein stated, "it shall be lawful for the Commissioner, upon the surrender to him of such patent," * * * "to cause a new patent to be issued to the said inventor for the same invention, for the residue of the period then unexpired, for which the original patent was granted in accordance with the patentee's corrected description and specification, and, in case of his death or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators or assigns."

The seventh section of the Act provided, as we have had occasion hereinbefore to observe, that upon the filing of any application for a patent and the payment of the duty required by law, "the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery, etc."

The acts of 1839, 1852 and 1863 provided for an appeal to the Supreme Court of the District of Columbia from the decision of the Commissioner refusing a patent.

The applicant, Whitely, as the grantee of an exclusive sectional interest in a patent to one Jonathan Haines, filed an application for reissue of said patent. The Commissioner of Patents *declined to entertain the application* upon the ground that the applicant was only the grantee of an exclusive sectional interest and not the owner of the entire patent sought to be reissued. *He also declined to allow an appeal from his decision.*

An application was made to the Supreme Court of the District of Columbia for a writ of mandamus. That Court awarded a peremptory writ commanding the Commissioner "to refer said application to the proper examiner, or otherwise examine or cause the same to be examined according to law," and a writ of error was prosecuted to reverse that order.

In disposing of the case this Court, speaking through Mr. Justice Swayne, said:

"The Commissioner says, in his answer to the rule, that he could not examine the application because none had been filed in the Patent Office.

"This position is untenable. It is averred in the petition and not denied in the answer—and, therefore, as in other like cases of pleading, to be taken as conceded—that the application was filed with the Acting Commissioner. It is also admitted in the answer that the requisite amount of fees had been paid by the relator, but, it is added, that it had not been placed to the credit of the office and was in the hands of the chief clerk, subject to the relator's order.

"The relator had done all in his power to make his application effectual and had a right to consider it properly before the Commissioner.

"It was so. If it was not *a mandamus would clearly lie to compel the Commissioner to receive it.* It was his first duty to receive the application, whatever he might do subsequently. Without this initial step there could be no examination, and, indeed, no rightful knowledge of the subject on his part. Examination and the exercise of judgment, with their proper fruit, were to follow, and they did follow.

"The Commissioner found the question, whether the assignee was such a one as the law entitled to a reissue, lying at the threshold of his duties? It required an answer before he could proceed further. His decision was against the appellant. His examination of the subject was thorough and his conclusion is supported by an able and elaborate argument. It was made a part of his reply to the rule, and is found in the record.

"From this decision, *whether right or wrong*, the relator had a right, under the Statute, to appeal.

"*If the mandamus had ordered the Commissioner to allow the appeal we should have held the order under which it was issued to be correct.* But the order was that he should proceed to examine the application. That he had already done. The preliminary question which he decided was as much within the scope of his authority as any other which could arise. Having resolved it in the negative there was no necessity for him to look further into the case. Enter-

> taining such views it would have been idle to do so. *The question* was vital to the application and its resolution was fatal so far as he was concerned. Only a reversal by the tribunal of appeal could revive it and cast upon him the duty of further examination."

This case is instructive in that it shows that the *refusal* of the Commissioner *to examine the merits of an invention set forth in* an application for a patent may amount to *a rejection of such application* and *a refusal of a patent thereon*, such as entitles an applicant to an appeal; and, furthermore, that where the right of appeal from the decision of the examining officer is obstructed the proper remedy is mandamus.

Within the reasoning of this case, the requirement of cancellation of relator's claims 7 to 13, inclusive, and the refusal to proceed further with the case was a refusal and rejection of the application *with those claims in it*, and the Commissioner's denial of a right of appeal from such refusal and rejection was error.

The present rule regulating appeals (133) would have barred Whitely's appeal, as the Commissioner in his case had not examined the merits of the invention claimed, had not decided, but had refused to decide, any question of novelty, utility, patentability or any other question affecting the merits of the *invention*, or any question as to the inoperativeness or invalidity of the original patent sought to be reissued. The only question the Commissioner did decide was that the assignee was not entitled to file and prosecute an application for a reissue and this court said, "From this decision, whether right or wrong, the relator had a right UNDER THE STATUTE, to appeal."

CONCLUSIONS.

1. An applicant for a method or process patent has, on principle, the inherent right to demand protection, in that patent, of all patentable invention he is compelled to disclose in setting forth his new method or process.

2. There is nothing in the statutes curtailing this right; on the contrary, the statute plainly indicates that he may have a single patent covering his whole invention.

3. The Commissioner's power to make regulations for the conduct of proceedings in his office gives him no authority to curtail this right.

4. The statutes do not prohibit the inclusion of claims for a process and claims for a machine for carrying such process into effect, in a single patent.

5. No original patent covering process and machine has ever been declared invalid on that account; on the contrary, such patents have been sustained, under objection. In relator's case the method or process claimed is carried out by the apparatus claimed and the apparatus claimed in its use necessarily practices the method or process claimed. This is not denied.

7. Whether the process and apparatus covered by relator's claims are interdependent is a question of fact, affecting the merits, requiring the judicial determination of the Examiner, and is appealable both under the statute and under the rules.

8. Assuming Rule 41 to be valid, the rejection of relator's application under it is not different, in kind, from a rejection and refusal under the statute itself and is appealable under the statute.

9. If the Commissioner has any discretion he has exhausted it by embodying it in a rule, and that rule, when

properly construed, does not prohibit the joining of process and apparatus claims in the same application if they cover inventions "that are dependent upon each other and mutually contribute to produce a single result."

10. The action of the Primary Examiner of the 31st day of July, 1900, requiring and demanding, a second time, the cancellation of claims 7 to 13, inclusive, of relator's application, was an adverse decision upon and a second rejection of, his said claims and of his said application.

11. Such decision and second rejection gives relator a right of appeal to the Board of Examiners in Chief, under Sections 482 and 4909 of the statute.

12. Such adverse decision and second rejection goes to the merits and gives relator a right of appeal under Rules 41 and 133, when properly construed.

13. If Rule 133 does not accord relator a right of appeal from a requirement of division, it is invalid and void, because inconsistent with law.

14. The allowance of an appeal such as relator prays will not necessarily warrant the allowance of appeals from decisions of Examiners under rules of mere procedure not in conflict with the statute regulating appeals.

15. No case of estoppel is made out against the relator.

16. If the Examiner's rejection rests upon an alleged estoppel, an appeal clearly lies, under the rules, for a judgment founded on an estoppel necessarily affects the merits.

17. As the Commissioner is obstructing a clear right of appeal, mandamus is relator's proper remedy.

The judgment below should be reversed.

FREDERIC H. BETTS,
MELVILLE CHURCH,
For Plaintiff in Error.

APPENDIX.

[Decision in *Ex parte* Bellingrodt.]

[54 MSS. Dec., 474.]

(Petition on question of merits dismissed.)
Hearing March 27, 1894.

UNITED STATES PATENT OFFICE.

Ex Parte MAURICE B. BELLINGRODT.

Pistons for Rotary Blowers.

PETITION.

Application filed April 20, 1893, No. 471,060.
Mr. George J. Murray for applicant.

This is a petition taken from the requirement of the Examiner "wherein he refuses to consider the case upon its merits until the previous requirement for division has been complied with."

Under present rule 64, questions of form are always subordinated to those of merits. The question of division therefore being one of form should be postponed, if the applicant is disposed to question the propriety of this requirement until after a final determination of the merits has been reached. One exception, however, should be recognized in this practice. It occurs in cases in which the Examiner is of the opinion that the patent, if granted, would be held invalid by the courts as covering two or more independent inventions. In such cases the Examiner should reject for this reason without making any examination upon the merits. From this action, when repeated, the applicant may, if he is disposed to contest this requirement, take an appeal to the Examiners-in-Chief. If the Examiners-in-Chief reverse the decision of the Primary Examiner, the require-

ment will, of course, be waived; if they affirm the decision of the Primary Examiner, an appeal may be taken to the Commissioner. If the Commissioner's decision is favorable to applicant, the requirement will be waived; if it is unfavorable, no further action on the merits of the case will be made by the Office, other than such action as will be necessary to conform to the decision of the Circuit Court of Appeals for the District of Columbia, if an appeal thereto should be taken. As the question is now presented, it is one of merits, and, therefore, cannot properly be passed upon by me at present.

The petition is therefore dismissed without prejudice.

S. T. FISHER,
Assistant Commissioner.

JUNE 4, 1894.

FILE COPY.

Office Supreme Court
DEC 16 190
JAMES H. McKENNEY,
Clerk

Supreme Court of the United States.

UNITED STATES ON THE RELATION OF STEINMETZ,

vs.

FREDERICK I. ALLEN, Commissioner of Patents.

No. 383.

MEMORANDUM FOR PETITIONER.

I. The petitioner is entitled to a mandamus if he is unjustly deprived of an appeal from an adverse decision or has been otherwise deprived of any other substantial right.

II. If the twice repeated refusal of the Examiner to proceed with the examination of the Steinmetz application unless and until the applicant shall have cancelled Claims 7 to 13 (or shall have converted *one* application into *two)* is not authorized by law, and if the refusal of the Examiner to allow an appeal from this decision be not authorized by law, then the petitioner has been deprived of a substantial right and is entitled to a mandamus.

The Commissioner justifies his action under his power to make rules, and alleges rule 41 as the justification of his action. The petitioner denies the legality of that Rule. The validity of that Rule and of the authority to make it is thus brought in question on this appeal.

III. The Examiner seeks to justify his action by Rule 41 of the Patent Office.

This rule allows two inventions to be joined in a single application if "dependent" on each other and mutually contribute to a single result.

But the Examiner has declined even to consider whether this condition does or does not exist.

He refuses to proceed because Rule 41 has, *since the Steinmetz application was filed*, been supplemented by a post-script to the effect that Claims for a machine and for its process *must* be patented separately.

(1) Does the law *require* this? Clearly not, for no such requirement of law is cited or asserted.

(2) Has the law given to the Commissioner power to arbitrarily make and enforce this rule irrespective of the question whether the invention of machine and process are "mutually dependent" or not? The power conferred by law to make rules clearly does not include the making of rules which jeopardize the rights of inventors. There is nothing in the law which authorizes the Commissioner or Examiner absolutely, and without remedy by appeal, and without considering the special invention before them, to compel the inventor of a machine and of its process (or method) to apply for and take two patents instead of one?

It is to be clearly noted that this is not a case where the Commissioner or the Examiner has looked into the application in question and has decided that its special character is such that *it* ought to be divided. Nor is the case one where the Commissioner exercises or has undertaken to exercise his "discretion" in ordering *this particular* application to be divided. But he and the Commissioner, without considering this particular application, have, since it was filed, promulgated a new or amended rule which the Examiner has enforced by declining to act until it is complied with, to the effect that an apparatus or machine and its method *cannot* be united in one application.

The Examiner refuses to proceed with the case until a division has been made, or Claims 7 to 13 cancelled, *no matter what jeopardy to the inventor's rights may thereby ensue.*

IV. That there is jeopardy to the inventor's rights is fully proved. The principal brief for the petitioner (p. 26–27) shows that the practice of arbitrary divisions of applications has endangered the rights of inventors and has not yet received the approval of the courts.

It is sufficient in the present case to say that jeopardy exists even though it may be ultimately claimed that the inventor's rights may not be wholly sacrificed.

The case of *Underwood* v. *Gerber*, 149 U. S. 224, is conclusive that there is grave danger in the practice of separating an invention by attempting to cover it by two patents instead of one, even though those patents are dated on the same day and numbered with successive numbers.

V. That process and apparatus may be rightly joined in a single application, and that these difficulties may thereby be avoided, is fully established by the decision in this Court in the Telephone Cases, 126 U. S., p. 1.

VI. That in the present case the process and apparatus are in fact closely related to each other and probably "dependent" on each other, if not inseparable, sufficiently appears to justify the assumption, at least for the purposes of this case, that they ought not to be required to be *arbitrarily*, and without special reason, separated from each other.

VII. The question in this case, therefore, comes to this:

Does the law confer upon the Commissioner power to make an arbitrary rule of separation such as he has done by the amendments (*ex-post-facto*) to Rule 41?

No case has been cited supporting the legality of any such power. This is not the making of a rule merely to regulate practice. It is a rule which impairs rights.

No section or words of the law are invoked to justify the exercise of such power.

VIII. If the Examiner is without clear authority in law for his refusal to proceed, then his action amounts to a refusal of the application, because to insist upon unreasonable or unauthorized conditions, is, of course, equivalent to a refusal.

IX. If the Examiner's action is equivalent to a refusal of the application, and inasmuch as it has been twice repeated, it is clear that it amounts, in substance, to an "adverse decision" and is equivalent to an "adverse decision on the merits."

This being the case, the petitioner is clearly entitled to his appeal and the Commissioner and Examiner have unjustly deprived him of a substantial right by refusing to allow such appeal.

Respectfully submitted,

FREDERIC H. BETTS,
Counsellor for Petitioner.

Supreme Court of the United States.

OCTOBER TERM, 1903.

No. 383.

THE UNITED STATES EX RELATIONE CHARLES P. STEINMETZ, PLAINTIFF IN ERROR AND PETITIONER,

vs.

FREDERICK I. ALLEN, COMMISSIONER OF PATENTS, DEFENDANT IN ERROR.

Brief for Plaintiff in Error and Petitioner.

The facts upon which this petition is based are set forth at length in the petition itself.

The reason for this petition is that there is doubt as to whether the proper procedure for a review of the case by this court is by error, as in case No. 383, now pending in this court, or by certiorari proceedings, the propriety of error proceedings depending upon the question, usually a close one, whether the validity or merely the construction of an authority exercised under the United States is involved.

A petition similar to this was filed by the Government,

and granted, in Henry C. Payne, Postmaster General, plaintiff in error and petitioner, *vs.* The United States on the relation of The National Railway Publication Company, No. 628, October Term, 1902.

FREDERIC H. BETTS,
MELVILLE CHURCH,
For the Plaintiff in Error and Petitioner.

DECEMBER 16, 1903.

Supreme Court of the United States.

OCTOBER TERM, 1903.

No. 383.

UNITED STATES EX RELATIONE CHARLES P. STEINMETZ, PLAINTIFF IN ERROR AND PETITIONER,

vs.

FREDERICK I. ALLEN, COMMISSIONER OF PATENTS.

Petition for Writ of Certiorari to the Court of Appeals of the District of Columbia.

Comes now Charles P. Steinmetz, plaintiff in error and petitioner, and prays a writ of certiorari to the Court of Appeals of the District of Columbia in the above-entitled cause, and in support thereof says:

This is a proceeding by mandamus commenced in the Supreme Court of the District of Columbia by the United States on the relation of Charles P. Steinmetz, to compel Frederick I. Allen, Commissioner of Patents, to allow an appeal to the Board of Examiners-in-Chief from a decision of the Primary Examiner refusing and rejecting, a second time, the relator's application for patent because relator would not cancel from it certain claims, as required by the

Primary Examiner under the alleged authority of certain rules of Patent Office practice and decisions thereunder.

The Supreme Court of the District of Columbia refused the writ, and its judgment was affirmed, on appeal, by the Court of Appeals of the District of Columbia. A writ of error was sued out from this court to review the judgment of the Court of Appeals of the District of Columbia.

The case made by the relator's petition for mandamus is substantially as follows:

THE PETITION.

On the 21st day of November, 1896, the relator filed in the Patent Office an application for patent for his invention of new and useful Improvements in Motor Meters. This application contained and still contains thirteen (13) claims, covering the different phases of the invention; claims 1 to 6, inclusive, being, in terms, directed to the novel method or process involved in the working of the invention, and claims 7 to 13, inclusive, being, in terms, directed to the novel means or apparatus by which such method is carried into practice.

On the 15th day of May, 1900, the Primary Examiner—to whom, according to law, the application was referred by the Commissioner of Patents—examined and considered the application and decided that claims 17 to 13, inclusive, to the apparatus part of the invention, must be canceled. A reconsideration of this action was requested, and was granted, and the Primary Examiner, on the 31st day of July, 1900, repeated the requirement.

Regarding this last action as an adverse decision and as a

second rejection and refusal of his claims 7 to 13, inclusive, the relator appealed to the Board of Examiners-in-Chief, with a view to having the validity of the action of the Primary Examiner revised and determined by that tribunal, according to law.

The Primary Examiner, on the 9th day of August, 1900, refused to forward the appeal, with his answer thereto, on the ground that the question involved in the appeal was not one of which the Board of Examiners-in-Chief had jurisdiction, and therefore not appealable to that tribunal. A reconsideration of this action of the Primary Examiner was requested, and granted, and the action was, on the 16th day of August, 1900, repeated.

On the 20th day of August, 1900, the relator petitioned the then Commissioner of Patents to direct the Primary Examiner to answer and forward relator's appeal, which petition was on the 28th day of December, 1900, denied.

On the 16th day of January, 1902, a like petition was presented to the present Commissioner of Patents, the respondent herein, and on the 7th day of February, 1902, said petition was likewise denied.

On the 28th day of February, 1902, the relator directly petitioned the Board of Examiners-in-Chief to take jurisdiction of his appeal, but this petition was, on the 6th day of March, 1902, also denied, on the ground that the Examiners-in-Chief could not, under the Rules of the Patent Office, revise and determine the validity of the Primary Examiner's action without the latter's answer to the appeal, and, further, because of the previous action of the Commissioner in the premises.

The prayer of the relator's petition is that the respondent

be commanded to direct the Primary Examiner to answer and forward the relator's appeal to the Board of Examiners-in-Chief in order that the relator may have the benefit of a review of the Primary Examiner's action by the last-named tribunal and of the other appellate tribunals, if necessary.

THE RETURN.

The respondent's return admits that the relator is the true, original and first inventor of the invention for which he solicits a patent; admits that the relator's application contained and contains the claims set out in the petition, and that the relator's claims 7 to 13, inclusive, to the apparatus part of the relator's invention, were twice required to be cancelled by the Primary Examiner. It admits, further, the filing of the appeal by the relator from the decision of the Primary Examiner to the Board of Examiners-in-Chief and the taking of the various steps by the relator, as set out in the petition, in his endeavor to perfect his said appeal and to have the same determined by the Examiners-in-Chief.

It denies that any of the claims of relator's application has been twice, or at all, rejected; denies that any right of appeal to the Board of Examiners-in-Chief has accrued to relator, and attempts to justify the action of the Primary Examiner and of the respondent, on the ground that the ruling of the Primary Examiner was merely a requirement of division of relator's application under Rule 41 of Patent Office practice, which rule the Commissioner, with the approval of the Secretary of the Interior, had authority to make, and did not involve the rejection of any claim, or an action upon the merits of relator's application, such as would

entitle the relator to an appeal under the statute, or under Rule 133 of Patent Office practice.

In the Commissioner's decision, made part of the return (Exhibit B), it is admitted that all the claims of relator's application are allowable, but it is asserted that the refusal of the Office to grant a single patent embracing all of the claims is merely "a question of procedure or of the manner of securing protection" and "not of the right of the applicant to a patent upon any of the claims presented."

The return further sets forth that the relator is estopped by his conduct to question the validity of the Primary Examiner's requirement of division; and denies, generally, the denial of any right to the relator and of the relator's right to the relief prayed.

The relator moved for judgment, notwithstanding the return.

Mr. Justice Barnard, who heard the case in the Supreme Court of the District of Columbia, ruled that the decision of the Primary Examiner appealed from was only interlocutory in character; did not amount to a refusal or rejection of relator's application for a patent; and was not appealable under the statute or under the rules, to the Board of Examiners-in-Chief, and he denied the writ and dismissed the petition.

This judgment was affirmed by the Court of Appeals of the District of Columbia, that court holding that the requirement of division was a matter resting in the discretion of the Commissioner; that his judgment on that question was final; and that his rule made pursuant to his statutory authority to make rules, cutting off the appeal to the Board

of Examiners-in-Chief from the judgment of the Primary Examiner, was valid and not inconsistent with the statute regulating appeals.

The case made on the proceedings in error is now docketed in this court as No. 383 of October Term, 1903, and on motion of the Solicitor General has been advanced to be heard immediately after the case of *Ex parte* Frasch, Original No. 13, October Term, 1903.

It appears that the jurisdiction of this court in your petitioner's case No. 383, brought here on proceedings in error, is dependent wholly upon whether there is "drawn in question the validity" "of an authority exercised under the United States."

The underlying question most seriously affecting the right of your petitioner and of thousands of other inventors, namely, the authority of the Commissioner of Patents to make and enforce rules and regulations defining and limiting the right of appeal conferred by sections 482 and 4909, Revised Statutes, and to arbitrarily require division of an application for patent containing claims for a process and for an apparatus for carrying such process into effect, against the wishes and at the expense of the applicant, is one of great gravity and importance and is evidently so considered by the Government, as evidenced by its motion to advance No. 383, and inasmuch as the judgment of this court upon such question might not be obtained should the objection to its jurisdiction in case 383 be sustained, your petitioner prays—

1. That a writ of certiorari issue to the Court of Appeals of the District of Columbia.

2. That the record of said suit, already in this court in case No. 383, be received and accepted as the record in such certiorari proceedings.

3. That the hearing of said case No. 383 and of the case made under the certiorari proceedings be made concurrent.

4. That the briefs and arguments filed and to be filed in said case No. 383 be received and applied to the case made under the certiorari proceedings.

5. That such other and further relief be granted as the nature of the case shall seem to demand and as to this court shall seem proper.

CHARLES P. STEINMETZ.

FREDERICK H. BETTS,
MELVILLE CHURCH,
Of Counsel for Plaintiff in Error and Petitioner.

DECEMBER 16, 1903.

DISTRICT OF COLUMBIA, *ss:*

Charles P. Steinmetz, being duly sworn, deposes and says, that he is the complainant in the foregoing petition named, that he has read the said petition and knows the contents thereof, that the same is true of his own knowledge, except as to those matters which are therein stated to be on information and belief, and as to those he believes it to be true.

CHARLES P. STEINMETZ.

Sworn to and subscribed before me this 16th day of December, 1903.

THOMAS DURANT,
Notary Public.

In the Supreme Court of the United States.

OCTOBER TERM, 1903.

THE UNITED STATES EX RELATIONE Charles P. Steinmetz, plaintiff in error,
v.
FREDERICK I. ALLEN, COMMISSIONER of Patents, defendant in error.
No. 383.

BRIEF FOR THE DEFENDANT IN ERROR.

This cause is before the court on a writ of error to the court of appeals of the District of Columbia to review a judgment of that court affirming a judgment of the supreme court of the District dismissing a petition for mandamus directing the Commissioner of Patents to permit an appeal within his Office in a matter arising out of application for a patent.

The application was filed by the plaintiff in error November 21, 1896, and contained seven claims covering an alleged new form of electrical apparatus entitled a motor meter, and also six claims covering a process of actuating motor meters. It was referred to a primary examiner for action, and he directed that it be so divided as to present process and apparatus claims separately, and repeated such ruling. The applicant, alleging

that this was a rejection of his claims, attempted to appeal to the examiners in chief, under the provisions of section 4909, Revised Statutes, which is as follows:

> Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners in chief; having once paid the fee for such appeal.

The primary examiner refused to permit the appeal for the reason that he had not rejected any claim, and the Commissioner declined to direct him so to do.

The plaintiff in error then made application to the supreme court of the District of Columbia for a mandamus commanding the Commissioner to direct the primary examiner to permit the appeal and to forward the papers to the examiners in chief.

THE PETITION.

The allegations of the petition (Rec., 1 to 7) were in substance these:

The petitioner filed in the Patent Office a complete application for a patent upon an improvement in motor meters November 21, 1896, of which improvement he was the inventor.

The application contained thirteen claims, the first six covering a process of operating motor

meters, and the last seven the apparatus disclosed therein; it was referred to a primary examiner for action, and on May 15, 1900, he required cancellation therefrom of claims 7 to 13, relating to the apparatus, and upon reconsideration repeated this action July 31, 1900.

Regarding this as final rejection of claims 7 to 13, petitioner August 4, 1900, filed an appeal therefrom to the examiners in chief, which, contrary to his duty, the primary examiner refused to forward with his answer, as required by the Rules of Practice of the Patent Office.

On August 20, 1900, petitioner asked the former Commissioner by interlocutory petition to direct the examiner to forward the appeal. This was denied September 28, 1900.

On January 16, 1902, petitioner asked the present Commissioner to direct the primary examiner to forward the appeal and this was also denied February 7, 1902.

On February 28, 1902, petitioner asked the examiners in chief directly to hear and determine his appeal, notwithstanding the primary examiner's refusal to answer, and this was denied.

Alleging that it was the duty of the primary examiner to forward the appeal to the examiners in chief with answer thereto, and that upon his refusal it was the duty of the Commissioner of Patents to direct him to forward it, petitioner prayed the supreme court of the District that a writ of mandamus be issued to the Commissioner

commanding him to order the primary examiner to forward the appeal to the examiners in chief, with his proper answer, as required by the rules of the Patent Office.

THE RETURN.

The return of the Commissioner (R., 8 to 11) admits the filing of the application and its contents, the allegations as to inventorship, the filing of an appeal to the examiners in chief, and the various steps taken by the petitioner to have the same determined.

It recites further action in the case as follows:

On October 9, 1899, the primary examiner, to whom the case was referred for action, wrote applicant requiring division between his process and apparatus claims, in accordance with rule 41 of the Rules of Practice, before further action would be given upon the merits.

The applicant without then contesting the requirement for division asked, December 15, 1899, that his process claims be placed in interference with claims in a patent to one Duncan, saying:

> It is therefore requested that the requirement for division be waived for the present in order that an interference with the patent to Duncan above referred to may be declared.

The examiner replied, January 2, 1900:

> Pending the determination of the interference, applicant may retain the method and apparatus claims in this case, but the acceptance of an interference on one of the

> method claims will be held by the office to be an election of the prosecution of the method claims, and further prosecution of the apparatus claims in this application will not be permitted.

The applicant acquiesced in this ruling, and wrote January 19, 1900:

> It is respectfully requested that the interference with the Duncan patent, No. 604464, be declared as soon as possible.

The interference with Duncan was then declared, and after a final decision therein in applicant's favor, the examiner wrote him May 15, 1900:

> In accordance with office letter of January 2, 1900, applicant is required to cancel from this case all claims except those for the method.

This action was repeated upon reconsideration, and the examiner refused to permit an appeal to the examiners in chief, on the ground that his action was not a rejection and was not appealable under section 4909, Revised Statutes.

The applicant then, by interlocutory petition, asked the Commissioner to direct the examiner to permit the appeal, and this was denied, Assistant Commissioner Chamberlin saying:

> * * * It has been the practice for the past thirty years to treat the question not as one of merits and appealable to the examiners in chief, but as a proper matter for petition for the Commissioner. I see no reason for overturning this practice.

Acquiescing in this ruling, applicant, by interlocutory petition under rule 145, without fee, asked the Commissioner to review and reverse the examiner's requirement for a division of the application, and the Commissioner, after consideration, was of opinion that the ruling was proper, and sustained the examiner.

On January 16, 1902, applicant, by interlocutory petition, asked the present Commissioner to direct the examiner to permit his appeal to the examiners in chief, and this he refused, saying:

> The requirement for division is clearly a matter of form, not involving the merits of the claims, since the claims may be, and in the present case are, regarded as allowable. The examiner has not refused to grant a patent to this applicant upon any of the claims presented, but has merely required that they be included in two patents instead of one. It is a question of procedure or of the manner of securing the protection which is in controversy, and not the right of the applicant to a patent upon any of the claims presented.

The return denies that the action of the primary examiner was a rejection of any claim, and alleges it was a mere preliminary requirement as to procedure, a matter resting entirely within the discretion of the Commissioner as head of the office and not appealable. It denies the petitioner was entitled to appeal to the examiners in chief, and

that it was the duty of the Commissioner to direct that the appeal be forwarded.

The petitioner moved for a peremptory writ of mandamus, notwithstanding the answer. The District supreme court denied this, and the court of appeals affirmed such action.

The plaintiff's right to a writ of error to this court to review the judgment of the court of appeals is predicated upon the allegation that there is drawn in question the validity of "an authority exercised under the United States."

STATUTES.

Sections 233 and 234 of the act of 1901 (chapter 854, 31 Stats., 1227) are as follows:

> SEC. 233. Any final judgment or decree of the court of appeals may be reexamined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in all cases in which the matter in dispute, exclusive of costs, shall exceed the sum of five thousand dollars, in the same manner and under the same regulations as existed in cases of writs of error on judgments or appeals from decrees rendered in the supreme court of the District of Columbia on February ninth, eighteen hundred and ninety-three, and also in cases, without regard to the sum or value of the matter in dispute, wherein is involved the validity of any patent or copyright, or in which is drawn in question the validity

of a treaty or statute of, or an authority exercised under, the United States.

SEC. 234. In any case heretofore made final in the court of appeals it shall be competent for the Supreme Court of the United States to require, by certiorari or otherwise, any such case to be certified to said Supreme Court for its review and determination, with the same power and authority in the case as if it had been carried by appeal or writ of error to said Supreme Court.

Rules of Patent Office:

An application filed in the Patent Office is first referred to a primary examiner for action; if he twice rejects any claim an appeal may be taken to the examiners in chief (sec. 4909, Rev. Stats.); if they affirm the decision appeal may be taken to the Commissioner (sec. 4910, Rev. Stats.), and if he affirms the decision appeal may be taken to the court of appeals of the District of Columbia (sec. 4911, Rev. Stats., and sec. 9, act of February 9, 1893, R. S. U. S., Sup., vol. 2, c. 74).

The following rules of the Patent Office, made under the authority of section 483, Revised Statutes, bear upon the action taken:

41. Two or more independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other, and mutually contribute to produce a single result, they may be claimed in one application.

Claims for a machine and its product must be presented in separate applications.

Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications.

Claims for a process and its product may be presented in the same application.

42. If several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them, the inventor will be required to limit the description, drawing, and claim of the pending application to whichever invention he may elect. The other inventions may be made the subjects of separate applications, which must conform to the rules applicable to original applications. If the independence of the inventions be clear, such limitation will be made before any action upon the merits; otherwise, it may be made at any time before final action thereon, in the discretion of the examiner.

133. Every applicant for a patent, any of the claims of whose application have been twice rejected for the same reasons, upon grounds involving the merits of the invention, such as lack of invention, novelty, or utility * * * may, upon payment of a fee of $10, appeal from the decision of the primary examiner to the examiners in chief. The appeal must set forth in writing the points of the decision upon which it is taken, and must be signed by the applicant or his duly authorized attorney or agent.

145. Upon receiving a petition stating concisely and clearly any proper question

which has been twice acted upon by the examiner, and which does not involve the merits of the invention claimed, or the rejection of a claim, and also stating the facts involved and the point or points to be reviewed, an order will be made fixing a time for hearing such petition by the Commissioner, and directing the examiner to furnish a written statement of the grounds of his decision upon the matters averred in such petition within five days after being notified of the order fixing the day of hearing. The examiner shall at the time of making such statement furnish a copy thereof to the petitioner. No fee is required for such a petition.

The defendant in error contends:

I. This court has no jurisdiction to entertain the writ.

II. The decision of the court of appeals is right, and if the cause is considered here should be affirmed on the merits.

ARGUMENT.

I.

There is not here drawn in question the validity of "an authority exercised under the United States"—the only ground upon which it is alleged this court has jurisdiction.

Plaintiff in error nowhere questions the authority of the Commissioner of Patents to act on his petition, but, on the contrary has, by asking for

such action, admitted the Commissioner's authority to take it. He now says that the decision rendered in response to his request was wrong.

It is well settled by many decisions of this court that the validity of an authority exercised under the United States is not drawn in question simply because the correctness of a decision rendered by one exercising such authority is disputed. The validity of the authority must be called in question, and not merely the rightfulness or wrongfulness of the officer's action.

In the case of *Baltimore and Potomac Railroad Company* v. *Hopkins* (130 U. S., 211–226) suit was brought in the supreme court of the District of Columbia against the railroad to recover for alleged injuries occasioned by unlawful use of streets in Washington, which the railroad claimed to occupy and use as it did under authority of Congress. The court charged the jury that the railroad had a right, under the act of Congress, to use the streets in certain ways, but not in other ways. A writ of error was sued out and it was argued in this court that the validity of an authority exercised under the United States was drawn in question, and this gave jurisdiction. The writ was dismissed. After citing a number of authorities, Mr. Chief Justice Fuller, delivering the opinion, said:

> (P. 226) The validity of the statutes and the validity of authority exercised under them are, in this instance, one and the same

> thing; and "the validity of a statute," as these words are used in this act of Congress, refers to the power of Congress to pass the particular statute at all, and not to mere judicial construction as contradistinguished from a denial of the legislative power. In our opinion the validity of no act of Congress, or authority under the United States, was so drawn in question here as to give us jurisdiction.

In *United States* v. *Lynch* (137 U. S., 280–285), a mandamus proceeding instituted in the supreme court of the District of Columbia, it was claimed that it was the mere ministerial duty of the Auditor under the statute to allow relator's claim for mileage, but that in violation of that duty he undertook to exercise a discretion not possessed and to disallow the same, and that this being an invalid exercise of an authority under the United States the validity of such authority was drawn in question. And upon that ground it was maintained this court had jurisdiction on writ of error. The writ was dismissed. Mr. Chief Justice Fuller, speaking for the court, said:

> (P. 285.) In order to justify this position, however, the validity of the authority must have been drawn in question directly and not incidentally. The validity of a statute is not drawn in question every time rights claimed under such statute are controverted, nor is the validity of an authority, every

time an act done by such authority is disputed. The validity of a statute or the validity of an authority is drawn in question when the existence, or constitutionality, or legality of such statute or authority is denied and the denial forms the subject of direct inquiry.

We think that the authority of the Second Comptroller and the Fourth Auditor is not thus denied here, nor the validity of that authority questioned, but that what is claimed is that in the exercise of a valid authority the Auditor and Comptroller erred in respect to an allowance, in view of the decision of this court in another case. * * *

What the relator sought was an order coercing these officers to proceed in a particular way, and this order the supreme court of the District declined to grant. If we were to reverse that judgment upon the ground urged, it would not be for want of power in the Auditor to audit the account and in the Comptroller to revise and pass upon it, but because those officers had disallowed what they ought to have allowed and erroneously construed what needed no construction. This would not in any degree involve the validity of their authority.

The case of *South Carolina* v. *Seymour* (153 U. S., 353, 360) was before this court on a writ of error to the court of appeals of the District of Columbia, which had denied a writ of mandamus to

the Commissioner of Patents to register a trade-mark. The writ was dismissed for lack of jurisdiction. Mr. Justice Gray delivered the opinion, and said therein—

> In the present case no objection to the validity of the act of Congress under which the Commissioner of Patents acted was made, either at the hearings in the Patent Office and in the courts in the District of Columbia or in the briefs filed by counsel in this court. Nor was the existence or the lawfulness of the authority conferred by that act upon the Commissioner of Patents drawn in question. But from the beginning to the end of the proceedings the only controversy was as to the construction of the act of Congress, and consequently as to the nature and extent of the Commissioner's authority. Neither the question whether the Commissioner rightly decided upon the presumptive lawfulness of the right of the State of South Carolina to the trade-mark sought to be registered, nor the question whether the Commissioner's duty was of such a character that a writ of mandamus would lie to compel its performance, involved a question of the validity of the authority exercised by him under the United States.

In *Linford* v. *Ellison* (155 U. S., 503) it was held that a decision of the supreme court of Utah, adjudging a municipal tax void because not authorized by the organic law, did not involve the

validity of a statute of the United States nor was there drawn in question any authority exercised thereunder.

The question at issue in the present case was whether the Commissioner of Patents was wrong in refusing to direct an appeal from the primary examiner. His authority to act was admitted by asking for a mandamus.

II.

The action of the court of appeals was right on the merits.

The opinion of the court below which appears in the record is an able and complete discussion upon the merits of the questions involved, and is especially commended to the attention of this court as showing beyond question the correctness of its judgment.

The commissioner decided, upon petition to him, the matter which had been ruled upon by the primary examiner. Mandamus will not lie to compel him now to refer it to a lower tribunal in his own office.

It is fundamental that mandamus will not issue against a public officer except to compel the performance of some plain, clear, ministerial duty, and will not issue to control his discretion. (*Decatur* v. *Paulding*, 14 Peters, 515; *Mississippi* v. *Johnson*, 4 Wall., 475; *Redfield* v. *Windom*, 137 U. S., 636; *Dunlap* v. *Black*, 138 U. S., 636.)

Where it is the duty of the officer to pass upon a question, mandamus may be used to compel him

to decide, but not to compel him to decide in any particular way, nor to set aside a ruling already made.

In the present case the Commissioner, upon the request of plaintiff, rendered a decision upon the very question which it is now desired he shall transmit to the examiners in chief in his office for another decision. (Par. 13, return, page 10, record.) In other words, having asked the Commissioner to pass on the question, and not being satisfied with the decision, plaintiff now seeks a mandamus commanding the Commissioner to set that aside and refer the case to a lower tribunal in his office.

When the Commissioner reviewed and sustained the action of the primary examiner requiring division between process and apparatus he performed his full duty under the law. He has not failed or refused to act, but plaintiff wishes a different result.

The Commissioner is the head of the Patent Office, and when he personally acts upon a case he can not be required to refer it to a lower tribunal in his office. This was settled in the case of *Commissioner of Patents* v. *Whiteley* (4 Wall., 522), a proceeding for mandamus commanding the Commissioner to refer Whiteley's application to a primary examiner for consideration and action, after he had taken it up himself and had ruled that Whiteley was not entitled to a reissue. This court held a mandamus did not lie to require him to thereafter refer the case to a lower tribunal. The

court further said that since his ruling went to the merits Whiteley was entitled to appeal therefrom to the court.

In this case, if the examiner's requirement, approved by the Commissioner, is to be regarded as a final rejection, appeal lies to the court of appeals, and not from the primary examiner to the examiners in chief.

Section 481, Revised Statutes, provides that the Commissioner of Patents shall "superintend *or perform* all duties respecting the granting and issuing of patents directed by law."

He has authority to take a case up and act upon it personally in the first instance, and without regard to any decision of an examiner. He not only has the authority, but it is his duty, to refuse it where he is of the opinion that the applicant is not "justly entitled to a patent under the law." (Section 4893, Revised Statutes.)

He is not simply an appellate tribunal, as contended by the plaintiff. This is made clear in the Whiteley case and in *Butterworth* v. *Hoe* (112 U. S., 50).

The plaintiff, furthermore, asked the Commissioner to act upon the question raised by the primary examiner, and therefore can not be heard to say that the action was of no effect. He can not be permitted to ignore that action. If it was a rejection, he has mistaken his remely, since he

should have appealed to the court of appeals from the Commissioner's decision instead of applying for a mandamus.

Plaintiff has admitted that the action of the primary examiner was not a rejection of a claim and not appealable.

When plaintiff asked the Commissioner to review the examiner's action, he did so by petition under rule 145 (par. 13, return, page 10, record), which rule provides for review of a question which "does not involve the merits of the invention claimed or *the rejection of a claim*." By that petition he clearly admitted the examiner's action did not involve a rejection of a claim.

Plaintiff acquiesced in the decision of the primary examiner and can not now object and appeal therefrom.

If the examiner's action was originally appealable, the plaintiff forfeited his right of appeal by his conduct.

He was notified by the examiner that he must acquiesce in the requirement for division before he would be entitled to an interference with a patent to Duncan (par. 8, return, p. 9, record). By his acceptance of the examiner's ruling the Patent Office was induced to declare and conduct the interference proceeding which the plaintiff could not otherwise have obtained. Since he accepted the decision and both parties acted under it, he can not now appeal from it, even if he could in the first instance.

No appeal from the ruling of the primary examiner to the examiners in chief was permissible in any view of the case.

It is clear that the examiner's action was not in the first instance appealable unless within the meaning of section 4909, Revised Statutes, which applies to an application "any of the claims of which have been twice rejected."

Rejection means an adverse ruling upon the merits and not a mere requirement as to form or procedure. In this case there has been no adverse ruling upon the merits by the primary examiner.

Under the general rule of law the examiner's action to be appealable must dispose of the whole case, and not merely require certain steps preliminary to an adjudication of the claim. As said in *Bostwick* v. *Brinkerhoff* (106 U. S., 3):

> If the judgment is not one which disposes of the whole case on its merits, it is not final. Consequently it has been uniformly held that a judgment of reversal with leave for further proceedings in the court below can not be brought here on writ of error.

It was made plain in *Butterworth* v. *Hoe* (112 U. S., 50) that every failure to issue a patent is not a rejection within the meaning of the law, since "It applies only when the Commissioner decides to reject an application for a patent on the ground that the applicant is not, *on the merits*, entitled to it."

The action must be a denial of the applicant's right to his claims and must be of such character

as to prevent him from securing those claims unless reversed on appeal.

It was clearly not the intention of Congress to make preliminary questions of form and procedure appealable under sections 4909, 4910, and 4911, Revised Statutes. The Commissioner of Patents by section 483, Revised Statutes, is given authority to make rules governing procedure. He is therefore unmistakably designated by the statutes as the final authority upon such matters, and action thereupon is not subject to appeal.

The first statute providing for appeal was that of 1836. (4 Stat. L., 577.) Section 7 of that act enumerated certain grounds of rejection relating to the merits, and provided for an appeal from a ruling holding the applicant was not entitled to a patent. Subsequent statutes relating to appeals have made no attempt to enumerate the grounds of rejection.

At the time of the passage of the act of 1870, the foundation of the present patent system, the following rule promulgated by Commissioner Fisher in 1869 was in force:

> 44. After an application for a patent has been twice rejected upon the merits by the examiner having it in charge, it may, at the option of the applicant, be brought before the board of examiners in chief on payment of a fee of ten dollars. For this purpose a petition in writing must be filed, signed by the party or his authorized agent or attorney.

The history of the legislation shows that the right of appeal was given to secure correct determination upon the merits of applications for, as said in *Butterworth* v. *Hoe* (*supra*, p. 60), it—

> * * * is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one step in the statutory proceeding under the patent laws whereby that tribunal is interposed in aid of the Patent Office, though not subject to it.

The court of appeals said in the present case:

> It is not denied that to constitute a rejection of the claims in the meaning of the statute the action * * * must amount in legal effect to an adverse decision in respect to the merits of the claim, and be of a character to defeat the right to a patent therefor, unless reversed on appeal.

This has been the uniform construction of the law by all tribunals that have considered it, and it is clearly the right one.

Merits not involved—

The ruling by the examiner in this case did not reach the merits, and is therefore not appealable. There has been no ruling by him that plaintiff is not on the merits entitled to every claim made. He has not required the relinquishment of any claim, but has merely required him to present them separately. This is a mere matter of procedure and it alone could be settled by the proposed appeal. A decision on such an

appeal would not determine whether plaintiff is to receive a patent upon any claim. Whether the examiner were sustained or reversed upon the matter of procedure, the case would have to go back to him for final action upon the merits. The question raised is, therefore, clearly not one that disposes of the entire case, but, as decided by the lower court, is a mere preliminary matter of procedure.

Division not merits—

Division is not required upon the ground that the patent covering two inventions, if granted, would be declared invalid. No question as to validity is involved, since the courts have never declared a patent invalid because of the joinder of distinct inventions. Division, therefore, involves no question of merits.

Commissioner Fisher, referring to decisions sustaining patents, said in 1869:

> The doctrine of both of these cases seems to be that while the rule which assigns distinct inventions to distinct patents is a proper one, and one which the Commissioner may properly enforce, yet, if the patent actually issue, the courts will sustain it. It is certainly nowhere asserted that it is the duty of the Commissioner to include two or more inventions in one patent, but it is evidently referred to his discretion. (*Ex parte Yale*, C. D., 1869, 110.)

About the same time this court held, in *Bennett* v. *Fowler* (8 Wall., 445):

> It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvements shall be embraced in one, two, or more patents. Some discretion must necessarily be left on this subject to the head of the Patent Office. It is often a nice and perplexing question.

In *ex parte Mefford* (C. D., 1883, 95; 25 O. G., 881), Commissioner Butterworth said:

> From the decisions of the courts prior to this time it is clear that a patent containing them all would not for that reason be held invalid. (*Hogg* v. *Emerson*, 6 Howard, 437; *Barrett* v. *Hall*, 1 Mason, C. C., 447; *Moody* v. *Fisk*, 2 Mason, 112; *Wyeth* v. *Stone*, 1 Story, 273.)
>
> But it does not follow because the courts would not hold the patent invalid that it is the duty of the Patent Office to allow the application in its present form.

These cases announce the construction of the law which has always been followed. (*Ex parte Fefel*, 57 O. G., 409; *Ex parte Everson*, 68 O. G., 1381; *Ex parte Burgess*, 64 O. G., 1759; *Ex parte Demeny*, 64 O. G., 1649.)

The reason for requiring division was thus stated by Commissioner Fisher in *Ex parte Yale* (*supra*):

> Another consideration, which is not less important, is found in the classification of the various subjects of invention and the

> assignment of the different classes to different examiners. This division of labor is absolutely essential to the prompt and thorough examination of applications. It is adopted to facilitate the transaction of the public business, and the inventor himself is directly and immediately benefited by a strict adherence to it. Any union of inventions in one patent that would seriously impair this classification ought not to be permitted. Besides the delay and increased difficulty in making the examination, if the patent covers devices which enter into two classes, the drawing, which is single, must be deposited in the portfolio of the one class and be wanting in the portfolio of the other. It may thus be overlooked in the examination of the next case.

In *Ex parte Everson* (*supra*), twenty-four years later, it was said:

> The office classification must be considered in determining the question whether process and apparatus may be joined in the same application. This question of classification is one of the highest importance, and unless the lines of classification are kept clear there is danger that the present patent system will fall to pieces of its own weight.

It is absolutely necessary that the question of division be controlled by the Commissioner in order that he may carry out the examination system which Congress has created. The problem of classification is a serious one where 25,000 patents are granted each year.

The requirement for division merely affects costs and not substantial rights. The question of costs is not appealable.

In no way has the Commissioner attempted to increase fees fixed by law. The plaintiff is put to some expense by a requirement for division, but this is true of every requirement as to procedure and does not distinguish the present one from others.

Substantial rights not affected—

The plaintiff claims the requirement for division and the issuance of two patents instead of one will cause confusion and embarrassment to the public; but that fact, if true, does not adversely affect his interests. To give him the right of appeal, the examiner's action must adversely affect his interests, and not merely embarrass a stranger. There will, however, be no more confusion than happens every day when a broad patent is granted dominating other patents in the same art—such, for instance, as the Bell telephone. There is no real conflict of rights in such cases.

It is further claimed that where there is doubt whether the invention is a process or an apparatus, applicant should be permitted to claim both in one application. This admits he is not entitled to both, and as he is entitled to only one, there is surely no substantial injury to him in requiring him to limit the case to one.

No substantial injury can result to an applicant by requiring him to include his claims in two patents instead of one, unless the claims are thereby rendered invalid. If process and apparatus claims are embodied in two patents instead of one, plaintiff claims the courts may hold one of those patents invalid. There is no suggestion that *both* will be declared invalid, but merely that *one* may be. The only ground upon which one may be declared invalid, is that it covers the same thing as the other. Two patents for the same thing are not permissible. If they do cover the same thing and one is sustained, the applicant has all possible protection. He is not entitled to duplicate claims in one patent any more than in two.

There is no danger of the court holding a patent upon a process covers the same thing as one upon apparatus. If the process claim is not independent of the apparatus, it is merely for the function of the apparatus and is invalid whether in the same case or a separate case. This is settled by many decisions of this court.

Process and apparatus independent—

It is a well-settled principle in patent law that a process and an apparatus are distinct, separable, and independent things. A process is the mode of treatment to produce a certain result, and as said in *Cochrane* v. *Deemer* (94 U. S., 780–788):

> It is an act or a series of acts performed upon the subject-matter to be transformed and reduced to a different state or thing—

whereas a machine is a combination of mechanical elements which may or may not be useful in performing the acts which constitute the process.

As was said in *Corning* v. *Burden* (15 How., 252–268):

> It is when the term process is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations.

The court further pointed out that an alleged process which is the mere function of mechanism is not patentable.

James v. *Campbell* (104 U. S., 356–376):

> A patent for a process and a patent for an implement or a machine are very different things.

In *Heald* v. *Rice* (104 U. S., 736–753) this court said:

> A patent for a machine can not be reissued for the purpose of claiming the process of operating that class of machines, because if the claim for the process is anything more than for the use of the particular machine patented it is for a different invention.

If it is for the mere use of the machine, it is not patentable, because not a true process.

In *Tilghman* v. *Proctor et al.* (102 U. S., 707–728) it was said:

> It is very certain that the means need not be a machine or an apparatus. It may, as the court says, be a process. A machine is a thing. A process is an act or a mode of acting. The one is visible to the eye—an object of perpetual observation. The other is a conception of the mind, seen only by its effects when being executed or performed. Either may be the means of producing a useful result.

This court, in *Rubber Company* v. *Goodyear* (9 Wall., 788–796), said:

> Patentable subjects, as defined by the patent law, are "any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter." A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the latter not. The machine may be substantially old and the product new. In that event, the latter, and not the former, would be patentable. Both may be new, or both may be old. In the former case both would be patentable; in the latter, neither. The same remarks apply to processes and their results. Patentability may exist as to either, neither, or both, according to the fact of novelty, or the opposite. The patentability,

> or the issuing of a patent as to one, in no wise affects the rights of the inventor or discoverer in respect to the other. They are wholly disconnected and independent facts. Such is the sound and necessary construction of the statute.

Commissioner Mitchell, admitted by the plaintiff to be one of the ablest patent lawyers who ever held the office of Commissioner, said in the decision principally relied upon by plaintiff in this case:

> That process and apparatus constitute distinct inventions is too clear for argument, and it has been so decided over and over again by the Supreme Court of the United States. (*Ex parte Lord*, 50 O. G., 987, C. D., 1890, 16.)

If plaintiff should succeed in obtaining a decision that his process is absolutely dependent upon his mechanism, his process claims are not patentable because for the function of his mechanism.

Long established practice of Patent Office.—

An examination of the published decisions of the Patent Office (which extend from 1869 to date) fails to reveal any case in which the question of division has been treated as an appealable matter under sections 4909, 4910, and 4911, Revised Statutes. It has uniformly been held that it is a preliminary matter, left to the discretion of the Commissioner.

Rule 42 of the Patent Office provides that where an applicant is required to divide his case and limit it to one invention—

> If the independence of the inventions be clear, such limitation will be made before any action upon the merits; otherwise it may be made at any time before final action thereon.

There have been differences of opinion as to when division should be required, some holding that division should always be required between process and apparatus (*Ex parte Blythe*, 30 O. G., 1321; C. D., 1885, 82; *Ex parte Herr*, 41 O. G., 463; C. D., 1887, 105; *Ex parte Boucher*, 88 O. G., 545; and *Ex parte Frasch*, 91 O. G., 459), and others holding the question depended upon the circumstances of each case. There has never been a difference of opinion, however, upon the question whether division affects the merits and is an appealable matter.

Commissioner Mitchell had before him in the case of *Ex parte Chambers* (51 O. G., 1943; C. D., 1890, 101) the question whether an action by the primary examiner was appealable to the examiners in chief. He ruled the action was in effect a requirement for division and was not appealable, saying:

> The question of division has always been held to pertain to the administrative side of the functions of the Commissioner, and I am unable to understand how it becomes a

> question for the judicial cognizance of the successive tribunals of the office by being presented in the present form.

The only authority which plaintiff is able to cite in support of his contention, that the question of division is appealable to the examiners in chief, is the decision of Assistant Commissioner Fisher in *Ex parte Bellingrodt* (54 MS. Dec., 474), which was never published. In published decisions Assistant Commissioner Fisher and the then Commissioner, Mr. Seymour, announced a contrary practice. (*Ex parte Everson*, *Ex parte Demeny*, *supra*.)

It is interesting to note that even in the Bellingrodt case, aside from mere dictum, the ruling was that division was matter of form and not rejection. It was there said:

> The question of division therefore being one of form should be postponed, if the applicant is disposed to question the propriety of this requirement until after a final determination of the merits has been reached.

The uniform ruling of all Commissioners from the beginning has been that requirement for division is not appealable, and uniform and long-established construction of the statute by the able patent lawyers who have held the position of Commissioner is entitled to great weight. As was said in *Bate Refrigerating Company* v. *Sulzberger* (157 U. S., 1–34):

> If the statute be not so explicit as to preclude construction; if upon applying to it

> the established rules of interpretation; if looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting either one of two constructions, this court, without departing from sound principle, may well adopt that construction which is in harmony with the settled practice of the executive branch of the Government.

To adopt the construction contended for by plaintiff would upset the entire practice of the Patent Office, under which 50,000 applications for patents are disposed of each year, and cause great confusion. If one ruling as to procedure is appealable, all may be.

Last year the Commissioner decided 1,814 cases on interlocutory petition without fee, and 118 cases on appeal under section 4910, Revised Statutes. If rulings as to procedure are appealable, each of those cases should have come before him by appeal. The appeal fees alone would have amounted to $54,420.

The court of appeals in this case well said:

> These rules, with many others, forming a system of practical procedure for the Patent Office, were adopted by able, experienced patent lawyers who occupied the position of Commissioner of Patents, and they have been in force for many years and the practice of the Office has been made to conform to them. To support, at this late day, the contention of the appellant and declare these

rules in any material respect invalid upon the theory that they restrict the right of appeal, would be attended with very serious consequences to the Patent Office, indeed to the public. An established practice, such as has obtained under these rules, ought not to be disturbed by the court, except upon the clearest principle of right and necessity.

THE DEFENDANT IN ERROR RESPECTFULLY ASKS THAT THE WRIT OF ERROR BE DISMISSED FOR WANT OF JURISDICTION; AND IF THAT CAN NOT BE DONE, HE ASKS THAT THE JUDGMENT OF THE COURT OF APPEALS BE AFFIRMED.

J. C. MCREYNOLDS,
Assistant Attorney-General.

JOHN M. COIT,
Of Counsel.

WASHINGTON, *December 14, 1903.*

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14394—03——3

In the Supreme Court of the United States.

OCTOBER TERM, 1903.

THE UNITED STATES EX RELATIONE Charles P. Steinmetz, plaintiff in error,
v.
FREDERICK I. ALLEN, COMMISSIONER of Patents, defendant in error.
} No. 383.

PETITION FOR CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF FOR THE COMMISSIONER OF PATENTS IN OPPOSITION.

This cause was brought here by writ of error to the court of appeals of the District of Columbia. The record was filed July 29, 1903. Upon motion of the defendant in error it was advanced and set for hearing directly after No. 13, Original, Ex parte Frasch. On Monday, December 14, a motion was made for final hearing of *Ex parte Frasch* and a day fixed therefor later in that week. It was taken up Friday, December 18. For want

of time to hear it before the recess this cause was postponed until January. Briefs were prepared and filed by all parties in interest in both cases prior to December 16. In the brief for defendant in error it was insisted that the court had no jurisdiction, as there was not "drawn in question the validity of * * * an authority exercised under the United States."

On December 16 notice was served herein that on Monday, December 21, plaintiff in error would apply for a writ of certiorari.

Respondent respectfully insists that it is now too late for such an application; that it would be contrary to the orderly administration of the court's business and contrary to its policy to grant the same.

Reference is made in the brief filed in support of the motion to a petition filed by the Government and granted under similar circumstances in *Henry C. Payne, Postmaster-General, plaintiff in error*, v. *The United States, etc.*, No. 628, October term, 1902 (189 U. S., 512). In that case the record and writ of error were filed here March 7, 1903, and *on the same day* the papers and petition for certiorari were likewise filed. On March 9 petition was submitted to the court, and March 16 it was granted. The Government acted with promptness and did not wait until the cause was ready and about to be heard before making application for the writ.

The merits of the present controversy have been discussed at length in the brief already filed for defendant in error, and to it reference is made.

HENRY M. HOYT,
Solicitor-General.

DECEMBER 21, 1903.

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Supreme Court of the United States.

No. 383.—October Term, 1903.

The United States ex relatione Charles P. Steinmetz, Plaintiff in Error, *vs.* Frederick I. Allen, Commissioner of Patents. } In error to the Court of Appeals of the District of Columbia.

[February 23, 1904.]

This is a petition in mandamus filed in the Supreme Court of the District of Columbia to compel the Commissioner of Patents to require the primary examiner to forward an appeal, prayed by the petitioner, to the board of examiners-in-chief, to review the ruling of the primary examiner requiring petitioner to cancel certain of his claims in his application for motor meters.

The Supreme Court dismissed the petition, and its action was affirmed by the Court of Appeals. This writ of error was then sued out.

The decision of the primary examiner was based upon rule 41 of practice in the Patent Office, and the case involves the validity of the rule under the patent laws.

The petitioner filed an application in the Patent Office, November 21, 1896, for a patent for "certain new and useful improvements in motor meters." He expressed his invention in thirteen claims. They are inserted in the margin.*

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*1. The herein-described method of measuring alternating electric currents, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetization and adapted to actuate a rotatable armature in a motor meter arranged within the energizing coils producing said lines of magnetization.

2. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism from three ntersecting lines or axes of magnetization and adapted to actuate a rotatable armature arranged within the energizing coils producing said lines of magnetization.

3. The herein-described method of actuating a single-phase alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetization and adapted to actuate a rotatable armature arranged within the energizing coils producing said lines of magnetization.

4. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism by means

The first six were held by the primary examiner to be claims for a process; the balance of the claims to be for an apparatus; and on the 15th of May, 1900, ordered that the latter, that is, claims 7, 8, 9, 10, 11, 12 and 13, be cancelled from the application. In other words, he required a division between the process claims and the apparatus claims in accordance with rule 41. That rule is as follows:

"41. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result, they may be claimed in one application.

"Claims for a machine and its product must be presented in separate applications.

"Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications.

"Claims for a process and its product may be presented in the same application."

Petitioner persisted in his application as filed, and the primary examiner repeated his order for a division of the claims. Petitioner regarded such order as "a second final rejection" of his claims to the apparatus, and appealed therefrom to the board of examiners-in-chief. The primary examiner refused to answer the appeal and to forward the same with his

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of magneto-motive forces acting along three intersecting lines and subjecting an armature to the inductive action of said field.

5. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces being proportional to the current and the other two to the electro-motive force, and subjecting an armature to the inductive action of said field.

6. The herein-described method of actuating an alternating-current moter meter which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines, one magneto-motive force being proportional to the current and the other two to the electro-motive force, the several magneto-motive forces being so proportioned and related to each other than the resultant of the last two is displaced in phase from the first by the complement of the angle of lag, and subjecting an armature to the inductive action of said field.

7. In a Watt meter for alternating electric currents, means for producing a magnetic flux proportional to the current and varying in phase therewith, means for producing a second magnetic flux proportional to the electro-motive force and lagging in phase behind the same, and means for producing an auxiliary flux along a line at an angle to said second flux and of such magnitude and phase that the resultant of the two last-mentioned fluxes will lag behind the first by the complement of the angle of lag.

8. The combination in an electro motor of a field-magnet system and means for inducing therein magnetic fluxes of three phases, one a flux due to a series coil and proportional to the current, a second flux due to a shunt potential coil and lagging behind the electro-motive force, and a third flux lagging behind said second flux

answer thereto and the statements required by the rules of the Patent Office. Thereafter, on the 20th of August, 1900, petitioner petitioned the Commissioner of Patents to direct the primary examiner to forward said appeal, which petition was denied. It was repeated to the present Commissioner, defendant in error, and by him denied on the 7th of February, 1902.

These facts constitute petitioner's claim to relief.

The answer to the respondent asserts the validity of rule 41, justifies the action of the Patent Office, alleges that petitioner is estopped from contesting the orders of the primary examiner, and also alleges that those orders "did not involve the rejection of any claim or an action upon the merits of any claim made by the relator," as provided in rule 13, and that "the statutes and rule 133 of the rules of practice do not provide for an appeal to the examiners-in-chief from an examiner's requirement for division, and the examiners-in-chief have no jurisdiction to pass upon the question whether or not division should be required."

The answer presents also the following facts: Prior to making the order of May 15, 1900, to wit, on October 9, 1899, the primary examiner wrote a letter to petitioner regarding the division of the process claims and the

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and having a fixed angular relation thereto such that the resultant of the second and third fluxes is dephased by substantially the complement of the angle of lag from the flux due to the series coil

9. The combination in a recording electric meter of a field-magnet system acting on the armature and having a plurality of intersecting magnetic axes, means for inducing along one of said magnetic axes a flux proportional to the current and varying in phase therewith, and means for inducing along the other magnetic axes a plurality of other fluxes dependent upon the potential of the metered circuit, which lag behind the electro-motive force by different amounts and act upon the armature at different points, said fluxes being so proportioned in value and phase that their joint action upon the armature will enable the meter to register the true energy consumed in an alternating-current circuit without being substantially affected by changes of phase relation.

10. In a watt meter for alternating currents, the combination of a field-magnet system having three intersecting magnetic axes, means for producing along one of said axes a magnetic flux proportional to the current and varying in phase therewith, means for producing along another of said axes an alternating flux proportional to the electro-motive force and lagging behind the same, and means for producing along the third axis an auxiliary magnetic flux also proportional to the electro-motive force, of such a magnitude and phase that the joint action of the several fluxes upon the armature will enable the meter to register the true energy consumed in an alternating-current circuit without being substantially affected by changes of phase relation.

11. In a meter for alternating currents, the combination of a field-magnet system having three intersecting magnetic axes, means for producing along one of said axes a magnetic flux proportional to the current and varying in phase there-

apparatus claims, in accordance with rule 41, before further action would be given upon the merits of the case.

Petitioner replied December 15, 1899, requesting "that the requirement for division be waived for the present," in order that his process claims be placed in interference with the claims of a patent to one Duncan. To this request the examiner answered:

"Pending the determination of the interference applicant may retain the method and apparatus claims in this case, but the acceptance of an interference on one of the method claims will be held by the office to be an election of the prosecution of the method claims, and further prosecution of the apparatus claims in this application will not be permitted."

Petitioner replied January 19, 1900, urging that the interference be declared, and on February 7, 1900, it was declared and decided in favor of petitioner. After the decision the examiner wrote the letter of May 15, 1900. These proceedings, respondent contends, constitute an estoppel.

The first ruling of the Commissioner of Patents upon the petition to require the primary examiner to respond to petitioner's appeal was as follows:

"Where applicant does not care to comply with the examiner's requirements in a matter of division such as is here involved, it has been the practice for the past thirty years to treat the question, not as one of merits

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with, means for producing along another of said axes an alternating flux proportional to the electro-motive force and lagging behind the same, and means for producing along the third axes an auxiliary magnetic flux also proportional to the electro-motive force and of such magnitude and phase that the joint action of the two potential fluxes upon the armature will produce a torque sufficient to overcome the static friction of the meter.

12. In a single-phase alternating current meter, the combination of a field-magnet system having three intersecting magnetic axes, a field coil in which the current phase varies as the conditions of the circuit change, producing a magnetization along one magnetic axes, a potential coil producing a magnetization along another magnetic axis, a reactance device in series with said potential coil for lagging the current behind the electro-motive force and a second potential coil depending for its current upon the first potential coil, producing a magnetization along the third magnetic axis; the two potential coils conveying currents which differ in phase from each other, and each generating a flux which acts upon the armature at a point removed from the point at which the flux due to the other potential coil acts upon the armature.

13. In an electric meter, the combination of a multipolar field-magnet structure having three magnetic axes, current coils mounted upon some of the field poles and producing a magnetization along one of said magnetic axes, potential coils mounted upon other field poles and producing a magnetization along another one of said magnetic axes, and other potential coils mounted upon a portion only of the last-named field poles, or some of them, and producing a magnetization along the third magnetic axes, and an armature acted upon by the flux induced by the field coils.

and appealable to the examiners-in-chief, but as a proper matter for petition to the Commissioner. I see no reason for overturning this practice. This petition is denied."

The second order of the Commissioner, respondent, after reciting certain of the facts, concluded as follows:

"The requirement for division is purely a matter of form, not involving the merits of the claims, since the claims may be, and in the present case are, regarded as allowable. The examiner has not refused to grant a patent to this applicant upon any of the claims presented, but has merely required that they be included in two patents instead of one. It is a question of procedure or of the manner of securing the protection which is in controversy and not the right of the applicant to a patent upon any of the claims presented.

"The examiner was right in taking the position that the question involved is not appealable to the examiners-in-chief, and although it is a general rule of law that the appellate tribunal is the one to determine whether or not it has jurisdiction when an appeal is taken to it, it is not considered necessary in the office practice to follow that practice strictly, since the Commissioner is the head of the office and has the final decision upon all questions arising within it and may settle questions of this kind upon direct petition. The examiner's decision upon the question whether or not an appeal to the examiners-in-chief is regular and proper is not final, since it may be reviewed by the Commissioner upon petition, but he has authority to pass upon that question in the first instance.

"The petition is denied."

Mr. Justice McKenna, after stating the case as above, delivered the opinion of the Court.

1. The jurisdiction of this court to review the judgment of the Court of Appeals is questioned. There is no money in dispute nor anything to which a pecuniary value has been given. Jurisdiction is claimed under the clause of section 8 of the act of February 9, 1893, which gives an appeal to this court from the final judgment or decree of the Court of Appeals in cases in which there is drawn in question the validity of "an authority exercised under the United States."

By section 483 of the Revised Statutes the Commissioner of Patents, subject to the approval of the Secretary of the Interior, is empowered to establish from time to time regulations not inconsistent with law, for the conduct of proceedings in the Patent Office. The Commissioner of Patents, exercising the power conferred, established, among other rules of practice, rule 41. It thereby became a rule of procedure and constituted, in part, the powers of the primary examiner and Commissioner. In other words, it became an authority to those officers, and, necessarily, an authority "under the United States." Its validity was and is assailed by the plaintiff in error. We think, therefore, we have jurisdiction, and the motion to dismiss is denied.

2. The issue is well defined between the parties, both as to the right and remedy, in the Patent Office. As to right, petitioner contends that a union by an inventor of process and apparatus claims, which are essentially the same invention, is given by the patent laws, and that rule 41, so far as it takes that right away, is repugnant to those laws and invalid. As to remedy, that the decision of the primary examiner constituted a final decision upon the case, and petitioner was entitled to an appeal under the patent laws to the board of examiners-in-chief. The latter proposition depends upon the first. Assuming the right in an inventor as expressed in the first proposition, the primary examiner denied the right. True, a distinction can be made between his ruling and one on the merits, if we regard the merits to mean invention, novelty or the like. But in what situation would an applicant for a patent be? If he yield to the rule he gives up his right of joinder. If he does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application. (Section 4894, R. S.) A ruling having such effect must be considered as final and appealable. Whether, however, to the examiners-in-chief or to the Commissioner, and from the latter to the courts, we may postpone answering until we have considered the right of an inventor to join process and apparatus claims in one application.

Section 4886 of the Revised Statutes of the United States provides as follows:

"Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

There is nothing in the language of the section which necessarily precludes the joinder of two or more inventions in the same application. But the section does distinguish inventions into arts (processes), machines, manufactures and compositions of matter, and the earliest construction of the law denied the right of joinder. An exception, however, came to be made in cases of dependent and related inventions.

In *Hogg* v. *Emerson*, (6 How. 437,) it was said:

"The next question is, that this description in the letters thus considered covers more than one patent and is therefore void.

"There seems to have been no good reason at first, unless it be a fiscal one on the part of the Government when issuing patents, why more than one in favor of the same inventor should not be embraced in one instru-

ment, like more than one tract of land in one deed or patent for land. (Phillips on Pat., 217.)

"Each could be set out in separate articles or paragraphs, as different counts for different matters in libels in admiralty or declarations at common law, and the specifications could be made distinct for each and equally clear.

"But to obtain more revenue, the public officers have generally declined to issue letters for more than one patent described in them. (Renouard, 293; Phillips on Pat. 218.) The courts have been disposed to acquiesce in the practice, as conducive to clearness and certainty. And if letters issue otherwise inadvertently to hold them, as a general rule, null. But it is a well established exception that patents may be united, if two or more, included in one set of letters, relate to a like subject, or are in their nature or operation connected together. (Phil. on Pat. 218, 219; *Barret* v. *Hall*, 1 Mason C. C. 447; *Moody* v. *Fiske*, 2 Mason C. C. 112; *Wyeth et al.* v. *Stone et al.*, 1 Story, 273.)"

This language would seem to imply that not the statute but the practice of the Patent Office required separate applications for inventions, but the cases cited were explicit of the meaning of the statute. Mr. Justice Story, in *Wyeth* v. *Stone*, said:

"For, if different inventions might be joined in the same patent for entirely different purposes and objects, the patentee would be at liberty to join as many as he might chose, at his own mere pleasure, in one patent, which seems to be inconsistent with the language of the patent acts, which speak of the thing patented, and not of the things patented, and of a patent for invention, and not of a patent for an inventions; and they direct a specific sum to be paid for each patent."

But he confined the requirement to independent inventions, and his illustrations indicated that he meant by independent inventions not those which, though distinct, were "for the same common purpose and auxiliary to the same common end."

Hogg v. *Emerson* came to this court again, and is reported in 11 How. 587. Of one of the objections to the patent the court said:

"It is that the improvement thus described is for more than one invention, and that one set of letters patent for more than one invention is not tolerated by law.

"But grant that such is the result when two or more inventions are entirely separate and independent, though this is doubtful on principle, yet it is well settled, in the cases formerly cited, that a patent for more than one invention is not void if they are connected in their design and operation. This last is clearly the case here."

Many other cases are to the same effect.

Can it be said that a process and an apparatus are inevitably so independent as never to be "connected in their design and operation?" They may be completely independent. (*Cochrane* v. *Deener*, 94 U. S. 780.) But they may be related. They may approach each other so nearly that it will be difficult to distinguish the process from the function of the appa-

ratus. In such case the apparatus would be the dominant thing. But the dominance may be reversed and the process carry an exclusive right, no matter what apparatus may be devised to perform it. There is an illustration in the *Telephone cases*, (126 U. S. 1.) The claim passed upon in those cases was as follows:

"The method of and apparatus for transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations, similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth."

The claim was held to refer to the art described, and the means of making it useful. The court observed:

"Other inventors may compete with him for the ways of giving effect to the discovery, but the new art he has found will belong to him and those claiming under him during the life of his patent."

A distinction between the process and the means employed for using it was recognized. It was said:

"The patent for the art does not necessarily involve a patent for the particular means employed for using it. Indeed, the mention of any means, in the specification or descriptive portion of the patent, is only necessary to show that the art can be used; for it is only useful arts—arts which may be used to advantage—that can be made the subject of a patent."

The patent was sustained. It was not attacked because it embraced independent inventions. The fact is not without force. Considering the ability of counsel engaged and the division of the court in opinion, it is a proper inference that no tenable objection to the patent was overlooked.

It is said by Robinson, in his work on Patents, that "special rules which govern the joinder of arts or processes with each other or with related inventions of a different class, are more stringent in the Patent Office than in the courts." (Section 473, vol. 11, Robinson on Patents.) And the author deduces the conclusion that under the rules of the Patent Office a process cannot be "joined with the apparatus that performs it, nor either of these with the product in which they result, unless they are to such an extent inseparable that the existence of some one of them is dependent upon that of the others." But rule 41 precludes even this.

If there is a divergence of views between the courts and the Patent Office and the divergence proceeds from a different interpretation of the statute, the views of the courts ought to prevail. If the courts, however, have only recognized and enforced the exercise of a discretion of the Patent Office, the question occurs, what is the extent of such discretion and can it be expressed and fixed in an inflexible rule such as rule 41? In *Bennet* v. *Fowler*, (8 Wall. 445,) a discretion in the Patent Office was recognized. The ques-

tion arose upon the validity of two reissued patents for improvements, which "had been embraced in one, in the original patent." The court said:

"It may be that if the improvements set forth in both specifications had been incorporated into one patent, the patentee taking care to protect himself as to all his improvements by proper and several claims, it would have been sufficient. It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvements shall be embraced in one, two or more patents. Some discretion must necessarily be left on this subject to the head of the Patent Office. It is often a nice and perplexing question."

Some discretion is not an unlimited discretion, and if the discretion be not unlimited it is reviewable. In other words, the statute gives the right to join inventions in one application in cases where the inventions are related, and it cannot be denied by a hard and fixed rule which prevents such joinder in all cases. Such a rule is not the exercise of discretion; it is a determination not to hear. No inventor can reach the point of invoking the discretion of the Patent Office. He is notified in advance that he will not be heard, no matter what he might be able to show. His right is denied, therefore, not regulated. Such is the necessary effect of rule 41, as amended.

Without that rule the action of the Patent Office can be accommodated to the character of inventions, and discretion can be exercised, and when exercised, we may say in passing, except in cases of clear abuse, the courts will not review it. But the rule as amended, as we have said, precludes the exercise of any judgment and compels the separation of claims for a process and claims for its apparatus, however related or connected they may be. And the right denied is substantial. Counsel for petitioner have explained that right by the embarrassments caused by its denial, one of which is that, by disclosing the apparatus in his application for the process, he might lose the right to and a patent for the apparatus, and to sustain that view *James* v. *Campbell*, (104 U. S. 356,) is cited. We are not prepared to admit such consequences nor that *James* v. *Campbell* so decides. If the classification of the statute makes a distinction between the different kinds of inventions—between a process and an apparatus—and requires or permits a separate application for each, it would seem to follow irresistibly that an application and patent for one would not preclude an application and patent for the other, and the order of the application could not affect the right which the law confers. *James* v. *Campbell* was a case of reissued patent, and by express provision of the statute as to reissued patents no new matter can be introduced in them. In other words, the reissue is to perfect, not to enlarge, the prior patent. Whether the principle of the case applies to related as well as to independent inventions is not clear from its language. The court said:

"Where a new process produces a new substance, the invention of the process is the same as the invention of the substance, and a patent for the one may be reissued so as to include both, as was done in the case of Goodyear's vulcanized rubber patent. But a process, and a machine for applying the process are not necessarily one and the same invention."

The facts of the case did not call for a more definite ruling. The original patent was for a device for postmarking and cancelling postage stamps by a single blow. The reissued patent claimed the act of marking and cancellation, and it was observed by the court:

"The process or act of making a postmark and cancelling a postage stamp by a single blow or operation, as a subject of invention, is a totally different thing in the patent law from a stamp constructed for performing that process."

But without attempting to enlarge the case and extend it to more intimately related inventions, it is enough now to say that there is nothing in the case which decides that if the process had been claimed in an independent application it (the process) would have been adjudged to have been dedicated to the public by the other patent. There is language indicating the contrary. It was said:

"If he (the patentee) was the author of any other invention than that which he specifically describes and claims, though he might have asked to have it patented at the same time and in the same patent, yet if he has not done so, and afterwards desires to secure it, he is bound to make a new and distinct application for that purpose, and make it the subject of a new and different patent."

The case, however, indicates what embarrassment and peril of rights may be caused by a hard and fixed rule regarding the separation of related inventions. See also *Mosler Safe Co.* v. *Master*, (127 U. S. 345,) and *Miller* v. *Eagle Manufacturing Co.*, (151, U. S. 186.)

The Patent Office has not been consistent in its views in regard to the division of inventions. At times convenience of administration has seemed to be of greatest concern; at other times more anxiety has been shown for the rights of inventors. The policy of the office has been denominated that of "battledore and shuttlecock," and rule 41 as it now exists was enacted to give simplicity and uniformity to the practice of the office. Its enactment was attempted to be justified by the assumption that the patent laws gave to the office a discretion to permit or deny a joinder of inventions. But, as we have already said, to establish a rule applicable to all cases is not to exercise discretion. Such a rule ignores the differences which invoke discretion, and which can alone justify its exercise, and we are of opinion therefore that rule 41 is an invalid regulation.

3. Having settled the right of appellant, we may now return to the consideration of his remedy. Respondent contends:

"It is fundamental that mandamus will not issue against a public officer, except to compel the performance of some plain, clear, ministerial duty, and will not issue to control his discretion."

And it is further contended that respondent has acted, and, having acted, cannot be required to refer the case to a lower tribunal in his office. To sustain the contention *Commissioner of Patents* v. *Whitely*, (4 Wall. 522,) is cited.

The unity of the inventions claimed by petitioner in the case at bar we may assume. It is not denied by respondent. Petitioner had, therefore, the right to join them in one application. The denial of this right by the primary examiner was a rejection of the application and entitled petitioner to an appeal to the examiners-in-chief, under section 4909 of the Revised Statutes. That section provides:

"Every applicant for a patent, . . . any of the claims of which have been twice rejected, . . . may appeal from the decision of the primary examiner to the board of examiners-in-chief; . . ."

The section 482 provides:

"The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be on the written petition of the appellant to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions and perform such other like duties as he may assign them."

The procedure on appeal is provided for by the rules of the Patent Office. It is taken by filing a petition praying an appeal with the primary examiner setting forth the reasons upon which the appeal is based, and it is made the duty of the examiner five days before the date of hearing to furnish the appellate tribunal and the appellant with a statement of the grounds of his decision. A petition praying an appeal was filed but the primary examiner refused to answer the appeal, and the defendant in error also refused to direct him to answer it. It is manifest that if an appeal cannot be compelled from the decision of the primary examiner, an applicant is entirely without remedy. And respondent has asserted that extreme. In *Ex parte Frasch* the Court of Appeals of the District of Columbia was persuaded that an appeal was not the proper remedy. In the case at bar it is contended that mandamus is not the proper one. One or the other must be. A suggestion made is that the inventor must await a decision on the merits, meaning by merits "lack of invention, novelty or utility," as expressed in rule 133. But after waiting he would encounter the arbitrary requirement of rule 41. Besides what would there be to review if the order of the primary examiner were complied with and the claims put into separate applications? There are some observations in *Commissioner of Patents* v. *Whitely*, which may be

quoted. Whitely claimed to be the assignee of a patent, and filed an application for a reissue. The Commissioner declined to entertain it on the ground that Whitely was only assignee of an interest and not of the entire patent. He also declined to allow an appeal to be taken from his decision. The Supreme Court of the District of Columbia awarded a peremptory writ of mandamus commanding the Commissioner to refer the application to the proper examiner, or otherwise examine or cause it to be examined according to law. Error was prosecuted to this court. Under the act of 1836 it was provided that if the Commissioner decided adversely to an applicant for a patent an appeal could be taken to the board of examiners, and by the act of 1837 that remedy was given to an applicant for a reissue of a patent, and the question in the case was whether that remedy should have been pursued. In other words, whether the remedy was by appeal or mandamus. It was decided that appeal was the remedy. Singularly enough, the Commissioner in answer to the rule took the position that the application was not before him because it had not been filed. The court said if that were so "mandamus would clearly lie to compel the Commissioner to receive it. It was his first duty to receive the application. Whatever he might do subsequently, without this initial step there could be no examination, and, indeed, no rightful knowledge of the subject on his part. Examination and the exercise of judgment, with their proper fruit, were to follow, and they did follow."

And so the exercise of judgment might follow a hearing of the application under review. It was the duty of the primary examiner to accord a hearing or, refusing to do so, to grant an appeal. It was the duty of the Commissioner to compel the appeal. The Commissioner of Patents is primarily charged with granting and issuing patents. Applications for patents are made to him, (section 4888, Revised Statutes,) and his superintendence should be exercised to secure the rights which the statutes confer on inventors. The first of those rights is a hearing. If that be denied other rights cannot accrue.

The Commissioner justifies his decision by the rules of the Patent Office and a long practice under them. If there is inconsistency between the rules and statute, the latter must prevail. But the primary examiner did not follow the rules. The rules provide that if appeal be regular *in form* (italics ours) he shall within five days of the filing thereof furnish the examiners-in-chief with a written statement of the grounds of his decision on all of the points involved in the appeal, with copies of the rejected claims and with the references applicable thereto. If he decide that the appeal is not regular in form, a petition from such decision may be made directly to the Commissioner. The regularity of the appeal in form is not questioned in the case at bar, and it was the duty of the examiner to answer the appeal by furnishing the examiners-in-chief the statement provided

for in rule 135. A petition to the Commissioner was not necessary except to make the examiner to perform his duty.

4. We do not think that petitioner was estopped from insisting upon his application by proceeding with the interference with Duncan after the examiner's letter of December 15, 1899. It would be pressing mere order of procedure and the convenience of the Patent Office too far to give them such result under the circumstances.

The judgment of the Court of Appeals is therefore reversed with directions to reverse that of the Supreme Court, and direct the Supreme Court to grant the writ of mandamus as prayed for.

True copy.

Test:

Clerk Supreme Court, U. S.